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AUG 11 2010

CENTRAL REEXAMINATION UNIT

(For Patent Owner)

KEATING & BENNETT, LLP
1800 ALEXANDER BELL DRIVE, SUITE 200
RESTON, VA 20191

(For Third Party Requester)

Inter Partes Reexamination Proceeding
Control No. 95/001,206
Filed: August 19, 2009
For: U.S. Patent No. 7,272,021

: **DECISION GRANTING**
: **PETITION AND**
: **SUA SPONTE**
: **WAIVING PAGE LIMIT**

This is a decision on patent owner's petition paper entitled "PETITION UNDER 37 C.F.R. § 1.183 TO WAIVE PAGE LIMIT SET BY 37 C.F.R. § 1.943(B)" filed on June 10, 2010.

The patent owner petition is before the Office of Patent Legal Administration.

The petition fee of \$400.00 pursuant to 37 CFR 1.17(f) for the petition under 37 CFR 1.183 was processed on June 15, 2010.

The patent owner petition under 37 CFR 1.183 is granted, for the reasons set forth herein.

BACKGROUND

1. On September 18, 2007, United States Patent No. 7,272,021 (the '021 patent) issued to Schlecht et al.
2. On July 14, 2009, a request for *inter partes* reexamination of the '021 patent was filed by a third party requester. The request was assigned Reexamination Control No. 95/001,206 (the '1206 proceeding).
3. On August 19, 2009, a corrected request for *inter partes* reexamination was filed by the third party requester, and the '1206 proceeding was assigned a filing date of August 19, 2009.
4. On October 15, 2009, *inter partes* reexamination was ordered in the '1206 proceeding.
5. On March 5, 2010, a non-final Office action was mailed in the '1206 proceeding.

6. On March 29, 2010, patent owner filed a request for extension of time to file its response to the March 5, 2010 Office action.
7. On April 16, 2010, the Office mailed a decision granting patent owner's March 29, 2010 request for extension of time and extending the time period for patent owner's response by one month to June 5, 2010.
8. On June 10, 2010, patent owner filed the instant petition entitled "PETITION UNDER 37 C.F.R. § 1.183 TO WAIVE PAGE LIMIT SET BY 37 C.F.R. § 1.943(B)" (petition under 37 CFR 1.183), concurrently with a patent owner response to the March 5, 2010 Office action.¹ This petition is the subject of the present decision.
9. On August 4, 2010, the Office mailed a "Notice RE Defective Paper in Inter Partes Reexamination" (the Notice of Defective Paper) stating that patent owner's June 10, 2010 response does not comply with 37 CFR 1.943(b). The Notice of Defective Paper set a time period of one month or thirty days, whichever is longer, from the mailing date of the Notice of Defective Paper for patent owner to file a corrected response.

DECISION

I. Relevant Authority

37 CFR 1.183 provides:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 CFR 1.943(b) provides:

Responses by the patent owner and written comments by the third party requester shall not exceed 50 pages in length, excluding amendments, appendices of claims, and reference materials such as prior art references.

II. Patent Owner Petition Under 37 CFR 1.183

Patent owner's June 10, 2010 petition under 37 CFR 1.183, requesting waiver of the 50-page limit of 37 CFR 1.943(b) for its concurrently-filed response to the March 5, 2010 Office action, has been fully considered.

¹ Patent owner's June 10, 2010 filing was accompanied by a Certificate of Mailing indicating that the response was timely mailed on June 7, 2010 (the due date of June 5, 2010 fell on a Saturday).

37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party. The burden is on petitioner to set forth with specificity the facts that give rise to an extraordinary situation in which justice requires suspension of a rule. A showing which petitioner can make in support of a request for waiver of the 50-page limit of 37 CFR 1.943(b) can be an attempt to draft a patent owner's response in compliance with the 50-page limit, and submission of a resulting response that is in excess of 50 pages concurrently with a petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b), requesting entry of the submitted response. Such a response can be evaluated for economizing, extraneous material, and arrangement, without repetition of information already of record. In this way, petitioner can rely on the proposed response: (1) for justification that more pages are needed to complete the response, and (2) to set forth an accurate determination of exactly how many additional pages are needed to complete the response.

In the instant petition under 37 CFR 1.183, patent owner requests that the page limit for patent owner's response to the March 5, 2010 Office action be waived. Patent owner states that the June 10, 2010 response "totals less than eighty pages of argument (excluding reference materials, the listing of claims, and fact declarations),"² and asserts that its response is "not excessive in view of the effective length of the Office Action."³

In support of waiver of 37 CFR 1.943(b), patent owner states that "the Examiner mailed a non-final office action that incorporated by reference the bulk of the arguments in the Requester's Request for Reexamination, effectively resulting in an office action comprising more than 150 pages of rejections and findings (split into twelve "issues" beyond the discussion of the priority date of the claims)."⁴ Patent owner asserts that "[i]t is not realistic that a patent owner could fairly address the scope of rejections adopted by the Examiner in less than one third of the space than was used [to] set forth the reasoning for the rejections."⁵ In particular, patent owner states that, under 37 CFR 1.111(b), it "must address every ground of rejection," that "the Examiner set forth a total of twelve issues in addition to the priority date," and that patent owner "is required to respond to the Requester's priority date analysis (adopted by the Examiner) and each claim rejection with more than a bald traversal of each rejection."⁶ Patent owner further asserts that it is "entitled to present evidence of secondary considerations of non-obviousness, which are extensive in this case" and that "[w]hile the reference materials themselves do not appear to be subject to the fifty page limit, it requires many pages to place these references in context."⁷

Based on the individual facts and circumstances of this case such as, for example, the size of the March 5, 2010 Office action, including the number of rejections and incorporation by reference

² Petition under 37 CFR 1.183 at page 3.

³ Id.

⁴ Petition under 37 CFR 1.183 at page 2.

⁵ Petition under 37 CFR 1.183 at page 3.

⁶ Id.

⁷ Id.

of pages from the request,⁸ it is deemed equitable to waive the 50-page limit of 37 CFR 1.943(b) in this instance.

The total number of pages of patent owner's June 10, 2010 response that count toward the page limit is 78 pages.⁹ The substantive portion of the March 5, 2010 Office action has been determined to span approximately 161 pages.¹⁰ Thus, it is deemed equitable in this instance to waive the 50-page limit of 37 CFR 1.943(b) to the extent that patent owner's response to the March 5, 2010 Office action not exceed 78 pages. Accordingly, patent owner's petition under 37 CFR 1.183 is granted and the page limit of 37 CFR 1.943(b) is waived to the extent of permitting patent owner's response to the March 5, 2010 Office action to exceed the page limit by up to 28 pages. This waiver makes patent owner's June 10, 2010 response page-length compliant.¹¹

III. Time Period and Page Limit for Submission of Third Party Requester Comments

This decision, *sua sponte*, waives the provisions of 37 CFR 1.943(b) to the extent that any written comments by third party requester filed in response to patent owner's response as set forth in this decision shall not exceed 78 pages in length, excluding reference materials, such as prior art references. **This waiver is conditional on the submission being in at least 12 point font and one-and-a-half or double spaced, with appropriate margins.** Requester has 30 days from the mailing date of this decision, granting patent owner's petition under 37 CFR 1.183 and making patent owner's June 10, 2010 response page-length compliant, to file a comments paper pursuant to 37 CFR 1.947.

⁸ For example, the March 5, 2010 Office action contains a total of 72 rejections. See Office action at pages 10-16.

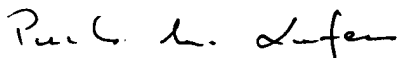
⁹ Pursuant to MPEP 2667(I)(A)(2), only those pages of patent owner's response upon which arguments appear are included against the page limit count. The remarks portion of the June 10, 2010 response includes 78 pages of arguments. The June 10, 2010 response also includes 2 declarations under 37 CFR 1.132 (the Schlecht and Pellikaan declarations). As set forth in MPEP 2667(I)(A)(2), affidavits or declarations that are excluded from the page limit requirements include, for example, declarations that provide comparative test data and an analysis of same. Further, attached exhibits presenting data or drawings are not included against the page limit count, unless an exhibit or drawing includes argument as to how the outstanding rejection is overcome. Thus, no pages of the Schlecht declaration count toward the page limit, and no pages of the Pellikaan declaration and its 88 accompanying exhibits count toward the page limit. Concurrently, on June 10, 2010, patent owner filed a notification of concurrent proceedings under 37 CFR 1.565(a), to which was attached several documents and exhibits from a related litigation. A review of the remarks portion of the June 10, 2010 response indicates that patent owner did not incorporate by reference material from these other sources but, rather, included any such material directly into the response itself, for example, in the form of direct quotes. See, e.g., June 10, 2010 patent owner response at pages 4-6. Additionally, because 37 CFR 1.943(b) expressly excludes appendices of claims from the page limit count, no pages of Appendix A count toward the page limit.

¹⁰ It is noted that, on its face, the substantive portion of the March 5, 2010 Office action, setting forth the rejections of the claims that were adopted by the examiner, appears to span only 16 pages but relies heavily on incorporation by reference of approximately 145 pages from the request for *inter partes* reexamination in the '1206 proceeding to set forth the rejections.

¹¹ The August 4, 2010 Notice of Defective Paper is moot in view of this waiver making patent owner's June 10, 2010 response page-length compliant. Thus, no patent owner response to the Notice of the Defective Paper is required.

CONCLUSION

1. Patent owner's June 10, 2010 petition under 37 CFR 1.183 is granted and the page limit of 37 CFR 1.943(b) is waived to the extent of permitting patent owner's response to the March 5, 2010 Office action to exceed the page limit by up to 28 pages. This waiver makes patent owner's June 10, 2010 response page-length compliant.
2. The August 4, 2010 Notice of Defective Paper is moot in view of this decision making patent owner's June 10, 2010 response page-length compliant. Thus, no patent owner response to the Notice of the Defective Paper is required.
3. This decision, *sua sponte*, waives the provisions of 37 CFR 1.943(b) to the extent that any written comments by third party requester filed in response to patent owner's response as set forth in this decision shall not exceed 78 pages in length, excluding reference materials, such as prior art references. **This waiver is conditional on the submission being in at least 12 point font and one-and-a-half or double spaced, with appropriate margins.** Requester has 30 days from the mailing date of this decision, granting patent owner's petition under 37 CFR 1.183 and making patent owner's June 10, 2010 response page-length compliant, to file a comments paper pursuant to 37 CFR 1.947.
4. Jurisdiction for the '1206 reexamination proceeding is returned to the Central Reexamination Unit (CRU).
5. Any questions concerning this communication should be directed to Nicole Dretar, Legal Advisor, at (571) 272-7717.



Pinchus M. Laufer
Legal Advisor
Office of Patent Legal Administration



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,206	08/19/2009	7272021	36856.1613	6964
24197	7590	04/19/2011	EXAMINER	
KLARQUIST SPARKMAN, LLP 121 SW SALMON STREET SUITE 1600 PORTLAND, OR 97204			ART UNIT	PAPER NUMBER

DATE MAILED: 04/19/2011

Please find below and/or attached an Office communication concerning this application or proceeding.



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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

Joseph R. Keating

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**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NUMBER 95/001,206.

PATENT NUMBER 7272021.

TECHNOLOGY CENTER 3999.

ART UNIT 3992.

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above-identified reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the *inter partes* reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an *ex parte* reexamination has been merged with the *inter partes* reexamination, no responsive submission by any *ex parte* third party requester is permitted.



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APR 19 2011
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Joseph R. Keating : (For Third Party
KEATING & BENNETT, LLP : Requester)
1800 ALEXANDER BELL DRIVE :
SUITE 200 :
RESTON, VA 20191 :

In re: Schlecht et al. :
Inter Partes Reexamination Proceeding : DECISION ON PETITION
Control No.: 95/001,206 : UNDER 37 CFR § 1.181
Deposited: August 19, 2009 :
For: U.S. Patent No.: 7,272,021 :

This is a decision on a petition filed by the patent owner on August 31, 2010 entitled:
"PETITION UNDER 37 C.F.R.. § 1.181 TO STRIKE THIRD PARTY REQUESTER'S
AUGUST 23, 2010 COMMENTS" [hereinafter "the Petition"].

The petition is a request to the Director to exercise his supervisory authority pursuant to 37 CFR
§ 1.181 to strike the allegedly improper comments from the record.

The petition is before the Director of the Central Reexamination Unit. The petition is denied.

REVIEW OF RELEVANT FACTS

- U.S. Patent No. 7,272,021 issued on September 18, 2007.
- A request for *inter partes* reexamination was filed on August 19, 2009 and assigned control no. 95/001,206.
- *Inter partes* reexamination was ordered on October 15, 2009 and a non-final rejection was mailed on March 5, 2010.
- On June 10, 2010, patent owner filed a paper responding to the Office action. The certificate of service states it was served on the third party on June 7. The paper was longer than permitted by rule, but was filed with a petition to waive the page limit.
- On August 11, 2010, the Office of Patent Legal Administration issued a decision granting the petition and waiving the page limit, thereby making the response a complete and compliant response. The decision stated the third party had 30 days from the decision date to file comments.
- On August 23, 2010, the third party submitted comments.
- On August 31, 2010, patent owner filed the instant petition.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

35 U.S.C. § 314 Conduct of inter partes reexamination proceedings (in part)

(b) RESPONSE. —

* * *

(2) Each time that the patent owner files a response to an action on the merits from the Patent and Trademark Office, the third-party requester shall have one opportunity to file written comments addressing issues raised by the action of the Office or the patent owner's response thereto, if those written comments are received by the Office within 30 days after the date of service of the patent owner's response.

37 C.F.R. § 1.943 Requirements of responses, written comments, and briefs in *inter partes* reexamination (in part)

(b) Responses by the patent owner and written comments by the third party requester shall not exceed 50 pages in length, excluding amendments, appendices of claims, and reference materials such as prior art references.

MPEP § 2666.05 Third Party Comments After Patent Owner Response (in part)

I. TIMELINESS

A third party requester may once file written comments on any patent owner response to an Office action, during the examination stage of an *inter partes* reexamination proceeding. The third party requester comments must be filed within a period of 30 days from the date of service of the patent owner's response on the third party requester. 37 CFR 1.947. . . . If the third party requester comments are filed after 30 days from the date of service of the patent owner's response on the third party requester, the comments will not be considered. See 37 CFR 1.957(a).

The following special circumstance is to be noted. In unique circumstances, it may happen that a patent owner files a response to an Office action and the page length of the response exceeds the page length set by 37 CFR 1.943(b). Accompanying the response is a petition under 37 CFR 1.183 requesting waiver of the 37 CFR 1.943(b) requirement. Until such a 37 CFR 1.183 petition to waive the page length is granted, or a page length compliant response is filed (if the 37 CFR 1.183 petition is not granted), the patent owner response is incomplete. Pursuant to MPEP § 2666.40, "[a]fter the owner completes the response, the examiner will wait two months from the date of service of the patent owner's completion of the response, and then take up the case for action, since the 30 days for the third party requester comments on the response as completed will have expired by that time. The third party requester may file comments on the response as completed . . . The response as completed is treated as a new response on-the-merits to the Office action; thus, the third party requester is entitled to file comments and has 30 days to do so." Based on the above, at the time the 37 CFR 1.183 petition is granted, the patent owner response becomes complete with its content being set in place, and the requester has 30 days from the date of the decision granting the 37 CFR 1.183 petition to file a comment paper pursuant to 37 CFR 1.947.

DECISION

Patent owner [“petitioner”] argues that the third party requester’s comments filed August 23, 2010 are improper because they were not timely filed. Petitioner argues that the statute requires comments to be filed within 30 days of service of the owner’s response. Service is the only triggering event in the statute starting the 30 day time period, not the time of a response becoming complete or compliant, therefore it was improper for the Office to grant 30 days from the date of the decision waiving the page limit. The MPEP is not law, and cannot contravene the clear and unambiguous language of the statute. As service was performed June 7th, and the comments were not received until August 23rd, they were not timely, says petitioner.

These arguments are not persuasive. While it is true that the triggering event in the statute is “service,” it is also true that the service must be of a “patent owner’s response.” The term “response” is not defined in the statute, but it is implicit that the term refers only to properly compliant responses. It does not make sense for statutory requirements to be triggered by the filing of something that, on its face, is improper. Furthermore, as “response” is not defined, it is left to the Office as the agency administering the statute to interpret and define the term. As codified in the regulations, 37 CFR § 1.943 states that “Responses by the patent owner . . . shall not exceed 50 pages in length.” A “response” is therefore interpreted and defined by the Office at least as a paper that does not exceed 50 pages in length. As Congress failed to define “response” in the statute, the Office is free to interpret and further define the term in its regulations.

Thus, at the time the paper was filed, at the time of service, the paper was not a “response” within the meaning of the statute, and therefore the time period was not yet triggered. Only after the Office waived the page limit requirement, in effect altering its definition in this case, did there exist a patent owner’s response. While service was made earlier, it was not effected until the waiver of the page limit because it was not until that date that there was a patent owner’s response. The effective date of “service of the patent owner’s response” under 35 U.S.C. § 314(b)(2) was therefore the date of the decision waiving the page limit requirement, and it was proper for the Office to grant 30 days from that date for the filing of comments.

Petitioner has not shown that the Office’s interpretation is unreasonable, and as shown above the statute is not clear and unambiguous in petitioner’s favor. The Director sees no need to alter the Office’s interpretation of the statute in this situation, which is already explicitly set forth in MPEP 2666.05 as quoted above, and the present situation is directly in accord with the MPEP. The entry of the comments paper is therefore in accord with Office policy. Accordingly, the petition is denied.

CONCLUSION

1. The petition filed August 31, 2010 is denied. The third party comments filed August 23, 2010 are not expunged from the record.
2. Telephone inquiries related to this decision should be directed to Mark Reinhart, Supervisory Patent Examiner, at (571) 272-1611 or in his absence to the undersigned at (571) 272-0700.



Irem Yucel
Director, Central Reexamination Unit



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,206	08/19/2009	7272021	36856.1613	6964
24197	7590	06/04/2011	EXAMINER	
KLARQUIST SPARKMAN, LLP 121 SW SALMON STREET SUITE 1600 PORTLAND, OR 97204			ART UNIT	PAPER NUMBER

DATE MAILED: 06/04/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Date: 6-4-11

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**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001206
PATENT NO. : 7272021
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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JUN 04 2011

CENTRAL REEXAMINATION UNIT

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(Courtesy Copy)

In re Schlecht et al
Inter partes Reexamination Proceeding
Control No: 95/001,206
Filing Date: August 19, 2009
For: U.S. Patent No.: 7,272,021

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DECISION
DISMISSING
PETITION

This is a decision on the March 21, 2011 patent owner petition, entitled "Petition to Stay *Inter Partes* Reexamination" (the March 21, 2011 patent owner petition).

This decision also addresses the November 3, 2009 change of correspondence address for the patent owner.

The March 21, 2011 patent owner petition, the November 3, 2009 change of correspondence address for the patent owner, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

SUMMARY

The March 21, 2011 patent owner petition is **dismissed**.

The November 3, 2009 change of correspondence address for the patent owner is **ineffective**.

DECISION

The patent owner requests the Office to suspend the present *inter partes* reexamination proceeding.

MPEP 2686.04 provides, in pertinent part (emphasis added):

[35 U.S.C. 314(c)]¹ thus authorizes the Director of the USPTO **to suspend (stay) reexamination proceedings, where there is good cause to do so**, pending the conclusion of litigation based on a potential for termination of a reexamination prosecution under 35 U.S.C. 317(b). Thus, a District Court decision that is pending appeal on the validity of the same claims considered in an *inter partes* reexamination proceeding may provide the requisite statutory “good cause” for suspension, due to the real possibility that the 35 U.S.C. 317(b) estoppel may attach in the near future to bar/terminate the reexamination proceeding.

Factors to be considered in determining whether it is appropriate to suspend action in the reexamination are:

- A. Whether the third party requester is a party to the litigation;
- B. Whether the claims in suit are identical to the claims under reexamination;
- C. Whether the issue(s) raised in the reexamination proceeding are the same issue(s) that were raised or could have been raised by the requester in the litigation;
- D. Whether the litigation has advanced to a late enough stage that there is a sufficient probability that a final decision will be adverse to the requester; and
- E. Whether there is a concurrent *ex parte* reexamination proceeding for the patent.

The patent owner argues that good cause exists to suspend the present proceeding because the requester, Murata Manufacturing Co. Ltd., is a co-defendant in the co-pending litigation, *SynQor, Inc. v. Artesyn Technologies, Inc. et al.*, Civil Action No. 2:07-CV-497-TJW-CE (E.D. Tex.). Upon brief review of the multitude of court documents filed in the present proceeding, the Office has verified that the requester, Murata Manufacturing Co., Ltd., is a co-defendant in the co-pending litigation, which satisfies item A.²

The patent owner further asserts that the claims at issue in the reexamination are identical to those in the litigation. The patent owner states that prior to trial, the district court instructed the

¹ 35 U.S.C. 314(c) provides, in pertinent part (emphasis added):

Unless otherwise provided by the Director for good cause, all *inter partes* reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, shall be conducted with special dispatch within the Office.

² The patent owner is reminded that the patent owner has the burden of providing a sufficient showing of the above-listed factors, including whether the requester is a co-defendant to the litigation. Merely stating that the requester is a co-defendant in the litigation is insufficient. In the present case, the Office was able to verify patent owner’s statement after brief review. However, if more than a brief review of the voluminous number of court documents is required to determine the above factors, then the showing of the patent owner will be determined to be insufficient, as discussed *infra*.

parties to agree on a representative number of claims for trial management purposes, and that the parties agreed to try claims 21 and 30 as representative claims of U.S. Patent no. 7,272,021 (the '021 patent). The patent owner, however, has not pointed to any court document that includes, for example, the court's instructions regarding the requirement to select representative claims, such as the court's order to select representative claims, or a court document that includes a statement by the patent owner regarding the court's requirement to select representative claims. Furthermore, the patent owner has not pointed to any court document that sets forth which claims of the '021 patent were the subject of the litigation *prior to* the court's requirement to select representative claims. In other words, the patent owner has not shown which group of claims is represented by the representative claims. For this reason, the patent owner has not sufficiently shown that the claims at issue are identical to the claims in reexamination, i.e., claims 1, 9, 15, 16, 21-27, 29-31, 39, and 45-47 of the '021 patent. Thus, item B has not been shown to have been satisfied.

The patent owner asserts that "all of the art cited by the Requester was available for use in the Litigation". To support its assertion, the patent owner points to exhibit A of the present petition, which is a court document, filed on October 29, 2010 by the co-defendants in the co-pending litigation, that identifies prior art "that may anticipate or showing [sic] the state of the art" pursuant to 35 U.S.C. 282, and that "reserves the right to modify or supplement this disclosure". This court document was filed more than one year after the August 19, 2009 filing date of the request for reexamination, showing that any issues raised in the reexamination proceeding were either raised or could have been raised prior to trial in the litigation. Thus, item C has been satisfied.

The patent owner further argues that the proceedings in the district court have reached an advanced stage. The patent owner states that the district court has entered a judgment on the jury verdict. The patent owner, however, has not pointed to a copy of the court's judgment to support its statement. Furthermore, the patent owner has not provided any evidence that an appeal has been filed with the Federal Circuit, or that the time for filing all appeals has expired. For this reason, the patent owner has not shown that litigation has advanced to a late enough stage that there is a sufficient probability that a final decision will be adverse to the requester. Thus, item D has not been shown to have been satisfied.

Finally, Office records do not reveal the existence of a co-pending *ex parte* reexamination proceeding for the '021 patent, which satisfies item E.

See also *Sony Computer Entertainment America, Inc. v. Dudas*, 85 USPQ2d 1594 (E.D. Va. 2006), where the court upheld the Office's determination of "good cause" to suspend two related *inter partes* reexamination proceedings. The facts of the present case, however, are clearly distinguishable from *Sony*. In *Sony*, the request for *inter partes* reexamination was not filed until after a final judgment in the district court was rendered. In the present case, however, the request for *inter partes* reexamination was filed well before trial began. Furthermore, unlike *Sony*, the Office has already issued an action closing prosecution rejecting all of the patent claims under reexamination, while in *Sony*, an action on the merits had not yet issued. Also, in *Sony*, an appeal had been filed and had been fully briefed. Thus, a final decision in *Sony* was on

the horizon.³ In the present case, however, the patent owner has not shown that an appeal to the Federal Circuit has been filed, or that the time for filing all appeals has expired. In other words, the patent owner has not shown that a final decision is expected in the near future. And, without a final decision adverse to requester, no estoppel can attach to bar the filing of an *inter partes* reexamination request or to mandate termination of an ordered reexamination proceeding. Stated another way, the fact that estoppel could possibly attach at some uncertain point in the future, as argued by patent owner, does not provide the requisite showing of good cause for suspension. Finally, reexamination in *Sony* was limited to the claims that were being litigated. In the present case, however, the patent owner has not shown that the claims in suit are identical to the claims under reexamination in the present proceeding.

In summary, the patent owner has not provided a showing of good cause to suspend prosecution of the present reexamination proceeding.

Accordingly, the March 21, 2011 patent owner petition is **dismissed**. Pursuant to MPEP 2686.04, the present *inter partes* reexamination proceeding **will continue**, and **will not be suspended**.

If a renewed petition to suspend the present *inter partes* reexamination proceeding is later contemplated, **the factors explained in this decision must be addressed.**

The November 3, 2009 Change of Correspondence Address of the Patent Owner Is Ineffective

A change of correspondence address was filed by the patent owner in the present proceeding on November 3, 2009. However, the address for the patent owner in a reexamination proceeding is the official correspondence address of the patent owner *in the patent file*. In the present case, the official correspondence address for the patent owner, that is of record in the patent file, application no. 11/407,699, is shown in the caption of this decision. See MPEP 2622 and 37 CFR 1.33(c).

Accordingly, the November 3, 2009 change of correspondence address for the patent owner is **ineffective**.

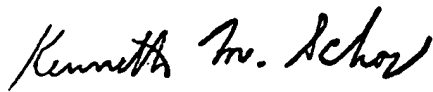
A courtesy copy of this decision will be mailed to the practitioner who submitted the present patent owner petitions, Mr. Richard D. McLeod. **Absent the filing of a proper change of correspondence address in the patent file, which is application no. 11/407,699, however, all future correspondence will be mailed to the current address of record for the patent owner, as shown in the caption of this decision.**

CONCLUSION

- The March 21, 2011 patent owner petition is **dismissed**.
- The present *inter partes* reexamination proceeding will continue, and **will not be suspended**.

³ A decision is "final" after all appeals, including any appeal to the Federal Circuit, have been exhausted.

- The November 3, 2009 change of correspondence address for the patent owner is ineffective. Absent the filing of a proper change of correspondence address in the patent file, application no. 11/407,699, all future correspondence will be mailed to the current address of record for the patent owner, as shown in the caption of this decision.
- Telephone inquiries related to this decision should be directed to Cynthia L. Nessler, Senior Legal Advisor, at (571) 272-7724, or in her absence, to the undersigned at (571) 272-7710.



Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

6-02-11
Kenpet8/IP/suspend



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United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,206	08/19/2009	7272021	36856.1613	6964
24197	7590	12/23/2011	EXAMINER	
KLARQUIST SPARKMAN, LLP 121 SW SALMON STREET SUITE 1600 PORTLAND, OR 97204			ART UNIT	PAPER NUMBER

DATE MAILED: 12/23/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Joseph R. Keating
KEATING & BENNETT, LLP
1800 Alexander Bell Drive, Suite 200
Reston, VA 20191

Date:

MAILED

DEC 23 2011

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001206

PATENT NO. : 7272021

TECHNOLOGY CENTER : 3999

ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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DEC 23 2011

CENTRAL REEXAMINATION UNIT

Klarquist Sparkman
121 SW Salmon Street
Suite 1600
Portland, OR 97204

(For Patent Owner)

Joseph R. Keating
Keating & Benneti, LLP
1800 Alexander Bell Drive
Suite 200
Reston, VA 20191

(For Third Party Requester)

In re Schlecht et al.
Inter Partes Reexamination Proceeding
Control No. 95/001, 206
Filed: August 19, 2009
For: U.S. Patent No. 7,272,021

:
: **DECISION**
: **GRANTING PETITION**
: **UNDER § 1.183**
:

This is a decision on the December 20, 2011 patent owner petition entitled "Petition To Waive Rules (37 C.F.R. § 1.183)."

The patent owner petition is before the Office of Patent Legal Administration.

The petition under 37 C.F.R. § 1.183 to request rule waiver and an extension of time is **granted** to the extent specified below.

BACKGROUND

- On August 19, 2009, a corrected request for *inter partes* reexamination of certain claims of U.S. Patent 7,272,021 was filed by a third party requester. This proceeding was accorded control number 95/001,206 ("the '1206 proceeding"). Reexamination was ordered on October 15, 2009.
- Prosecution progressed until, on September 2, 2011, a Right of Appeal Notice was issued by the Office, in which all of requester's proposed rejections were adopted, and all of the patent claims subject to reexamination were rejected.

- On October 3, 2011, patent owner filed a Notice of appeal and the following petitions:
 - A petition entitled “Petition For Entry of Amendment After ACP (37 C.F.R. § 1.181)” requesting reconsideration of the examiner’s decision to close prosecution.
 - A petition entitled “Petition To Waive Rules (37 C.F.R. § 1.183)” requesting a waiver of the prohibition on requesting an extension of time to file an appellant’s brief until after a decision is issued on the co-filed § 1.181 petition.
- On November 21, 2011, the Office issued a decision granting the petition to waive rules under § 1.183, extending the time to file an appeal brief through January 3, 2012.
- On December 20, 2011, patent owner filed a petition entitled “Petition To Waive Rules (37 C.F.R. § 1.183)” requesting a waiver of the prohibition on requesting an extension of time to file an appellant’s brief until after a decision is issued on the earlier-filed § 1.181 petition.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

37 CFR § 1.183 states:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 C.F.R. § 41.61(b) states:

- (1) Within fourteen days of service of a requester’s notice of appeal under paragraph (a)(2) of this section and upon payment of the fee set forth in § 41.20(b)(1), an owner who has not filed a notice of appeal may file a notice of cross appeal with respect to the final rejection of any claim of the patent.
- (2) Within fourteen days of service of an owner’s notice of appeal under paragraph (a)(1) of this section and upon payment of the fee set forth in § 41.20(b)(1), a requester who has not filed a notice of appeal may file a notice of cross appeal with respect to any final decision favorable to the patentability, including any final determination not to make a proposed rejection, of any original, proposed amended, or new claim of the patent.

37 CFR § 41.66 states, in pertinent part:

- (a) An appellant’s brief must be filed no later than two months from the latest filing date of the last-filed notice of appeal or cross appeal or, if any party to the proceeding is entitled to file an appeal or cross appeal but fails to timely do so, no later than two months from the expiration of the time for filing (by the last

party entitled to do so) such notice of appeal or cross appeal. The time for filing an appellant's brief or an amended appellant's brief may not be extended.

DECISION

The present patent owner petition for an extension of time was filed on December 20, 2011, after the filing of a Notice of Appeal, and a previously granted petition for an extension of time to file an appellant's brief. Patent owner filed the instant petition under 37 C.F.R. § 1.183 for waiver of the prohibition of an extension of time for filing an appellant's brief until after a decision is issued on the petition under § 1.181 that was filed on October 3, 2011. Under 37 C.F.R. § 41.66(a), the time for filing an appellant's brief may not be extended.

The time for filing an appellant's brief was previously extended to run through January 3, 2011.¹ The outstanding petition under 37 C.F.R. § 1.181 is currently under consideration by the Office.

In this instance, patent owner has filed a petition for extension of time to obtain the results of (a decision on) a petition under § 1.181. A decision on the § 1.181 petition has not yet been rendered. In the event patent owner were to have filed an Appellant's Brief to keep the proceeding pending, in this case, that filing would cause an unnecessary expenditure of resources by the Central Reexamination Unit (CRU) to consider a brief that could become moot, should the petition under § 1.181 be granted.

Under the current facts and circumstances of the proceeding, an extension of time under 37 C.F.R. § 1.183 is granted to the extent that patent owner petitioner's time period to submit an Appellant's Brief is extended to run 30 days from the previously extended due date; i.e., through February 2, 2011.

If the petition under § 1.181 has not yet been decided at the point where the time for requester to file an Appellant's Brief becomes less than two weeks prior to the deadline as extended, then petitioner may file a petition for an additional extension of time. In that event, petitioner is advised to contact Michael Cygan at the phone number given below in the contact information to inform the Office that the petition for an additional extension of time is being filed, in order to expedite its review. Petitioner should note for any further request for extension that the Office, by statute, handles all *inter partes* reexamination proceedings with special dispatch, and therefore the delay resultant to granting a petition extending the time for filing an appellant's brief is weighed the risk of unnecessary expenditure of resources, and that weighing is a strongly fact-specific inquiry.

CONCLUSION

1. The patent owner petition for extension of time filed December 20, 2011 for filing an Appellant's Brief is **granted to the extent stated above.**

¹ See decision issued on November 21, 2011.

2. The time for to file an Appellant's Brief, by either or both of the patent owner or the third party requester, is extended to run **30 days** from the due date; *i.e.*, through February 2, 2012.
3. Telephone inquiries related to this decision should be directed to the undersigned at (571) 272-7700.

/Michael Cygan/

Michael Cygan
Legal Advisor
Office of Patent Legal Administration

December 22, 2011



UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,206	08/19/2009	7272021	36856.1613	6964
24197	7590	01/25/2012	EXAMINER	
KLARQUIST SPARKMAN, LLP 121 SW SALMON STREET SUITE 1600 PORTLAND, OR 97204			ART UNIT	PAPER NUMBER

DATE MAILED: 01/25/2012

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Joseph R. Keating
KEATING & BENNETT, LLP
1800 Alexander Bell Drive, Suite 200
Reston, VA 20191

Date:

MAILED

JAN 25 2012

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001206

PATENT NO. : 7272021

TECHNOLOGY CENTER : 3999

ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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JAN 25 2012

Klarquist Sparkman
121 SW Salmon Street
Suite 1600
Portland, OR 97204

(For Patent Owner)

CENTRAL REEXAMINATION UNIT

Joseph R. Keating
Keating & Benneti, LLP
1800 Alexander Bell Drive
Suite 200
Reston, VA 20191

(For Third Party Requester)

In re Schlecht et al.
Inter Partes Reexamination Proceeding
Control No. 95/001, 206
Filed: August 19, 2009
For: U.S. Patent No. 7,272,021

:
: **DECISION**
: **GRANTING PETITION**
: **UNDER § 1.183**
:

This is a decision on the January 19, 2012 patent owner petition entitled "Petition To Waive Rules (37 C.F.R. § 1.183)."

The patent owner petition is before the Office of Patent Legal Administration.

The petition under 37 C.F.R. § 1.183 to request rule waiver and an extension of time is **granted** to the extent specified below.

BACKGROUND

- On August 19, 2009, a corrected request for *inter partes* reexamination of certain claims of U.S. Patent 7,272,021 was filed by a third party requester. This proceeding was accorded control number 95/001,206 ("the '1206 proceeding"). Reexamination was ordered on October 15, 2009.
- Prosecution progressed until, on September 2, 2011, a Right of Appeal Notice was issued by the Office, in which all of requester's proposed rejections were adopted, and all of the patent claims subject to reexamination were rejected.

- On October 3, 2011, patent owner filed a Notice of appeal and the following petitions:
 - A petition entitled “Petition For Entry of Amendment After ACP (37 C.F.R. § 1.181)” requesting reconsideration of the examiner’s decision to close prosecution.
 - A petition entitled “Petition To Waive Rules (37 C.F.R. § 1.183)” requesting a waiver of the prohibition on requesting an extension of time to file an appellant’s brief until after a decision is issued on the co-filed § 1.181 petition.
- On November 21, 2011, the Office issued a decision granting the petition to waive rules under § 1.183, extending the time to file an appeal brief through January 3, 2012.
- On December 20, 2011, patent owner filed a petition entitled “Petition To Waive Rules (37 C.F.R. § 1.183)” requesting a waiver of the prohibition on requesting an extension of time to file an appellant’s brief until after a decision is issued on the earlier-filed § 1.181 petition.
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- On January 19, 2012, patent owner filed a petition entitled “Petition To Waive Rules (37 C.F.R. § 1.183)” requesting a waiver of the prohibition on requesting an extension of time to file an appellant’s brief until after a decision is issued on the earlier-filed § 1.181 petition.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

37 CFR § 1.183 states:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 C.F.R. § 41.61(b) states:

- (1) Within fourteen days of service of a requester’s notice of appeal under paragraph (a)(2) of this section and upon payment of the fee set forth in § 41.20(b)(1), an owner who has not filed a notice of appeal may file a notice of cross appeal with respect to the final rejection of any claim of the patent.
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make a proposed rejection, of any original, proposed amended, or new claim of the patent.

37 CFR § 41.66 states, in pertinent part:

(a) An appellant's brief must be filed no later than two months from the latest filing date of the last-filed notice of appeal or cross appeal or, if any party to the proceeding is entitled to file an appeal or cross appeal but fails to timely do so, no later than two months from the expiration of the time for filing (by the last party entitled to do so) such notice of appeal or cross appeal. The time for filing an appellant's brief or an amended appellant's brief may not be extended.

DECISION

The present patent owner petition for an extension of time was filed on January 19, 2012, after the filing of a Notice of Appeal, and two previously granted petitions for an extension of time to file an appellant's brief. Patent owner filed the instant petition under 37 C.F.R. § 1.183 for waiver of the prohibition of an extension of time for filing an appellant's brief until after a decision is issued on the petition under § 1.181 that was filed on October 3, 2011. Under 37 C.F.R. § 41.66(a), the time for filing an appellant's brief may not be extended.

The time for filing an appellant's brief was previously extended to run through February 2, 2012.¹ The outstanding petition under 37 C.F.R. § 1.181 is currently under consideration by the Office.

In this instance, patent owner has filed a petition for extension of time to obtain the results of (a decision on) a petition under § 1.181. A decision on the § 1.181 petition has not yet been rendered. In the event patent owner were to have filed an Appellant's Brief to keep the proceeding pending, in this case, that filing would cause an unnecessary expenditure of resources by the Central Reexamination Unit (CRU) to consider a brief that could become moot, should the petition under § 1.181 be granted.

Under the current facts and circumstances of the proceeding, an extension of time under 37 C.F.R. § 1.183 is granted to the extent that patent owner petitioner's time period to submit an Appellant's Brief is extended to run 30 days from the previously extended due date; i.e., through March 3, 2012.

If the petition under § 1.181 has not yet been decided at the point where the time for requester to file an Appellant's Brief becomes less than two weeks prior to the deadline as extended, then petitioner may file a petition for an additional extension of time. In that event, petitioner is advised to contact Michael Cygan at the phone number given below in the contact information to inform the Office that the petition for an additional extension of time is being filed, in order to expedite its review. Petitioner should note for any further request for extension that the Office, by statute, handles all *inter partes* reexamination proceedings with special dispatch, and

¹ See decision issued on November 21, 2011.

therefore the delay resultant to granting a petition extending the time for filing an appellant's brief is weighed the risk of unnecessary expenditure of resources, and that weighing is a strongly fact-specific inquiry.

CONCLUSION

1. The patent owner petition for extension of time filed January 19, 2012 for filing an Appellant's Brief is **granted to the extent stated above.**
2. The time for to file an Appellant's Brief, by either or both of the patent owner or the third party requester, is extended to run **30 days** from the due date; *i.e.*, through March 3, 2012.
3. Telephone inquiries related to this decision should be directed to the undersigned at (571) 272-7700.

/Michael Cygan/

Michael Cygan
Legal Advisor
Office of Patent Legal Administration

January 24, 2011



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,206	08/19/2009	7272021	36856.1613	6964
24197	7590	02/02/2012	EXAMINER	
KLARQUIST SPARKMAN, LLP 121 SW SALMON STREET SUITE 1600 PORTLAND, OR 97204			ART UNIT	PAPER NUMBER

DATE MAILED: 02/02/2012

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Joseph R. Keating
KEATING & BENNETT, LLP
1800 Alexander Bell Drive, Suite 200
Reston, VA 20191

Date:

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FEE 02
CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001206
PATENT NO. : 7272021
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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Klarquist Sparkman, LLP
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Portland, OR 97204

(For Patent Owner)

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FEE 02 2012

CENTRAL REEXAMINATION UNIT

Murata Manufacturing Company, Ltd.
c/o Keating & Bennett, LLP
1800 Alexander Bell Drive
Suite 200
Reston, VA 20191

(For *Inter Partes* Requester)

In re Schlecht et al
Inter Partes Reexamination Proceeding
Control No. 95/001,206
Filed: August 19, 2009
For: U.S. Patent No.: 7,272,021

: **DECISION**
:
: **DISMISSING**
:
: **PETITION**

This is a decision on patent owner's April 1, 2011 combined petition entitled "Petition to Reopen Prosecution and/or Waive Rules (37 CFR §§ 1.182/1.183)" (patent owner's April 1, 2011 combined petition).

This decision also addresses requester's June 8, 2011 opposition paper entitled "Opposition to Petition to Reopen Prosecution and/or Waive Rules (37 CFR §§ 1.182/1.183)" (requester's June 8, 2011 opposition).

Patent owner's April 1, 2011 combined petition, requester's June 8, 2011 opposition, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

SUMMARY

Patent owner's April 1, 2011 combined petition under 37 CFR 1.182 and 1.183 is **dismissed**.

DECISION

The patent owner requests that the Office "waive" the provisions of 37 CFR 41.2 and 41.60 and reopen prosecution in the present proceeding "so that [the patent owner] may compel the production of evidence [under 35 U.S.C. 24] from the relevant parties" and "formally present the evidence to the Patent Office".¹ The patent owner argues that "Congress intended that the Patent Owner would be able to compel the production of evidence from hostile parties (e.g., infringers)", and that "the trial record establishes the existence of substantial evidence [which is under a protective order by the court] that defeats the Requester's allegations of obviousness".

¹ See the first two lines of page 3 and the last four lines of page 11 of the present petition.

As an initial matter, the Office notes that the patent owner has not presented good and sufficient reasons, under 37 CFR 1.181, to reopen prosecution. 35 U.S.C. 314(c) requires that all *inter partes* reexamination proceedings to be acted upon with “special dispatch.” The rules and procedures of the Office were established through notice and comment in order to achieve special dispatch in a reasonable manner. The Office rules and procedures encourage examiners to look at the facts involved in a particular proceeding and to weigh the equities before issuing an action closing prosecution (ACP). The patent owner does not argue, and provides no evidence, that the examiner failed to follow Office policies and procedures in the ACP. The patent owner also does not allege that the ACP was premature. The record shows that the examiner appropriately followed Office rules and procedures in the determination to issue an ACP, and did not categorically deprive the patent owner of its statutory rights to present arguments and evidence in reexamination proceedings.

Patent owner’s argument that prosecution should be reopened appears to be solely based on the allegation that “the interests of justice would be best served” if the provisions of 37 CFR 41.2 and 41.60 were waived, if the patent owner were permitted to compel the requester to produce evidence under 35 U.S.C. 24, and if the patent owner were permitted to present such evidence to the Office. Thus, the present combined petition is taken as:

- 1) a petition under 37 CFR 1.183 to “waive” the provisions of 37 CFR 41.2 and 41.60;
- 2) a petition under 37 CFR 1.182 to authorize discovery in the present *inter partes* reexamination proceeding; and
- 3) a petition under 37 CFR 1.182 to reopen prosecution in the present *inter partes* reexamination proceeding to permit the entry of the discovered evidence.

37 CFR 41.2 provides, in pertinent part:

An appeal in an *inter partes* reexamination proceeding is not a contested case.

37 CFR 41.60 provides, in pertinent part:

An *inter partes* reexamination proceeding is not a contested case subject to part D [which governs interferences].

37 CFR 1.183 permits waiver of “any *requirement* of the regulations . . . which is not a requirement of the statutes . . .”. The above-quoted provisions, however, are *definitions*, not requirements. There is no requirement for the Office to waive. Furthermore, the Office cannot selectively “waive” the definition of any one *inter partes* reexamination proceeding, i.e., that it is not a contested case, while preserving the same definition for other *inter partes* reexamination proceedings, because to do so would be arbitrary and capricious. For this reason, patent owner’s petition under 37 CFR 1.183 to “waive” the relevant provisions of 37 CFR 41.2 and 41.60 is **dismissed**.

The patent owner also requests the Office, under 37 CFR 1.182, to authorize discovery in the present proceeding. Patent owner’s petition is, in essence, a request to review the Office’s interpretation that the *inter partes* reexamination statute does not authorize discovery in *inter*

partes reexamination proceedings, which includes the interpretation that *inter partes* reexamination proceedings are not “contested cases” within the meaning of 35 U.S.C. 24.

35 U.S.C. 24 provides, in pertinent part (emphasis added):

The clerk of any United States court for the district wherein testimony is to be taken for use in any contested case in the Patent and Trademark Office, shall, upon the application of any party thereto, issue a subpoena for any witness residing or being within such district, commanding him to appear and testify before an officer in such district authorized to take depositions and affidavits, at the time and place stated in the subpoena. The provisions of the Federal Rules of Civil Procedure relating to the attendance of witnesses and to the production of documents and things shall apply to contested cases in the Patent and Trademark Office....

The *inter partes* reexamination statute, however, does not authorize discovery in *inter partes* reexamination proceedings. 35 U.S.C. 24 is not applicable to *inter partes* reexamination proceedings.

Optional *inter partes* reexamination was enacted in the American Inventors Protection Act of 1999 (the AIPA). See Public Law 106-113, 113 Stat. 1501, 1501A-552 through 1501A-591 (1999), codified at 35 U.S.C. 311–318. 35 U.S.C. 311–318 provide for the filing of a request for *inter partes* reexamination, the Office’s decision on such a request, an examination stage including Office actions on the merits, patent owner responses to the Office actions, and third-party requester comments (where patent owner responds) addressing issues raised by the Office action and/or the patent owner’s response, an appeal stage, and the issuance of a certificate at the conclusion of the proceedings. The AIPA provided that the patent owner in an *inter partes* reexamination could appeal a decision of the Board of Patent Appeals and Interferences (BPAI) adverse to patent owner to the United States Court of Appeals for the Federal Circuit (Federal Circuit). However, as originally enacted, the AIPA did not permit a third party requester of the *inter partes* reexamination to appeal an adverse decision of the BPAI to the Federal Circuit, and did not provide for third-party-requester participation in an appeal taken by the patent owner to the Federal Circuit. Subsequently, the *21st Century Department of Justice Appropriations Authorization Act* (see Pub. L. 107-273, 116 Stat. 1758, 1899-1906 (2002)) via section 13106, granted the third party requester the rights to (a) appeal an adverse decision of the BPAI to the Federal Circuit (in which appeal the patent owner may participate), and (b) be a party to a patent owner appeal to the Federal Circuit. Such is the extent of third party participation in an *inter partes* reexamination proceeding, as provided by the 1999 and 2002 enactments. An *inter partes* reexamination proceeding is otherwise modeled on *ex parte* proceedings such as initial examination or *ex parte* reexamination, which do not permit discovery. See, e.g., 145 Cong. Rec. H6944 (Aug. 3, 1999) (Statement of Rep. Rohrabacher) (indicating that the AIPA was intended to create a proceeding like *ex parte* reexamination which did “not subject the patent to any greater challenge in scope than currently exists today” but “merely allows a reexam requestor the option to further explain why a particular patent should not have been granted”).

35 U.S.C. 314 prescribes the procedure for the conduct of *inter partes* reexamination proceedings. 35 U.S.C. 314(a) provides, in pertinent part (emphasis added):

Except as otherwise provided in this section, reexamination shall be conducted according to the procedures established for **initial examination** under the provisions of sections 132 and 133.

35 U.S.C. 132 and 133, which govern initial examination, do not provide any basis for the authorization of discovery under 35 U.S.C. 24. The initial examination of a patent application is not a “contested case in the Patent and Trademark Office” within the meaning of 35 U.S.C. 24. Moreover, 35 U.S.C. 305, which includes corresponding provisions governing *ex parte* reexamination, similarly specifies that *ex parte* reexamination “will be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133.” The fact that the same language is used to describe the conduct of *ex parte* reexamination proceedings, which do not provide for discovery, implies that discovery practice is not within the scope of any reexamination proceeding, whether *inter partes* or *ex parte*. Cf. *Rules to Implement Optional Inter Partes Reexamination Proceeding*, 65 Fed. Reg. 76,756, 76,763 (December 7, 2000) (final rule) (“In a very real sense, the intent of reexamination is to start over and reexamine the patent and examine new and amended claims *as they would have been examined in the original application of the patent.*”) (emphasis added).

35 U.S.C. 314(b) provides for service of parties and for the submission of written comments by the third party requester after a patent owner response during the examination stage. Third party requester’s written comments must be filed within thirty days of the date of service of patent owner’s response. There is no authorization for discovery. Furthermore, it would be impracticable, if not impossible, for the parties to conduct discovery, for the court to resolve any discovery disputes, and for the third party requester to prepare and submit its written comments within the thirty-day period set by statute. The fact that Congress required the third party requester to file written comments within a thirty-day period provides evidence that Congress did not intend to authorize discovery practice in *inter partes* reexamination proceedings.

Both 35 U.S.C. § 314(c), which governs *inter partes* reexamination, and 35 U.S.C. § 305, which governs *ex parte* reexamination, provide that reexamination in *inter partes* reexamination and in *ex parte* reexamination proceedings, respectively, will be conducted with “special dispatch” within the Office. Neither the statute nor the regulations define special dispatch; however, in *Ethicon v. Quigg*, 849 F.2d 1422, 7 USPQ2d 1152 (Fed. Cir. 1988), the Federal Circuit explained:

“Special dispatch” is not defined by statute. . . . According to Webster’s New World Dictionary, special means distinctive, unique, exceptional or extraordinary, and dispatch means to finish quickly or promptly. Consequently, the ordinary, contemporary and common meaning of special dispatch envisions some type of unique, extraordinary or accelerated movement. In fact, the PTO itself has interpreted special dispatch to require that ‘reexamination proceedings will be “special” through their pendency’ in the office and provides for an accelerated schedule. MPEP § 2261.

Ethicon, 849 F.2d at 1426.

Any provision for discovery would necessarily prolong proceedings before the Office. The time needed to conduct the discovery, the additional, extensive consideration by the Office of that

discovery, and the resolution of any issues, would be contrary to the statutory mandate for special dispatch. If Congress had intended for discovery to be permitted in *inter partes* reexamination proceedings, rather than in *ex parte* reexamination proceedings, Congress would have expressly provided for such a practice, and it would have circumscribed the discovery in a manner consistent with the statutory requirement for “special dispatch.” Thus, the statutory requirement for special dispatch clearly provides evidence that Congress did not contemplate discovery for *inter partes* reexamination proceedings. Regarding the sole exception to the “special dispatch” requirement in the statute, i.e., a finding of “good cause” by the Director, the Office has not authorized an exception to the “special dispatch” provision for the purposes of permitting discovery, and is not authorized to do so, given the above-discussed provisions of 35 U.S.C. 314(a) and (b)(2).

The above interpretation of the *inter partes* reexamination provisions is consistent with their legislative history. The legislative history makes no mention of discovery, and consistently expresses a concern for providing a low-cost, efficient alternative to litigation, in which a third party requester has the ability to participate by submitting comments, in writing, to the examiner, in response to arguments made by the patentee. See, e.g., H.R. Rep. No. 106-287, 106th Cong., 1st Sess. 31, (1999) (Submitted by Rep. Coble) (“The existing patent reexamination system is an ineffective means for bringing relevant prior art unavailable to examiners during their search to the attention of the PTO due to the *ex parte* nature of the proceeding.”); 145 Cong. Rec. S14720, (Nov. 17, 1999) (Statement of Senator Lott) (“Subtitle F is intended to reduce expensive patent litigation in U.S. district courts by giving third-party requesters, in addition to the existing *ex parte* reexamination in Chapter 30 of title 35, the option of *inter partes* reexamination proceedings in the USPTO. Congress enacted legislation to authorize *ex parte* reexamination of patents in the USPTO in 1980, but such reexamination has been used infrequently since a third party who requests reexamination cannot participate at all after initiating the proceedings. Numerous witnesses have suggested that the volume of lawsuits in district courts will be reduced if third parties can be encouraged to use reexamination by giving them an opportunity to argue their case for patent invalidity in the USPTO. Subtitle F provides that opportunity as an option to the existing *ex parte* reexamination proceedings.”).

It is clear that the Office’s construction of the statute has consistently been that the *inter partes* reexamination provisions do not authorize discovery. In response to a reporting requirement of the AIPA (see AIPA, Pub. L. 106-113, 1501A-571, § 4606 (1999)), the Office conducted a “round table meeting” to receive views on the effectiveness and possible improvement of *inter partes* reexamination and then drafted a report to Congress. The report points out that “the lack of such procedural mechanisms as discovery and cross-examination that would be available in litigation has apparently resulted in challengers being unwilling to invoke *inter partes* reexamination and risk its estoppel effect.” *United States Patent And Trademark Office Report To Congress On Inter Partes Reexamination* (2004) (available at http://www.uspto.gov/web/offices/dcom/olia/reports/reexam_report.htm), at 4; see also Transcript of February 17, 2004 Roundtable Meeting (available at http://www.uspto.gov/web/offices/pac/dapp/opla/comments/reexamproceed/round_tbl_transcript.pdf) at 20-21 (discussing the lack of discovery in *inter partes* reexamination). The report contrasts *inter partes* reexamination to a proposed “post-grant review process,” in which “[c]losely controlled discovery and cross-examination would be available in the review, upon the challenger’s presenting sufficient grounds that one or more of the patent claims are

unpatentable.” Id. at 8. Accordingly, the public and the Office understood that discovery was not available in *inter partes* reexamination, and that additional legislation would be required to provide for such discovery.

In this regard, on September 16, 2011, Congress enacted The America Invents Act (the AIA), which, replaces *inter partes* reexamination with a new proceeding titled *inter partes* review, effective September 16, 2012. The statute expressly provides for discovery in newly enacted 35 U.S.C. § 316 (conduct of *inter partes* review), which instructs the Director to “prescribe regulations . . . setting forth standards and procedures for discovery of relevant evidence, including that such discovery will be limited to (A) the deposition of witnesses submitting affidavits or declarations; and (B) what is necessary in the interests of justice.” See Pub. L. No. 112-29, Section 6. The legislative history of the new proceeding confirms that Congress intended to provide discovery where none had previously been available:

The Act converts *inter partes* reexamination from an examinational to an adjudicative proceeding, and renames the proceeding “*inter partes* review.” The Act also makes the following improvements to this proceeding:

....

- Discovery. Parties may depose witnesses submitting affidavits or declarations and seek such discovery as the Patent Office determines is otherwise necessary in the interest of justice.

H. Rep. No. 112-98 (Part 1) 112th Cong., 1st Sess., at 46-47 (2011) (available at <http://www.gpo.gov/fdsys/pkg/CRPT-112hrpt98/pdf/CRPT-112hrpt98-pt1.pdf>).

Congress’s characterization of the provision for limited discovery in *inter partes* review as an “improvement” over *inter partes* reexamination settles any dispute concerning the proper interpretation of the *inter partes* reexamination statute. The AIPA does not authorize discovery in *inter partes* reexamination proceedings.

Furthermore, an *inter partes* reexamination proceeding is not a contested case. The Office’s interpretation of 35 U.S.C. 314 to exclude authorization for discovery in *inter partes* reexamination proceedings, including the interpretation that *inter partes* reexamination proceedings are not “contested cases” within the meaning of 35 U.S.C. 24, is confirmed by the Office’s promulgation of rules specifically governing discovery for interferences, while none were drafted for *inter partes* reexamination proceedings. See, e.g., 37 CFR 41.150(a), which states: “[a] party is not entitled to discovery except as authorized in this subpart”. If Congress intended to permit discovery in *inter partes* reexamination proceedings, it would have modeled *inter partes* reexamination proceedings on interferences, which are contested cases, and not on proceedings such as initial examination or *ex parte* reexamination, which are not contested cases, and which do not include discovery.

Finally, in quashing a subpoena served by the patent owner on the requester in merged *inter partes* reexamination proceeding control numbers 95/000,542 and 95/000,552 (“the merged proceeding”), the district court for the Eastern District of Virginia recently determined that an *inter partes* reexamination proceeding is not a contested case, and that discovery is not permitted in *inter partes* reexamination proceedings. See *Abbott Labs. v. Cordis Corp.*, Civil Action No.

1:11-MC-421, Order (E.D. Va. Jan. 20, 2012) (Hilton, J.), *aff'g* Order (Anderson, Mag. J.) (granting motion to quash); see Hr'g Tr. at 19-20 (E.D. Va. Dec. 9, 2011) (agreeing with the Office's December 7, 2011 final agency action in the merged proceeding when explaining reasons for granting motion to quash). See also the December 7, 2011 final agency action (in the merged proceeding) denying a petition by the patent owner (in that merged proceeding) requesting the Office to authorize the patent owner to compel discovery in that proceeding.

In summary, discovery in an *inter partes* reexamination proceeding is not permitted by the *inter partes* reexamination statute, or by any regulation governing *inter partes* reexamination proceedings. 35 U.S.C. 24 is not applicable to *inter partes* reexamination proceedings. Accordingly, patent owner's petition under 37 CFR 1.182 to authorize discovery in the present *inter partes* reexamination proceeding, is **dismissed**. Given this dismissal, patent owner's petition under 37 CFR 1.182 to reopen prosecution in order to enter the discovered evidence is **dismissed as moot**.

The patent owner states that the evidence which patent owner wishes to obtain by discovery is subject to a June 19, 1999 protective order by the court in *SynQor, Inc. v. Artesyn Technologies, Inc., et al*, Civil Action No. 2-07-CV-497-TJW-CE (E.D. Tex.). Even if the patent owner were to obtain the evidence desired, the Office would not review, permit the entry of, or otherwise consider such evidence, because the Office would not violate the court's protective order, also as argued by the requester. In order for such evidence to be entered and considered by the Office, the patent owner must provide evidence that the requester has consented to a waiver of the court's protective order, and that the court has granted such a waiver. The patent owner has apparently not obtained the requester's consent in view of the requester's argument, in its June 8, 2011 opposition, that the court's protective order "remains in full force and effect to this day", and that the Office cannot grant the patent owner the authority to violate the court's order. The patent owner must explain, in any response to this decision, why the patent owner believed, at the time of filing the present petition, that it would not be a violation of the court's protective order if the Office were to grant the present petition.

The patent owner has recourse through the court to request the court's permission to submit the necessary materials in this proceeding, also as argued by the requester. Therefore, there are adequate remedies to address this situation.

The patent owner further states that documents, which are designated as exhibits D and E and which are attached to the present petition, were subject to the court's protective order, but were made public at trial by the requester. The patent owner also states that additional documents, which were filed in a notice of concurrent proceedings along with patent owner's March 21, 2011 response, were also subject to the court's protective order, but were presented at trial by the requester's expert witness, Dr. Leeb. The patent owner has not, for example, provided *evidence* that these documents were made public by the requester, or that requester has consented to a waiver of the court's protective order with respect to these documents. However, the requester has had over ten months to object to the filing of the documents in the notice of concurrent proceedings, and nearly nine months to object to the filing of the documents attached to the present petition as exhibits D and E, during which time the requester has filed comments on April 20, 2011 on patent owner's March 21, 2011 response, and has filed its June 8, 2011 opposition to the present petition. To date, the requester has not presented any arguments that

any of these documents are still under the court's protective order. For this reason, these documents will remain in the file, and will not be sealed. However, if any of these documents remain under the court's protective order, the parties are required to inform the Office immediately.

In view of the above, patent owner's April 1, 2011 combined petition under 37 CFR 1.183 to "waive" the relevant provisions of 37 CFR 41.2 and 41.60, and under 37 CFR 1.182 to authorize discovery, and to reopen prosecution, is **dismissed**.

A decision on patent owner's October 7, 2011 petition entitled "Renewed Petition to Stay *Inter Partes* Re-examination (37 CFR 1.182)" will be separately mailed in due course.

CONCLUSION

- Patent owner's April 1, 2011 combined petition under 1.182 and 1.183 is **dismissed**.
- This proceeding is being referred to the Central Reexamination Unit, for treatment of the October 3, 2011 petition entitled "Petition for Entry of Amendment after ACP (37 CFR §§ 1.181)".
- Any inquiry concerning this communication should be directed to Cynthia Nessler, Senior Legal Advisor, at (571) 272-7724.



Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,206	08/19/2009	7272021	36856.1613	6964
24197	7590	02/10/2012	EXAMINER	
KLARQUIST SPARKMAN, LLP 121 SW SALMON STREET SUITE 1600 PORTLAND, OR 97204			ART UNIT	PAPER NUMBER

DATE MAILED: 02/10/2012

Please find below and/or attached an Office communication concerning this application or proceeding.



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Joseph R. Keating
KEATING & BENNETT, LLP
1800 Alexander Bell Drive, Suite 200
Reston, VA 20191

Date:

MAILED

FEB 10 2012

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001206
PATENT NO. : 7272021
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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Klarquist Sparkman, LLP
121 S.W. Salmon Street
Suite 1600
Portland, OR 97204

(For Patent Owner)

MAILED

FEB 10 2012

CENTRAL REEXAMINATION UNIT

Murata Manufacturing Company, Ltd.
c/o Keating & Bennett, LLP
1800 Alexander Bell Drive
Suite 200
Reston, VA 20191

(For Third Party Requester)

In re Schlecht et al
Inter partes Reexamination Proceeding
Control No: 95/001,206
Filing Date: August 19, 2009
For: U.S. Patent No.: 7,272,021

DECISION
DISMISSING
PETITION

This is a decision on patent owner's October 7, 2011 petition, entitled "Renewed Petition to Stay *Inter Partes* Reexamination (37 CFR 1.182)" (patent owner's October 7, 2011 renewed petition).

This decision also addresses requester's October 27, 2011 opposition paper, entitled "Opposition to Renewed Petition to Stay *Inter Partes* Reexamination (37 CFR 1.182)" (requester's October 27, 2011 opposition).

Patent owner's October 7, 2011 renewed petition, requester's October 27, 2011 opposition, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

SUMMARY

Patent owner's October 7, 2011 renewed petition is **dismissed** as untimely. The present *inter partes* reexamination proceeding **will continue**, and **will not be suspended**.

DECISION

The patent owner requests the Office to suspend the present *inter partes* reexamination proceeding.

MPEP 2686.04 provides, in pertinent part (emphasis added):¹

[35 U.S.C. 314(c)]² thus authorizes the Director of the USPTO **to suspend (stay) reexamination proceedings, where there is good cause to do so**, pending the conclusion of litigation based on a potential for termination of a reexamination prosecution under 35 U.S.C. 317(b). Thus, a District Court decision that is pending appeal on the validity of the same claims considered in an *inter partes* reexamination proceeding may provide the requisite statutory “good cause” for suspension, due to the real possibility that the 35 U.S.C. 317(b) estoppel may attach in the near future to bar/terminate the reexamination proceeding.

*

*

... **[S]uspension will not be considered on its merits when there is an outstanding Office action.**

To have a petition to suspend a reexamination proceeding considered, the patent owner must file any required response to an outstanding Office action either prior to, or concurrent with, its petition. The Office will not consider on the merits a petition to suspend a reexamination proceeding when such a response by the patent owner is due.

In the present reexamination proceeding, a right of appeal notice (RAN) was issued by the Office on September 2, 2011, after which a notice of appeal was filed by the patent owner on October 3, 2011.³ Patent owner's appellant's brief is due. The Office will not consider on the merits the present renewed petition to suspend the instant reexamination proceeding when patent owner's appellant's brief is due, also as argued by the requester in its October 27, 2011 opposition.

Accordingly, patent owner's October 7, 2011 renewed petition under 37 CFR 1.182 to suspend the present reexamination proceeding is **dismissed** as untimely. Pursuant to MPEP 2686.04, the present *inter partes* reexamination proceeding **will continue**, and **will not be suspended**.

¹ See particularly, MPEP 2686.04, subsections II(B) and III.

² 35 U.S.C. 314(c) provides, in pertinent part (emphasis added):

Unless otherwise provided by the Director for good cause, all *inter partes* reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, shall be conducted with special dispatch within the Office.

³ The patent owner has filed three consecutive petitions under 37 CFR 1.183 to extend the time period for filing an appellant's brief, arguing that no decision has yet to be rendered on patent owner's petitions (1) under 37 CFR 1.182 and 1.183 to reopen prosecution, filed on April 1, 2011; and (2) under 37 CFR 1.181 to enter an amendment after action closing prosecution (ACP), filed on October 3, 2011. Each of the patent owner's three petitions to extend the time period for filing its appellant's brief have been granted. A decision dismissing patent owner's petition under 37 CFR 1.182 and 1.183 has been mailed. The Office's most recent decision, mailed on January 25, 2012, granted patent owner's petition to extend the time period for filing its appellant's brief on the basis that a decision on patent owner's petition under 37 CFR 1.181 to enter an amendment after ACP has not yet been rendered.

Additional Comments

Even if the present renewed petition were timely filed, however, the present renewed petition would not be granted because the patent owner has not provided a showing of good cause to suspend the prosecution of the present reexamination proceeding.

Factors to be considered in determining whether it is appropriate to suspend action in the reexamination are:

- A. Whether the third party requester is a party to the litigation;
- B. Whether the claims in suit are identical to the claims under reexamination;
- C. Whether the issue(s) raised in the reexamination proceeding are the same issue(s) that were raised or could have been raised by the requester in the litigation;
- D. Whether the litigation has advanced to a late enough stage that there is a sufficient probability that a final decision will be adverse to the requester; and
- E. Whether there is a concurrent *ex parte* reexamination proceeding for the patent.

In its June 4, 2011 decision dismissing patent owner's initial petition to suspend the present reexamination proceeding, the Office determined that elements A and E have been satisfied.

Regarding element D, the patent owner argues that the proceedings in the district court have concluded, and that the district court has entered a judgment on the jury verdict. To date, however, the patent owner has not pointed to any written evidence that an appeal has been filed with the Federal Circuit, or that the time for filing all appeals has expired. For this reason, the patent owner has not shown that litigation has advanced to a late enough stage that there is a sufficient probability that a final decision will be adverse to the requester. Thus, item D has not been shown to have been satisfied.

See also *Sony Computer Entertainment America, Inc. v. Dudas*, 85 USPQ2d 1594 (E.D. Va. 2006), where the court upheld the Office's determination of "good cause" to suspend two related *inter partes* reexamination proceedings. The facts of the present case, however, are clearly distinguishable from Sony. In Sony, the request for *inter partes* reexamination was not filed until after a final judgment in the district court was rendered. In the present case, however, the request for *inter partes* reexamination was filed well before trial began. Furthermore, unlike Sony, the Office has already issued a right of appeal notice rejecting all of the patent claims under reexamination and an appeal to the Board of Patent Appeals and Interferences (BPAI) has been filed; while in Sony, an action on the merits had not yet issued by the Office. Also, in Sony, an appeal to the Federal Circuit had been filed and had been fully briefed. Thus, a final decision in Sony was on the horizon. In the present case, however, the patent owner has not shown that an appeal to the Federal Circuit has been filed, or that the time for filing all appeals has expired. In other words, the patent owner has not shown that a final decision is expected in the near future. And, without a final decision adverse to requester, no estoppel can attach to bar the filing of an *inter partes* reexamination request or to mandate termination of an ordered reexamination

proceeding. Stated another way, the fact that estoppel could possibly attach at some uncertain point in the future, as argued by patent owner, does not provide the requisite showing of good cause for suspension.

Regarding elements B and C, because the present renewed petition is being dismissed as untimely, and further because element D has not been shown to have been satisfied, the Office need not, at the present time, address the issue of whether the claims at issue in the reexamination are identical to those in the litigation, and need not reconsider whether the issue(s) raised in the reexamination proceeding are the same issue(s) that were raised or could have been raised by the requester in the litigation.⁴

In summary, even if the present renewed petition were timely filed, it would not be granted because the patent owner has not provided a showing of good cause to suspend prosecution of the present reexamination proceeding.

CONCLUSION

- The October 7, 2011 patent owner renewed petition is **dismissed** as untimely.
- The present *inter partes* reexamination proceeding **will continue**, and **will not be suspended**.
- Telephone inquiries related to this decision should be directed to Cynthia L. Nessler, Senior Legal Advisor, at (571) 272-7724.



Brian E. Hanlon
Director
Office of Patent Legal Administration

29 2012

⁴ The June 4, 2011 decision determined that element C, i.e., whether the issue(s) raised in the reexamination proceeding are the same issue(s) that were raised or could have been raised by the requester in the litigation, had been shown to have been satisfied. However, should the patent owner timely file a second renewed petition to suspend the present reexamination proceeding, the Office reserves its option to reconsider this issue.



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24197	7590	02/13/2012		
KLARQUIST SPARKMAN, LLP 121 SW SALMON STREET SUITE 1600 PORTLAND, OR 97204				
			EXAMINER	
			ART UNIT	PAPER NUMBER

DATE MAILED: 02/13/2012

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Joseph R. Keating
KEATING & BENNETT, LLP
1800 Alexander Bell Drive, Suite 200
Reston, VA 20191

Date:

MAILED

FEB 13 2012

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001206
PATENT NO. : 7272021
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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KLARQUIST SPARKMAN, LLP
121 SW SALMON STREET
SUITE 1600
PORTLAND, OR 97204

: (For Patent Owner)
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FEB 13 2012

CENTRAL REEXAMINATION UNIT

KEATING & BENNETT, LLP
1800 ALEXANDER BELL DRIVE
SUITE 200
RESTON, VA 20191

: (For Third Party
: Requester)
:
:
:

In re: Schlecht et al.

Inter Partes Reexamination Proceeding

Control No.: 95/001,206

Deposited: August 19, 2009

For: U.S. Patent No.: 7,272,021

:
: DECISION ON PETITION
: UNDER 37 CFR § 1.181
:
:

This is a decision on a petition filed by the patent owner on October 3, 2011 entitled:
"PETITION FOR ENTRY OF AMENDMENT AFTER ACP (37 CFR §§ 1.181)" [hereinafter
"the petition"].

The petition is a request to the Director to exercise his supervisory authority pursuant to 37 CFR
§ 1.181 to enter an amendment that was denied entry by the examiner.

The petition is before the Director of the Central Reexamination Unit. The petition is denied.

REVIEW OF RELEVANT FACTS

- U.S. Patent No. 7,272,021 issued on September 18, 2007.
- A request for *inter partes* reexamination was filed on August 19, 2009 and assigned control no. 95/001,206.
- *Inter partes* reexamination was ordered on October 15, 2009 and progressed until an Action Closing Prosecution [“ACP”] was mailed February 18, 2011.
- On March 21, 2011, patent owner filed a response to the ACP along with a proposed amendment. The amendment proposed adding new claims 49-51.
- On September 2, 2011, the examiner issued a Right of Appeal Notice. The examiner denied entry of the post-ACP amendment for five reasons.
- On October 3, 2011, patent owner filed the instant petition requesting entry of proposed new claims 49-50 only.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

37 CFR § 1.951 Options after Office action closing prosecution in *inter partes* reexamination (in part):

- (a) After an Office action closing prosecution in an *inter partes* reexamination, the patent owner may once file comments limited to the issues raised in the Office action closing prosecution. The comments can include a proposed amendment to the claims, which amendment will be subject to the criteria of § 1.116 as to whether or not it shall be admitted.

37 CFR § 1.116 Amendments and affidavits or other evidence after final action and prior to appeal (in part):

- (b) After . . . an action closing prosecution (§ 1.949) in an *inter partes* reexamination filed under § 1.913, but before or on the same date of filing an appeal (§ 41.31 or § 41.61 of this title):

- (1) An amendment may be made canceling claims or complying with any requirement of form expressly set forth in a previous Office action;
- (2) An amendment presenting rejected claims in better form for consideration on appeal may be admitted; or
- (3) An amendment touching the merits of the application or patent under reexamination may be admitted upon a showing of good and sufficient reasons why the amendment is necessary and was not earlier presented.

DECISION

Patent owner ["petitioner"] argues that that the post-ACP amendment should have been entered by the examiner. In the amendment petitioner proposed adding three new claims. New claim 49 depends from claim 1 and further requires "wherein the regulation stages are switching regulators." New claim 50 depends from claim 1 and further requires "wherein the regulation stages are switching regulators, wherein the DC power source provides a voltage within the range of 36 to 75 volts, and wherein the regulation stage output is of a voltage level to drive logic circuitry." New claim 51 was an independent claim. Petitioner apparently withdraws the addition of new claim 51 in the petition.

The examiner declined entry, stating that the amendment (1) does not comply with 37 CFR § 1.530(f) as the claims are not underlined; (2) does not comply with 37 CFR § 1.530(e) as no support was shown in the disclosure, only in the parent; (3) raises issues of broadening under 35 U.S.C. § 314, as proposed claim 51 enlarges the scope of the claims of the patent; (4) does not comply with 37 CFR § 1.116(b) because the explanation as to why the amendment was necessary and not earlier presented was not sufficient; and (5) the amendment does not further prosecution by proposing the addition of new claims that have not before been considered. RAN pp. 2-5. Without conceding anything as to the propriety of petitioner's other arguments, this decision focuses only on reason (4).

An amendment after ACP must comply with one of 37 CFR 1.116(b)(1)-(3). Subsection (1) is clearly inapplicable as the amendment does more than cancel claims. Subsection (2) is also inapplicable as petitioner has not provided any argument, either in the petition or in the original post-ACP response, as to why the amendment presents the claims in better form for appeal.

As to 37 CFR § 1.116(b)(3), petitioner argued in its post-ACP response: (a) the prior response was filed prior to the claim construction order in concurrent litigation; (b) the examiner cited that

order to support her claim construction; (c) it could not have proposed an amendment previously, or the third party/defendant in litigation would have cited that amendment as evidence of the scope of the claim; and (d) petitioner believes that the court's construction is incorrect, but it should be permitted to make the claims consistent with its previous argument as to what it believes is the correct interpretation of the claims. Response filed March 21, 2011 at p. 47. The examiner in the RAN stated that these arguments show that the amendment was not made previously for strategic litigation purposes, therefore there is insufficient reasoning as to why the amendment could not have been presented earlier.

Petitioner responds that the examiner has mischaracterized the requirements of section 1.116 and it would be impossible for any claim to pass the examiner's standard. Petitioner further argues it would have been illogical for it to amend the claims prior to the court's resolution of the claim construction dispute as the amendment would have contradicted petitioner's position in litigation.

Regardless of the exact wording used by the examiner, her finding that the post-ACP amendment did not comply with section 1.116(b)(3) was not improper. Petitioner has not made a showing of good and sufficient reasons why its amendment was necessary and not earlier presented. Petitioner's argument is that the amendment was necessary to explicitly incorporate its claim construction arguments into the claims. It argues that it could not make the amendment earlier because it would have been inconsistent with its claim construction arguments, both in the Office and in litigation, and that making an amendment previously would have been used against it by the defendant in litigation.

Such arguments are not persuasive as providing good and sufficient reasons why the amendment is necessary and was not earlier presented. The examiner was correct in concluding that all this tells us is that earlier in prosecution patent owner made a choice—that it would argue claim construction, rather than amending its claims. Only after the court disagreed with patent owner did it decide to amend the claims—after the close of prosecution. Patent owner's "good and sufficient" reason is, essentially, "I wanted to convince the examiner without amendment earlier; only after that failed did I decide to file an amendment." If this were the standard, a patent owner would never have to amend in response to a first Office action; it could merely argue claim constructions, and then add amendments if needed later, after the close of prosecution.

It is also unpersuasive that it would have been "illogical" to argue a narrow construction and at the same time present an amendment seemingly inconsistent with that argument. A patent will typically have various claims of varying scopes, and sometimes claims may not be consistent. The Director sees no reason why patent owner's addition of, say, claim 49 would have been illogical previously. Patent owner could easily have couched any such prior amendment in the terms that it was merely making explicit what was already implicit, while maintaining that it believed its construction of the independent claim to be correct. A court would no doubt take

such statements into consideration when construing the corresponding claims, considering claim differentiation, etc. *See Univ. of Cal. v. DakoCytomation Cal., Inc.*, 85 USPQ2d 1929, 1936 (Fed. Cir. 2008) (holding that doctrine of claim differentiation is only a presumption and may be overcome by the prosecution history). Again, this appears to have been more of a tactical choice, that petitioner believed its position would look more favorable if it did not amend the claims. Once the court construed the claims this became less important, so it was willing to amend.

Finally, it is unpersuasive that the defendant would have seized upon any amendment as proof that patent owner's "down converter" was not defined in the specification. Once again, petitioner is clearly admitting that patent owner based its decision not to amend on how the amendment might be perceived in litigation. Frankly, the Office is not concerned with how an amendment might potentially be characterized in litigation or how it would look to the court. The Office's duty here is to resolve the questions of patentability raised by the requester, and to do so with special dispatch. 35 U.S.C. §§ 313-314. In carrying out this duty, the Office is not terribly concerned with how patent owner's actions in this proceeding might affect other proceedings in other tribunals.

Patent owner is requesting additional examination of new claims after the close of prosecution. It has progressed in this manner for reasons seemingly based entirely on litigation strategy, so that its arguments in court would not potentially be hampered by claim amendments. There is nothing inherently wrong with patent owner's litigation strategy, but as with most things it has its downside. That downside here is that the Director finds that these reasons for withholding the amendment until after the close of prosecution, reasons based solely on litigation strategies, are not "good and sufficient reasons why the amendment is necessary and was not earlier presented." 37 CFR § 1.116(b)(3).

Thus, upon review of the entire record, the examiner appropriately applied Office policies and procedures in determining that the post-ACP amendment should not be entered. The amendment has not been shown to satisfy any of the requirements for entry of 37 CFR § 1.116(b). For the reasons set forth above, it is deemed that the examiner followed Office rules and procedures and did not abuse her discretion in declining entry of the post-ACP amendment filed March 21, 2011. The petition is denied.

CONCLUSION

1. The petition filed October 3, 2010 is denied. The amendment post-ACP is not entered.

2. Telephone inquiries related to this decision should be directed to Mark Reinhart, Supervisory Patent Examiner, at (571) 272-1611 or in his absence to the undersigned at (571) 272-0700.



Irem Yucel
Director, Central Reexamination Unit



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,207	08/19/2009	7072190	36856.1759	6970
24197	7590	08/16/2010		
KLARQUIST SPARKMAN, LLP 121 SW SALMON STREET SUITE 1600 PORTLAND, OR 97204				
			EXAMINER	
			ART UNIT	PAPER NUMBER

DATE MAILED: 08/16/2010

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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/001,207	08/19/09	7072190	36856.1759

MURATA MANUFACTURING COMPANY, LTD
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EXAMINER
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ART UNIT	PAPER
3992	

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DATE MAILED:
AUG 16 2010

CENTRAL REEXAMINATION UNIT

**INTER PARTES REEXAMINATION
COMMUNICATION**

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All correspondence relating to this *inter partes* reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of this communication.



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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/001,207	08/19/09	7072190	36856.1759

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INTER PARTES REEXAMINATION COMMUNICATION

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(For Patent Owner)

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AUG 16 2010

CENTRAL REEXAMINATION UNIT

KEATING & BENNETT, LLP
1800 ALEXANDER BELL DRIVE, SUITE 200
RESTON, VA 20191

(For Third Party Requester)

Inter Partes Reexamination Proceeding
Control No. 95/001,207
Filed: August 19, 2009
For: U.S. Patent No. 7,072,190

: **DECISION GRANTING**
: **PETITION AND**
: **SUA SPONTE**
: **WAIVING PAGE LIMIT**

This is a decision on patent owner's petition paper entitled "PETITION UNDER 37 C.F.R. § 1.183 TO WAIVE PAGE LIMIT SET BY 37 C.F.R. § 1.943(B)" filed on July 13, 2010.

The patent owner petition is before the Office of Patent Legal Administration.

The petition fee of \$400.00 pursuant to 37 CFR 1.17(f) for the petition under 37 CFR 1.183 was processed on June 14, 2010.

The patent owner petition under 37 CFR 1.183 is granted, for the reasons set forth herein.

BACKGROUND

1. On July 4, 2006, United States Patent No. 7,072,190 (the '190 patent) issued to Schlecht.
2. On July 14, 2009, a request for *inter partes* reexamination of the '190 patent was filed by a third party requester. The request was assigned Reexamination Control No. 95/001,207 (the '1207 proceeding).
3. On August 19, 2009, a corrected request for *inter partes* reexamination was filed by the third party requester, and the '1207 proceeding was assigned a filing date of August 19, 2009.
4. On November 13, 2009, *inter partes* reexamination was ordered in the '1207 proceeding.
5. On April 13, 2010, a non-final Office action was mailed in the '1207 proceeding.

6. On May 10, 2010, patent owner filed a request for extension of time to file its response to the April 13, 2010 Office action.
7. On May 13, 2010, the Office mailed a decision granting patent owner's April 13, 2010 request for extension of time and extending the time period for patent owner's response by one month to July 13, 2010.
8. On July 13, 2010, patent owner filed the instant petition entitled "PETITION UNDER 37 C.F.R. § 1.183 TO WAIVE PAGE LIMIT SET BY 37 C.F.R. § 1.943(B)" (petition under 37 CFR 1.183), concurrently with a patent owner response to the April 13, 2010 Office action. This petition is the subject of the present decision.

DECISION

I. Relevant Authority

37 CFR 1.183 provides:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 CFR 1.943(b) provides:

Responses by the patent owner and written comments by the third party requester shall not exceed 50 pages in length, excluding amendments, appendices of claims, and reference materials such as prior art references.

II. Patent Owner Petition Under 37 CFR 1.183

Patent owner's July 13, 2010 petition under 37 CFR 1.183, requesting waiver of the 50-page limit of 37 CFR 1.943(b) for its concurrently-filed response to the April 13, 2010 Office action, has been fully considered.

37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party. The burden is on petitioner to set forth with specificity the facts that give rise to an extraordinary situation in which justice requires suspension of a rule. A showing which petitioner can make in support of a request for waiver of the 50-page limit of 37 CFR 1.943(b) can be an attempt to draft a patent owner's response in compliance with the 50-page limit, and submission of a resulting response that is in excess of 50 pages concurrently with a

petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b), requesting entry of the submitted response. Such a response can be evaluated for economizing, extraneous material, and arrangement, without repetition of information already of record. In this way, petitioner can rely on the proposed response: (1) for justification that more pages are needed to complete the response, and (2) to set forth an accurate determination of exactly how many additional pages are needed to complete the response.

In the instant petition under 37 CFR 1.183, patent owner requests that the page limit for patent owner's response to the April 13, 2010 Office action be waived. Patent owner states that the July 13, 2010 response "totals less than seventy-five pages of argument (excluding reference materials, the listing of claims, and fact declarations),"¹ and asserts that its response is "not excessive in view of the effective length of the Office Action."²

In support of waiver of 37 CFR 1.943(b), patent owner states that "the Examiner mailed a non-final office action . . . that incorporated by reference the bulk of the arguments in the Requester's Request for Reexamination, effectively resulting in an office action comprising more than 150 pages of rejections split into ten 'issues.'"³ The patent owner asserts that "[i]t is not realistic that a patent owner could fairly address the scope of rejections adopted by the Examiner in less than one third of the space than was used [to] set forth the reasoning for the rejections."⁴ In particular, patent owner states that, under 37 CFR 1.111(b), it "must address every ground of rejection," that "the Examiner set forth a total of ten issues involving all 33 claims of the patent," and that patent owner is "required to respond to each claim rejection with more than a bald traversal of each rejection."⁵ Patent owner further asserts that it is "entitled to present evidence of secondary considerations of non-obviousness, which are extensive in this case" and that "[w]hile the reference materials themselves do not appear to be subject to the fifty page limit, it requires many pages to place these references in context."⁶

Based on the specific facts set forth in the petition under 37 CFR 1.183, such as, for example, the size of the April 13, 2010 Office action, patent owner's showing in support of the request for waiver of the 50-page limit of 37 CFR 1.943(b) by attempting to draft a response in compliance with the 50-page limit and submitting the resulting response (which is in excess of 50 pages), and the individual facts and circumstances of this case, it is deemed equitable to waive the 50-page limit of 37 CFR 1.943(b) in this instance.

The total number of pages of patent owner's July 13, 2010 response that count toward the page limit is 71 pages.⁷ The substantive portion of the April 13, 2010 Office action has been

¹ Petition under 37 CFR 1.183 at page 3.

² Id.

³ Petition under 37 CFR 1.183 at page 2.

⁴ Petition under 37 CFR 1.183 at page 3.

⁵ Id.

⁶ Id.

⁷ Pursuant to MPEP 2667(I)(A)(2), only those pages of patent owner's response upon which arguments appear are included against the page limit count. The remarks portion of the July 13, 2010 response includes 71 pages of arguments. The July 13, 2010 response also includes 2 declarations under 37 CFR 1.132 (the Schlecht and Pellikaan declarations). As set forth in MPEP 2667(I)(A)(2), affidavits or declarations that are excluded from the page limit requirements include, for example, declarations that provide comparative test data and an analysis of same. Further,

determined to span approximately 184 pages.⁸ Thus, it is deemed equitable in this instance to waive the 50-page limit of 37 CFR 1.943(b) to the extent that patent owner's response to the April 13, 2010 Office action not exceed 71 pages. Accordingly, patent owner's petition under 37 CFR 1.183 is granted and the page limit of 37 CFR 1.943(b) is waived to the extent of permitting patent owner's response to the April 13, 2010 Office action to exceed the page limit by up to 21 pages. This waiver makes patent owner's July 13, 2010 response page-length compliant.

III. Time Period and Page Limit for Submission of Third Party Requester Comments

This decision, *sua sponte*, waives the provisions of 37 CFR 1.943(b) to the extent that any written comments by third party requester filed in response to patent owner's response as set forth in this decision shall not exceed 71 pages in length, excluding reference materials, such as prior art references. **This waiver is conditional on the submission being in at least 12 point font and one-and-a-half or double spaced, with appropriate margins.** Requester has 30 days from the mailing date of this decision, granting patent owner's petition under 37 CFR 1.183 and making patent owner's July 13, 2010 response page-length compliant, to file a comments paper pursuant to 37 CFR 1.947.

CONCLUSION

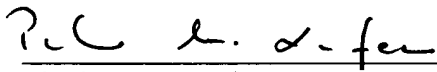
1. Patent owner's July 13, 2010 petition under 37 CFR 1.183 is granted and the page limit of 37 CFR 1.943(b) is waived to the extent of permitting patent owner's response to the April 13, 2010 Office action to exceed the page limit by up to 21 pages. This waiver makes patent owner's July 13, 2010 response page-length compliant.
2. This decision, *sua sponte*, waives the provisions of 37 CFR 1.943(b) to the extent that any written comments by third party requester filed in response to patent owner's response as set forth in this decision shall not exceed 71 pages in length, excluding reference materials, such as prior art references. **This waiver is conditional on the submission being in at least 12 point font and one-and-a-half or double spaced, with appropriate margins.** Requester has 30 days from the mailing date of this decision, granting patent owner's

attached exhibits presenting data or drawings are not included against the page limit count, unless an exhibit or drawing includes argument as to how the outstanding rejection is overcome. Thus, no pages of the Schlecht declaration count toward the page limit, and no pages of the Pellikaan declaration and its 96 accompanying exhibits count toward the page limit. Concurrently, on July 13, 2010, patent owner filed a notification of concurrent proceedings under 37 CFR 1.565(a), to which was attached several documents and exhibits from a related litigation. A review of the remarks portion of the July 13, 2010 response indicates that patent owner did not incorporate by reference material from these other sources but, rather, included any such material directly into the response itself, for example, in the form of direct quotes. *See, e.g.*, July 13, 2010 patent owner response at pages 3 and 4. Additionally, because 37 CFR 1.943(b) expressly excludes appendices of claims from the page limit count, no pages of Appendix A count toward the page limit.

⁸ It is noted that, on its face, the substantive portion of the April 13, 2010 Office action, setting forth the rejections of the claims that were adopted by the examiner, appears to span only 12 pages but relies heavily on incorporation by reference of approximately 172 pages from the request for *inter partes* reexamination in the '1207 proceeding to set forth the rejections.

petition under 37 CFR 1.183 and making patent owner's July 13, 2010 response page-length compliant, to file a comments paper pursuant to 37 CFR 1.947.

3. Jurisdiction for the '1207 reexamination proceeding is returned to the Central Reexamination Unit (CRU).
4. Any questions concerning this communication should be directed to Nicole Dretar, Legal Advisor, at (571) 272-7717.



Pinchus M. Laufer
Legal Advisor
Office of Patent Legal Administration



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,207	08/19/2009	7072190	36856.1759	6970
24197	7590	04/19/2011	EXAMINER	
KLARQUIST SPARKMAN, LLP 121 SW SALMON STREET SUITE 1600 PORTLAND, OR 97204			ART UNIT	PAPER NUMBER

DATE MAILED: 04/19/2011

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RESTON, VA 20191

Date:

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APR 19 2011

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001207
PATENT NO. : 7072190
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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CENTRAL REEXAMINATION UNIT

MURATA MANUFACTURING CO. LTD : (For Third Party
C/O KEATING & BENNETT, LLP : Requester)
1800 ALEXANDER BELL DRIVE :
SUITE 200 :
RESTON, VA 20191 :

In re: Schlecht :
Inter Partes Reexamination Proceeding : DECISION ON PETITION
Control No.: 95/001,207 : UNDER 37 CFR § 1.181
Deposited: July 14, 2009 :
For: U.S. Patent No.: 7,072,190 :

This is a decision on a petition filed by the patent owner on September 10, 2010 entitled:
“PETITION UNDER 37 C.F.R.. § 1.181 TO STRIKE THIRD PARTY REQUESTER’S
SEPTEMBER 7, 2010 COMMENTS” [hereinafter “the Petition”].

The petition is a request to the Director to exercise his supervisory authority pursuant to 37 CFR
§ 1.181 to strike the allegedly improper comments from the record.

The petition is before the Director of the Central Reexamination Unit. The petition is denied.

REVIEW OF RELEVANT FACTS

- U.S. Patent No. 7,072,190 issued on July 4, 2006.
- A request for *inter partes* reexamination was filed on July 14, 2009 and assigned control no. 95/001,207.
- *Inter partes* reexamination was ordered on November 13, 2009 and a non-final rejection was mailed on April 13, 2010.
- On July 13, 2010, patent owner filed a paper responding to the Office action. The certificate of service states it was served on the third party on July 12. The paper was longer than permitted by rule, but was filed with a petition to waive the page limit.
- On August 16, 2010, the Office of Patent Legal Administration issued a decision granting the petition and waiving the page limit, thereby making the response a complete and compliant response. The decision stated the third party had 30 days from the decision date to file comments.
- On September 7, 2010, the third party submitted comments.
- On September 10, 2010, patent owner filed the instant petition.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

35 U.S.C. § 314 Conduct of inter partes reexamination proceedings (in part)

(b) RESPONSE. —

* * *

(2) Each time that the patent owner files a response to an action on the merits from the Patent and Trademark Office, the third-party requester shall have one opportunity to file written comments addressing issues raised by the action of the Office or the patent owner's response thereto, if those written comments are received by the Office within 30 days after the date of service of the patent owner's response.

37 C.F.R. § 1.943 Requirements of responses, written comments, and briefs in *inter partes* reexamination (in part)

(b) Responses by the patent owner and written comments by the third party requester shall not exceed 50 pages in length, excluding amendments, appendices of claims, and reference materials such as prior art references.

MPEP § 2666.05 Third Party Comments After Patent Owner Response (in part)

I. TIMELINESS

A third party requester may once file written comments on any patent owner response to an Office action, during the examination stage of an *inter partes* reexamination proceeding. The third party requester comments must be filed within a period of 30 days from the date of service of the patent owner's response on the third party requester. 37 CFR 1.947. . . . If the third party requester comments are filed after 30 days from the date of service of the patent owner's response on the third party requester, the comments will not be considered. See 37 CFR 1.957(a).

The following special circumstance is to be noted. In unique circumstances, it may happen that a patent owner files a response to an Office action and the page length of the response exceeds the page length set by 37 CFR 1.943(b). Accompanying the response is a petition under 37 CFR 1.183 requesting waiver of the 37 CFR 1.943(b) requirement. Until such a 37 CFR 1.183 petition to waive the page length is granted, or a page length compliant response is filed (if the 37 CFR 1.183 petition is not granted), the patent owner response is incomplete. Pursuant to MPEP § 2666.40, "[a]fter the owner completes the response, the examiner will wait two months from the date of service of the patent owner's completion of the response, and then take up the case for action, since the 30 days for the third party requester comments on the response as completed will have expired by that time. The third party requester may file comments on the response as completed . . . The response as completed is treated as a new response on-the-merits to the Office action; thus, the third party requester is entitled to file comments and has 30 days to do so." Based on the above, at the time the 37 CFR 1.183 petition is granted, the patent owner response becomes complete with its content being set in place, and the requester has 30 days from the date of the decision granting the 37 CFR 1.183 petition to file a comment paper pursuant to 37 CFR 1.947.

DECISION

Patent owner ["petitioner"] argues that the third party requester's comments filed September 7, 2010 are improper because they were not timely filed. Petitioner argues that the statute requires comments to be filed within 30 days of service of the owner's response. Service is the only triggering event in the statute starting the 30 day time period, not the time of a response becoming complete or compliant, therefore it was improper for the Office to grant 30 days from the date of the decision waiving the page limit. The MPEP is not law, and cannot contravene the clear and unambiguous language of the statute. As service was performed July 12th, and the comments were not received until September 7th, they were not timely, says petitioner.

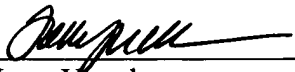
These arguments are not persuasive. While it is true that the triggering event in the statute is "service," it is also true that the service must be of a "patent owner's response." The term "response" is not defined in the statute, but it is implicit that the term refers only to properly compliant responses. It does not make sense for statutory requirements to be triggered by the filing of something that, on its face, is improper. Furthermore, as "response" is not defined, it is left to the Office as the agency administering the statute to interpret and define the term. As codified in the regulations, 37 CFR § 1.943 states that "Responses by the patent owner . . . shall not exceed 50 pages in length." A "response" is therefore interpreted and defined by the Office at least as a paper that does not exceed 50 pages in length. As Congress failed to define "response" in the statute, the Office is free to interpret and further define the term in its regulations.

Thus, at the time the paper was filed, at the time of service, the paper was not a "response" within the meaning of the statute, and therefore the time period was not yet triggered. Only after the Office waived the page limit requirement, in effect altering its definition in this case, did there exist a patent owner's response. While service was made earlier, it was not effected until the waiver of the page limit because it was not until that date that there was a patent owner's response. The effective date of "service of the patent owner's response" under 35 U.S.C. § 314(b)(2) was therefore the date of the decision waiving the page limit requirement, and it was proper for the Office to grant 30 days from that date for the filing of comments.

Petitioner has not shown that the Office's interpretation is unreasonable, and as shown above the statute is not clear and unambiguous in petitioner's favor. The Director sees no need to alter the Office's interpretation of the statute in this situation, which is already explicitly set forth in MPEP 2666.05 as quoted above, and the present situation is directly in accord with the MPEP. The entry of the comments paper is therefore in accord with Office policy. Accordingly, the petition is denied.

CONCLUSION

1. The petition filed September 10, 2010 is denied. The third party comments filed September 7, 2010 are not expunged from the record.
2. Telephone inquiries related to this decision should be directed to Mark Reinhart, Supervisory Patent Examiner, at (571) 272-1611 or in his absence to the undersigned at (571) 272-0700.



Irem Yucel
Director, Central Reexamination Unit



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,207	08/19/2009	7072190	36856.1759	6970
24197	7590	06/06/2011	EXAMINER	
KLARQUIST SPARKMAN, LLP 121 SW SALMON STREET SUITE 1600 PORTLAND, OR 97204			ART UNIT	PAPER NUMBER

DATE MAILED: 06/06/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
MURATA MANUFACTURING COMPANY, LTD
c/o KEATING & BENNETT, LLP
1800 ALEXANDER BELL DRIVE, SUITE 200
RESTON, VA 20191

Date:

MAILED

JUN 06 2011

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001207
PATENT NO. : 7072190
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/001,207	08/19/2009	7072190	36856.1759

HAMILTON, BROOK, SMITH & REYNOLDS, PC
530 VIRGINIA ROAD
P O BOX 9133
CONCORD, MA 01742-9133

EXAMINER
TON, MY-TRANG

ART UNIT	PAPER
3992	

DATE MAILED:

06/06/11

INTER PARTES REEXAMINATION COMMUNICATION

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Hamilton, Brook, Smith & Reynolds, P.C.
530 Virginia Road
P.O. Box 9133
Concord, MA 01742-9133

(For Patent Owner)

MAILED

JUN 06 2011

CENTRAL REEXAMINATION UNIT

Murata Manufacturing Company, Ltd.
c/o Keating & Bennett, LLP
1800 Alexander Bell Drive
Suite 200
Reston, VA 20191

(For Third Party Requester)

Klarquist Sparkman, LLP
121 S.W. Salmon Street
Suite 1600
Portland, OR 97204

(Courtesy Copy)

In re Schlecht
Inter partes Reexamination Proceeding
Control No: 95/001,207
Filing Date: August 25, 2009
For: U.S. Patent No.: 7,072,190

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DECISION
DISMISSING
PETITION

This is a decision on the March 22, 2011 patent owner petition, entitled "Petition to Stay *Inter Partes* Reexamination" (the March 22, 2011 patent owner petition).

This decision also addresses the November 23, 2009 change of correspondence address for the patent owner.

The March 22, 2011 patent owner petition, the November 23, 2009 change of correspondence address for the patent owner, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

SUMMARY

The March 22, 2011 patent owner petition is **dismissed**.

The November 23, 2009 change of correspondence address for the patent owner is **ineffective**.

DECISION

The patent owner requests the Office to suspend the present *inter partes* reexamination proceeding.

MPEP 2686.04 provides, in pertinent part (emphasis added):

[35 U.S.C. 314(c)]¹ thus authorizes the Director of the USPTO **to suspend (stay) reexamination proceedings, where there is good cause to do so**, pending the conclusion of litigation based on a potential for termination of a reexamination prosecution under 35 U.S.C. 317(b). Thus, a District Court decision that is pending appeal on the validity of the same claims considered in an *inter partes* reexamination proceeding may provide the requisite statutory “good cause” for suspension, due to the real possibility that the 35 U.S.C. 317(b) estoppel may attach in the near future to bar/terminate the reexamination proceeding.

Factors to be considered in determining whether it is appropriate to suspend action in the reexamination are:

- A. Whether the third party requester is a party to the litigation;
- B. Whether the claims in suit are identical to the claims under reexamination;
- C. Whether the issue(s) raised in the reexamination proceeding are the same issue(s) that were raised or could have been raised by the requester in the litigation;
- D. Whether the litigation has advanced to a late enough stage that there is a sufficient probability that a final decision will be adverse to the requester; and
- E. Whether there is a concurrent *ex parte* reexamination proceeding for the patent.

The patent owner argues that good cause exists to suspend the present proceeding because the requester, Murata Manufacturing Co. Ltd., is a co-defendant in the co-pending litigation, *SynQor, Inc. v. Artesyn Technologies, Inc. et al.*, Civil Action No. 2:07-CV-497-TJW-CE (E.D. Tex.). Upon brief review of the multitude of court documents filed in the present proceeding, the Office has verified that the requester, Murata Manufacturing Co., Ltd., is a co-defendant in the co-pending litigation, which satisfies item A.²

The patent owner further asserts that the claims at issue in the reexamination are identical to those in the litigation. The patent owner states that prior to trial, the district court instructed the parties to agree on a representative number of claims for trial management purposes, and that the

¹ 35 U.S.C. 314(c) provides, in pertinent part (emphasis added):

Unless otherwise provided by the Director for good cause, all *inter partes* reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, shall be conducted with special dispatch within the Office.

² The patent owner is reminded that the patent owner has the burden of providing a sufficient showing of the above-listed factors, including whether the requester is a co-defendant to the litigation. Merely stating that the requester is a co-defendant in the litigation is insufficient. In the present case, the Office was able to verify patent owner's statement after brief review. However, if more than a brief review of the voluminous number of court documents is required to determine the above factors, then the showing of the patent owner will be determined to be insufficient, as discussed *infra*.

parties agreed to try claims 2, 8, 10 and 19 as representative claims of U.S. Patent no. 7,072,190 (the '190 patent). The patent owner, however, has not pointed to any court document that includes, for example, the court's instructions regarding the requirement to select representative claims, such as the court's order to select representative claims, or a court document that includes a statement by the patent owner regarding the court's requirement to select representative claims. Furthermore, the patent owner has not pointed to any court document that sets forth which claims of the '190 patent were the subject of the litigation *prior to* the court's requirement to select representative claims. In other words, the patent owner has not shown which group of claims is represented by the representative claims. For this reason, the patent owner has not sufficiently shown that the claims at issue are identical to the claims in reexamination, i.e., claims 1-33 of the '190 patent. Thus, item B has not been shown to have been satisfied.³

The patent owner asserts that "all of the art cited by the Requester was available for use in the Litigation". To support its assertion, the patent owner points to exhibit A of the present petition, which is a court document, filed on October 29, 2010 by the co-defendants in the co-pending litigation, that identifies prior art "that may anticipate or showing [sic] the state of the art" pursuant to 35 U.S.C. 282, and that "reserves the right to modify or supplement this disclosure". This court document was filed more than one year after the August 25, 2009 filing date of the request for reexamination, showing that any issues raised in the reexamination proceeding were either raised or could have been raised prior to trial in the litigation. Thus, item C has been satisfied.

The patent owner further argues that the proceedings in the district court have reached an advanced stage. The patent owner states that the district court has entered a judgment on the jury verdict. The patent owner, however, has not pointed to a copy of the court's judgment to support its statement. Furthermore, the patent owner has not provided any evidence that an appeal has been filed with the Federal Circuit or that the time for filing all appeals has expired. For this reason, the patent owner has not shown that litigation has advanced to a late enough stage that there is a sufficient probability that a final decision will be adverse to the requester. Thus, item D has not been shown to have been satisfied.

Finally, Office records do not reveal the existence of a co-pending *ex parte* reexamination proceeding for the '190 patent, which satisfies item E.

See also *Sony Computer Entertainment America, Inc. v. Dudas*, 85 USPQ2d 1594 (E.D. Va. 2006), where the court upheld the Office's determination of "good cause" to suspend two related *inter partes* reexamination proceedings. The facts of the present case are clearly distinguishable from *Sony*. In *Sony*, the request for *inter partes* reexamination was not filed until after a final judgment in the district court was rendered. In the present case, however, the request for *inter partes* reexamination was filed well before trial began. Furthermore, unlike *Sony*, the Office has already issued a non-final Office action rejecting all of the patent claims under reexamination, while in *Sony*, an action on the merits had not yet issued. Also, in *Sony*, an appeal had been filed and had been fully briefed. Thus, a final decision in *Sony* was on the horizon.⁴ In the present

³ See footnote 2.

⁴ A decision is "final" after all appeals, including any appeal to the Federal Circuit, have been exhausted.

case, however, the patent owner has not shown that an appeal to the Federal Circuit has been filed, or that the time for filing all appeals has expired. In other words, the patent owner has not shown that a final decision is expected in the near future. And, without a final decision adverse to requester, no estoppel can attach to bar the filing of an *inter partes* reexamination request or to mandate termination of an ordered reexamination proceeding. Stated another way, the fact that estoppel could possibly attach at some uncertain point in the future, as argued by patent owner, does not provide the requisite showing of good cause for suspension. Finally, reexamination in *Sony* was limited to the claims that were being litigated. In the present case, however, the patent owner has not shown that the claims in suit are identical to the claims under reexamination in the present proceeding.

In summary, the patent owner has not provided a showing of good cause to suspend prosecution of the present reexamination proceeding.

Accordingly, the March 22, 2011 patent owner petition is **dismissed**. Pursuant to MPEP 2686.04, the present *inter partes* reexamination proceeding **will continue**, and **will not be suspended**.

If a renewed petition to suspend the present *inter partes* reexamination proceeding is later contemplated, **the factors explained in this decision must be addressed.**

The November 23, 2009 Change of Correspondence Address of the Patent Owner Is Ineffective

A change of correspondence address was filed by the patent owner in the present proceeding on November 23, 2009. However, the address for the patent owner in a reexamination proceeding is the official correspondence address of the patent owner *in the patent file*. In the present case, the official correspondence address for the patent owner, that is of record in the patent file, application no. 10/812,314, is shown in the caption of this decision. See MPEP 2622 and 37 CFR 1.33(c).

Accordingly, the November 23, 2009 change of correspondence address for the patent owner is **ineffective**.

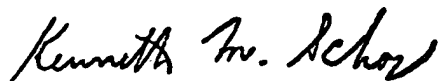
A courtesy copy of this decision will be mailed to the practitioner who submitted the present patent owner petitions, Mr. Richard D. McLeod. **Absent the filing of a proper change of correspondence address in the patent file, which is application no. 10/812,314, however, all future correspondence will be mailed to the current address of record for the patent owner, as shown in the caption of this decision.**

CONCLUSION

- The March 22, 2011 patent owner petition is **dismissed**.
- The present *inter partes* reexamination proceeding will continue, and **will not be suspended**.
- The November 23, 2009 change of correspondence address for the patent owner is

ineffective. Absent the filing of a proper change of correspondence address in the patent file, application no. 10/812,314, all future correspondence will be mailed to the current address of record for the patent owner, as shown in the caption of this decision.

- Telephone inquiries related to this decision should be directed to Cynthia L. Nessler, Senior Legal Advisor, at (571) 272-7724, or in her absence, to the undersigned at (571) 272-7710.



Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

6-03-11
Kenpet8/IP/suspend



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,207	08/19/2009	7072190	36856.1759	6970
24197	7590	12/21/2011	EXAMINER	
KLARQUIST SPARKMAN, LLP 121 SW SALMON STREET SUITE 1600 PORTLAND, OR 97204			ART UNIT	PAPER NUMBER

DATE MAILED: 12/21/2011

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MURATA MANUFACTURING COMPANY, LTD
c/o KEATING & BENNETT, LLP
1800 ALEXANDER BELL DRIVE, SUITE 200
RESTON, VA 20191

Date:

MAILED

DEC 21 2011

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001207
PATENT NO. : 7072190
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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CENTRAL REEXAMINATION UNIT

KLARQUIST SPARKMAN, LLP
121 SW SALMON STREET
SUITE 1600
PORTLAND OR 97204

(For Patent Owner)

MURATA MANUFACTURING COMPANY
C/O KEATING & BENNETT, LLP
1800 ALEXANDER BELL DRIVE
SUITE 200
RESTON, VA 20191

(For Third Party Requester)

In re Schlecht
Inter Partes Reexamination Proceeding
Control No. 95/001,207
Filed: August 19, 2009
For: U.S. Patent No. 7,072,190 B1

:
: **DECISION DISMISSING**
: **PETITION UNDER**
: **37 C.F.R. § 1.183**
:

This is a decision on the December 13, 2011 patent owner petition entitled "Petition to Waive Rules Under 37 CFR § 1.183."

The petition is before the Office of Patent Legal Administration.

The petition under 37 C.F.R. § 1.183 to request an extension of time to file an appellant's brief until after a decision is reached on patent owner's September 23, 2011 petition is **dismissed**.

BACKGROUND

1. On August 19, 2009, a request meeting the filing date requirements for *inter partes* reexamination was filed by the third party requester, and the resulting reexamination proceeding was assigned control number 95/001,207 ("the '1207 proceeding").
2. On November 13, 2009, the Office issued an order granting the request for *inter partes* reexamination.
3. On November 23, 2009, patent owner filed a petition to vacate the filing date of, and the order granting, the request. This petition was dismissed by the Office on June 21, 2010.

4. On April 13, 2010, the Office issued a non-final Office action on the merits of the '1207 proceeding.
5. On May 13, 2010, the Office issued a decision granting a request to extend the time to respond to the non-final Office action by one month.
6. On July 13, 2010, patent owner filed a response to the non-final Office action which exceeded the page limits set by rule, accompanied by a petition to waive the page limits. The petition was granted on August 16, 2010. Third party requester filed comments on September 7, 2010.
7. On September 10, 2010, patent owner filed a petition to strike the September 7, 2010 third party requester comments. This petition was denied by the Office on April 19, 2011.
8. On March 22, 2011, patent owner filed a petition to stay the *inter partes* reexamination. This petition was dismissed by the Office on June 6, 2011.
9. On August 4, 2011, the Office issued an Action Closing Prosecution ("ACP") rejecting all claims under reexamination, setting a one-month period for patent owner to file a submission under 37 C.F.R. § 1.951(a).
10. On September 23, 2011, patent owner filed an untimely submission accompanied by a petition requesting waiver of the rules to permit entry and consideration of that submission. This petition was dismissed in a decision mailed by the Office on December 21, 2011.
11. On September 28, 2011, the Office issued a Right of Appeal Notice.
12. On October 7, 2011, patent owner filed a renewed petition to stay the *inter partes* reexamination. Third party requester filed an opposition to this petition on October 27, 2011.
13. On October 28, 2011, patent owner filed a notice of appeal, and a submission which included three evidentiary documents.
14. On December 13, 2011, patent owner filed the instant petition seeking an extension of time to file an appellant's brief.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

35 U.S.C. 314 provides, in pertinent part:

[R]eexamination shall be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133.

37 C.F.R. § 1.183 states:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

DECISION

The present patent owner petition requests rule waiver under § 1.183 to extend the time for patent owner to file an appellant's brief until one month after the Office issues a decision on patent owner's petition filed on September 23, 2011. That petition was dismissed in an Office decision issued on December 21, 2011. The extension was sought for the purposes of (1) preventing unnecessary expenditure of Patent Office resources, (2) promoting the interests of justice, and (3) to resolve issues that may result in a redundant/wasted briefing. In view of the dismissal of the petition, questions of unnecessary expenditure of resources and redundant briefing are now moot. In view of the statutory requirement that the Office handle proceedings with "special dispatch," petitioner has failed to show the existence of an extraordinary situation for which justice requires relief in the form of extension of time to file an appellant's brief.

Therefore, the instant petition is dismissed to the extent that the requested 30 day extension is not granted. However, in view of the circumstances of the present proceeding, the time to file an Appellant's Brief under § 41.66(a) is extended to run through a date that is two weeks from the mailing date of this decision (January 4, 2011).

CONCLUSION

1. The December 13, 2011 patent owner petition is dismissed.
2. The time to file an Appellant's Brief under § 41.66(a) is extended to run through a date that is two weeks from the mailing date of this decision (January 4, 2011).
3. Telephone inquiries related to this decision should be directed to Michael Cygan, Legal Advisor, at (571) 272-7700.

/Michael Cygan/

Michael Cygan
Legal Advisor
Office of Patent Legal Administration

December 21, 2011



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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DATE MAILED: 12/21/2011

Please find below and/or attached an Office communication concerning this application or proceeding.



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
MURATA MANUFACTURING COMPANY, LTD
c/o KEATING & BENNETT, LLP
1800 ALEXANDER BELL DRIVE, SUITE 200
RESTON, VA 20191

Date:

MAILED

DEC 21 2011

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001207
PATENT NO. : 7072190
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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DEC 21 2011

KLARQUIST SPARKMAN, LLP
121 SW SALMON STREET
SUITE 1600
PORTLAND OR 97204

(For Patent Owner)

CENTRAL REEXAMINATION UNIT

MURATA MANUFACTURING COMPANY
C/O KEATING & BENNETT, LLP
1800 ALEXANDER BELL DRIVE
SUITE 200
RESTON, VA 20191

(For Third Party Requester)

In re Schlecht
Inter Partes Reexamination Proceeding
Control No. 95/001,207
Filed: August 19, 2009
For: U.S. Patent No. 7,072,190 B1

:
: **DECISION DISMISSING**
: **PETITION UNDER**
: **37 C.F.R. § 1.183**
:

This is a decision on the September 23, 2011 patent owner petition entitled "Petition to Waive Rules (37 CFR § 1.183)."

The petition is before the Office of Patent Legal Administration.

The petition under 37 C.F.R. § 1.183 to request for rule waiver and an extension of time is **dismissed**.

BACKGROUND

1. On August 19, 2009, a request meeting the filing date requirements for *inter partes* reexamination was filed by the third party requester, and the resulting reexamination proceeding was assigned control number 95/001,207 ("the '1207 proceeding").
2. On November 13, 2009, the Office issued an order granting the request for *inter partes* reexamination.
3. On November 23, 2009, patent owner filed a petition to vacate the filing date of, and the order granting, the request. This petition was dismissed by the Office on June 21, 2010.
4. On April 13, 2010, the Office issued a non-final Office action on the merits of the '1207 proceeding.

5. On May 13, 2010, the Office issued a decision granting a request to extend the time to respond to the non-final Office action by one month.
6. On July 13, 2010, patent owner filed a response to the non-final Office action which exceeded the page limits set by rule, accompanied by a petition to waive the page limits. The petition was granted on August 16, 2010. Third party requester filed comments on September 7, 2010.
7. On September 10, 2010, patent owner filed a petition to strike the September 7, 2010 third party requester comments. This petition was denied by the Office on April 19, 2011.
8. On March 22, 2011, patent owner filed a petition to stay the *inter partes* reexamination. This petition was dismissed by the Office on June 6, 2011.
9. On August 4, 2011, the Office issued an Action Closing Prosecution ("ACP") rejecting all claims under reexamination, setting a one-month period for patent owner to file a submission under 37 C.F.R. § 1.951(a).
10. On September 23, 2011, patent owner filed an untimely submission accompanied by the instant petition requesting waiver of the rules to permit entry and consideration of that submission.
11. On September 28, 2011, the Office issued a Right of Appeal Notice.
12. On October 7, 2011, patent owner filed a renewed petition to stay the *inter partes* reexamination. Third party requester filed an opposition to this petition on October 27, 2011.
13. On October 28, 2011, patent owner filed a notice of appeal, and a submission which included three evidentiary documents.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

35 U.S.C. 314 provides, in pertinent part:

[R]eexamination shall be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133.

35 U.S.C. 133 provides:

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Director in such action, the application shall be regarded as abandoned by the parties

thereto, unless it be shown to the satisfaction of the Director that such delay was unavoidable.

37 C.F.R. § 1.183 states:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 C.F.R. § 1.182 states:

All situations not specifically provided for in the regulations of this part will be decided in accordance with the merits of each situation by or under the authority of the Director, subject to such other requirements as may be imposed, and such decision will be communicated to the interested parties in writing. Any petition seeking a decision under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 C.F.R. § 1.956 states, in pertinent part:

The time for taking any action by a patent owner in an inter partes reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified. **Any request for such extension must be filed on or before the day on which action by the patent owner is due**, but in no case will the mere filing of a request effect any extension. [emphasis added]

37 C.F.R. § 1.958(b) states, in pertinent part:

Any **response** by the patent owner not timely filed in the Office may be accepted if the delay was unintentional. A grantable petition to accept an unintentionally delayed response must be filed in compliance with § 1.137(b). [emphasis added]

37 C.F.R. § 1.137(b) provides, in pertinent part:

(b) Unintentional. If the delay in reply by ... **patent owner** was unintentional, a petition may be filed pursuant to this paragraph to revive ... **a reexamination prosecution terminated under §§ 1.550(d) or 1.957(b)** or limited under § 1.957(c).... A grantable petition pursuant to this paragraph must be accompanied by:

- (1) The reply required to the outstanding Office action or notice, unless previously filed;
- (2) The petition fee as set forth in § 1.17(m);
- (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Director may require additional

information where there is a question whether the delay was unintentional [emphasis added]

DECISION

The present patent owner petition requests rule waiver under § 1.183 to enter the submission filed on September 23, 2011. Waiver is requested of “Rule 1.956(a) [which] requires that comments on an ACP . . . be filed within the time set by ACP.” Waiver is also requested of the requirement in Rule 1.956 that extensions be sought prior to the expiration of the period for response. The provisions of Rule 1.137 to permit the entry of papers due to unintentional delay are also sought in a third avenue for relief.

As an initial point, 37 CFR 1.4(c) provides that “each distinct subject, inquiry or order must be contained in a separate paper to avoid confusion and delay in answering papers dealing with different subjects.” As pointed out, the present petition includes multiple requests: (1) A request for waiver as to comments on an ACP being filed within the time set by ACP; (2) A request for waiver as to the requirement that extensions be sought prior to the expiration of the period for response; and a petition for acceptance of papers under § 1.137. The petition is dismissible based on this alone.

It is further pointed out that the waiver requested of “Rule 1.956(a)” cannot be granted because such a rule does not exist; however, waiver of § 1.956 and § 1.951(a) (which is presumably meant by patent owner) is addressed in the below decision. The request to use the provisions of § 1.137 is inappropriate, because § 1.137 applies only to responses that would result in the termination of the reexamination if not supplied, which is not the case for a submission after an ACP; however, as explained below, similar considerations are addressed in the below decision.

1. Whether An Extraordinary Situation Exists to Justify Rule Waiver Under § 1.183

I. The Proper Standard For Entry of Untimely Third Party Requester Papers

Petitioner presents the instant petition seeking rule waiver under § 1.183, which requires the existence of an “extraordinary situation” such that “justice requires” relief from the rule. While the unintentional and/or unavailability standards apply to relief in the context of revival of proceedings which have been terminated, those standards are not controlling as to relief under § 1.183.

Following the enactment of *ex parte* reexamination in 1980, entry of late papers in *ex parte* reexamination proceedings were requested via patent owner petition under § 1.183. Such petitions were grantable “if the situation is ‘extraordinary’ and if ‘justice requires’ the waiver [in cases where] rights may be lost by the failure to timely respond.”¹ In 1988, in reaction to *In re*

¹ MPEP 2268, 5th edition, August 1983.

Katrapat, 6 U.S.P.Q.2D 1863 (Comm'r Patents 1988),² Office policy changed to permit entry of a late paper by a patent owner where rights are lost by the failure to file the paper, and the delay in submitting the paper could be shown to be "unavoidable in the sense of § 133." The MPEP was accordingly updated in July 1989 to substitute 35 U.S.C. § 133 (and a petition under 37 CFR § 1.137(a) based on the "unavoidable" standard for accepting late papers) in place of 37 C.F.R. § 1.183 as the basis for seeking entry of late papers in reexamination, which at that time existed in *ex parte* form only.³

In the American Inventors Protection Act of 1999 enactment of optional *inter partes* reexamination, Congress specifically authorized entry of "an unintentionally delayed response by patent owner" through amendment of 35 U.S.C. § 41 (a)(7).⁴ Accordingly, the Office promulgated 37 C.F.R. § 1.958, which set forth the procedure for a petition to accept late papers and revive a terminated *inter partes* reexamination or claims terminated for lack of patent owner response.⁵

In the present instance, failure of the patent owner to file a submission following the ACP does not result in termination of the *inter partes* reexamination, as the Office will issue a Right of Appeal Notice whether or not patent owner files any paper under § 1.951(a).⁶ Since § 1.958 provides for revival only in instances where the reexamination would be terminated for lack of response, the standard for "unavoidable" or "unintentional" delay is not the standard by which this question is to be decided. However, a petition filed under § 1.183 remains the avenue to seek entry of a paper where a paper in a reexamination is filed late and the provisions of § 1.137 do not apply. In such cases, a showing analogous to that required by § 1.137(a) would be required in conjunction with requiring a showing of extraordinary circumstances such that justice requires relief, for acceptance of a patent owner submission when such relief is requested under § 1.183.

II. Factors Determining "Extraordinary Circumstances . . . Such That Justice Requires" Relief

The question of whether extraordinary circumstances exist such that justice requires waiver of a rule is necessarily specific to the facts and circumstances of the particular case. However, past practice and court precedent provide some guidance into this inquiry.

A. Past and Current Office Procedure:

Currently, the MPEP does not specifically address the circumstance in which a patent owner may seek entry of untimely papers, which are refused consideration under § 1.956. However, prior to

² See *In re Katrapat*, 6 U.S.P.Q.2D 1863 (Comm'r Patents 1988) (finding that § 305 intends that the "unavoidable delay" provision of § 133 applies to patent owners in reexaminations as well as applicants in patent application proceedings). Note that the reexamination proceeding in *Katrapat* was terminated due to late submission of a paper.

³ MPEP 2268, 5th edition, revision 12, July 1989.

⁴ 106 P.L. 113, Title IV "American Inventors Protection Act of 1999," Subtitle F "Optional Inter Partes Reexamination Procedure," § 4605. 35 U.S.C. § 41 (a)(7) states that upon filing "for an unintentionally delayed response by the patent owner in any reexamination proceeding, [the fee is] \$1,210, unless the petition is filed under section 133 or 151 of this title [unavoidable delay], in which case the fee shall be \$110."

⁵ 65 Fed. Reg. 76765, 76781 (Dec. 7, 2000).

⁶ See MPEP 2672(V).

the establishment of procedures for revival of a proceeding to enter an untimely paper submitted by the patent owner, the August 1983 5th edition of the MPEP provided guidance for seeking waiver of the rules to enter an untimely paper. In that edition, MPEP 2268 stated that since “substantial property rights are involved in patents undergoing reexamination, the Office will consider, in appropriate circumstances, petitions to waive the rules pursuant to 37 CFR 1.183.”⁷ Decisions on such petitions have applied the “extraordinary circumstances” test, and weighed such factors as the potential loss of appeal rights, acts of counsel to prudently ensure timely filing, and/or unawareness of or failure to properly interpret applicable due date regulations.⁸ Such considerations have also been found appropriate in other situations, such as interference proceedings, in which an “extraordinary circumstances” test is applicable.⁹

Such petitions were noted in that edition of the MPEP to be appropriate where “rights may be lost by the failure to timely respond;” however, there would be no “adequate basis to justify a waiver of the rule regardless of the reasons for the failure [where] no rights are lost by the failure to file these documents.”¹⁰

B. Prior Court Precedent:

The essence of the “extraordinary circumstances” requirement was expressed by the CCPA in *Myers v. Feigelman*, 455 F.2d 586, 172 USPQ 580 (CCPA 1972):

[T]he rules are designed to provide an orderly procedure and the parties are entitled to rely on their being followed in the absence of such circumstances as might justify waiving them under Rule 183. To hold that they may be ignored, in the absence of such circumstances, merely because no special damage has been shown would defeat the purpose of the rules.¹¹

Certain circumstances have been considered by the court as strong factors weighing against a finding of extraordinary circumstances. For example, numerous courts have found that lack of awareness of the provisions of a rule by an attorney is not a basis for waiver of that rule.¹²

⁷ See MPEP 2268, 5th edition, August 1983.

⁸ See, e.g., *In re Sivertz*, 227 USPQ 255 (Commr. Pat. July 23, 1985) (finding that counsel’s apparent unawareness of the proper due date provisions did not show that justice required waiver of any time period set forth in USPTO regulations for appeal to the Federal Circuit); *In re Bachler*, 229 USPQ 553 (Commr. Pat. March 13, 1986) (stating that “the evidence does establish that counsel took detailed steps to ensure that timely filing took place, and these, coupled with the fact that the denial of the request to have the reply brief considered and of an opportunity for an oral hearing may prejudice the patent owner, established an extraordinary situation”); *In re Reck*, 227 USPQ 488 (Commr. Pat. August 28, 1985) (stating “[c]ounsel’s apparent oversight . . . and unawareness with respect to [the appropriate timeliness regulations] does not make this an extraordinary situation for a grant of the relief sought”).

⁹ See, e.g., *B and E Sales Co. v. Andrew Jergens Co.*, 7 U.S.P.Q.2d 1906 (Commr. Pat. April 27, 1988) (finding that “the mistake was the result of counsel’s failure to review the rule” where counsel placed the burden of rule interpretation on a non-attorney staff member, resulting in an improper interpretation of a rule, resulting in untimeliness of a filing).

¹⁰ MPEP 2268, 5th edition, August 1983.

¹¹ See *Myers v. Feigelman*, 455 F.2d at 601, 172 USPQ at 584.

¹² See, e.g., *Nugent v. Yellow Cab Co.*, 295 F.2d 794 (7th Cir. 1961) cert denied, 369 U.S. 828 (1962) (stating “counsel’s mistake in overlooking and not being aware of rule [is] not [a] basis for waiving [a] rule”); *In re Jones*,

Certain other circumstances have been correlated by the courts with a finding of extraordinary circumstances. For example, where an unforeseeable intervening act in the submission of the document causes delay, such an act has been found to contribute to an “extraordinary” situation.¹³ Where certain aspects of the Office’s behavior are implicated in a party’s untimely submission, courts are apt to find that such behavior contributes to an “extraordinary” situation.¹⁴ Additionally, courts have stated a preference for mitigating “inevitable mistakes,”¹⁵ and courts have been noted to be “loathe to extinguish a litigant’s claim based solely on the innocent mistakes of his lawyer,”¹⁶

In each situation, the court or deciding official weighs the entirety of the facts presented by the party seeking waiver to determine whether “extraordinary circumstances” which would justify rule waiver are found to exist. No one circumstance is solely determinative.

II. The Entirety of Facts Does Not Show Extraordinary Circumstances Such That Justice Requires Relief

The petition presents numerous additional facts and lines of reasoning in support of establishing the existence of extraordinary circumstances in the petitioner’s present situation. Each of these has been carefully reviewed, and the totality of circumstances has been weighed in light of all of the facts and reasoning presented by the petitioner.

Patent owner argues that the situation is extraordinary because certain evidence was not available to the patent owner due to a protective order. Patent owner admits that such evidence first became available to the patent owner in March 2011,¹⁷ at which time it was submitted to the Office with a Notice of Concurrent Proceedings. Patent owner states that it lacked the opportunity to comment prior to the ACP on this evidence.

However, the ACP was issued on August 4, 2011. Patent owner had, at that point, possessed the information for over four months. Patent owner possessed the opportunity, through the right to file comments during the period set forth in § 1.951(a), to comment on the ACP in view of the

542 F.2d 65, 68, 191 USPQ 249, 252 (CCPA 1976)(stating “attorneys appearing before Court are presumed to have knowledge of the provisions of the current rules”).

¹³ See *Howard Florey Institute v. Dudas*, 87 U.S.P.Q.2d 1913 (E.D.VA 2008) (finding an acute panic attack by a courier of the paper to be filed at the USPTO to be an “extraordinary” situation).

¹⁴ See *Commonwealth of Australia v. Radio Corporation of America*, 399 F.2d 807, 810 (2nd Cir. 1968)(finding that “the lengthy deliberation of the Board of Patent Interferences upon the petition for reconsideration and appended motion was a major factor” with respect to 37 C.F.R. § 2.148).

¹⁵ *Helfgott & Karas v. Dickenson*, 209 F.3d 1328, 1330 (Fed. Cir) (stating “[m]istakes are inevitable, much as all those involved try to minimize their possibility. Even if total elimination of mistakes is an illusory goal, their reasonable mitigation should not be. Sound judgment, flexibility, and the careful following of considered processes are critical to ensuring that small mistakes do not become large ones, and that mistakes of form do not overwhelm the correctness of substance. Unfortunately, in this case, at least some of these elements were lacking from both parties to this dispute, leaving it to us to ascertain error, and assign responsibility for it”).

¹⁶ *Theodor Groz v. Quigg*, 10 U.S.P.Q.2d 1787 (reversing a refusal of the USPTO to find “unavoidable” a delay by patent owner in filing an appeal brief in a reexamination).

¹⁷ The petition at page 3 states that such information was available in “March 2010;” however, this appears to be a typographical error in the date.

information which patent owner received in March 2011. If patent owner had needed more time, due to the complexity of the information, to complete the comments submission, patent owner could have requested an extension of time.

However, patent owner did not request such time, because patent owner did not properly docket the time deadline responsive to the ACP, and thus believed the deadline was one month later than the actual deadline.¹⁸ Therefore, it can be seen that the unavailability of the protective order material prior to March 2011 was not an actual cause of patent owner's failure to timely submit a response to the ACP. Accordingly, the unavailability of the protective order material prior to March 2011 does not substantively contribute towards any "extraordinary circumstances" surrounding the untimely patent owner paper of September 23, 2011.

Petitioner's underlying argument is that the deadline was unintentionally missed due to a docketing error, a line of reasoning for which petitioner seeks application of the unintentional abandonment revival provisions of § 1.137(b). However, as detailed above, § 1.137(b) is only applicable to situations where rights are lost due to termination of the proceeding, and not the instant situation.

To the extent that petitioner attempts draw an analogy to revival proceedings in satisfying the requirements for an "extraordinary situation" for which "justice requires" relief under § 1.183, evidence would need to be submitted to show that a relevant routine is in place and is reliable, and that the unexpected failure actually caused the lack of timeliness of the submission. No such evidence was provided by the petitioner, merely the verified statement relating to § 1.137(b) that the entire delay in filing the petition was unintentional. While such a statement is acceptable for a petition under § 1.137(b), the statement by itself does not show the existence of an "extraordinary situation" for which "justice requires" relief under § 1.183. The factors relating to revival of a proceeding due to an unavoidably delayed submission, as set forth in MPEP 711.03(c), may be used to establish an extraordinary situation; *e.g.*, whether the lack of timeliness was in actuality caused by the failure of petitioner's standard docketing procedures, and whether such procedures are in actuality reasonably reliable to properly assign due dates to papers submitted under § 1.951(a) in *inter partes* reexaminations. It is unclear, under the facts provided by petitioner, whether such factors were at issue in the instant situation.

Furthermore, the statutory requirement that the Office handle *inter partes* reexamination proceedings with "special dispatch," as set forth in 35 U.S.C. 314(c), must be taken into account in determining whether "justice requires" that waiver of the rules be granted. The present proceeding was filed in August of 2009, and after a prosecution in which patent owner has filed numerous petitions, is now under appeal, with an outstanding patent owner petition to stay the proceeding. Were the instant petition to permit the late submission to be granted, the proceeding would be required to regress back to a pre-appeal stage in order to permit an opportunity for the requester to file a paper addressing the patent owner submission, with significant resultant delay in the proceeding.

Based above on the above factors, including the lack of confidentiality of the information at a

¹⁸ See page 3 of the petition, points 10 and 11.

time prior to the issuance of the ACP, a lack of demonstrated acts of counsel to prudently ensure timely filing, and given that patent owner can present argument on appeal in the proceeding, petitioner has failed to show the existence of an extraordinary situation for which justice requires relief in the form of permitting the September 23, 2011 patent owner submission to be entered and the proceeding to be regressed back to the above-described earlier stage. Therefore, the instant petition is dismissed.

CONCLUSION

1. The September 23, 2011 patent owner petition is dismissed.
2. Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Inter Partes Reexam
Commissioner for Patents
Post Office Box 1450
Alexandria, VA 22313-1450
3. Telephone inquiries related to this decision should be directed to Michael Cygan, Legal Advisor, at (571) 272-7700.



Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

December 21, 2011



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,207	08/19/2009	7072190	36856.1759	6970
24197	7590	02/24/2012	EXAMINER	
KLARQUIST SPARKMAN, LLP 121 SW SALMON STREET SUITE 1600 PORTLAND, OR 97204			ART UNIT	PAPER NUMBER

DATE MAILED: 02/24/2012

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RESTON, VA 20191

Date: **MAILED**
FEB 24 2012
CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001207
PATENT NO. : 7072190
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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(For Patent Owner)

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FEB 24 2012

CENTRAL REEXAMINATION UNIT

Murata Manufacturing Company, Ltd.
c/o Keating & Bennett, LLP
1800 Alexander Bell Drive
Suite 200
Reston, VA 20191

(For Third Party Requester)

In re Schlecht	:	
<i>Inter partes</i> Reexamination Proceeding	:	DECISION
Control No: 95/001,207	:	DISMISSING
Filing Date: August 25, 2009	:	PETITION
For: U.S. Patent No.: 7,072,190	:	

This is a decision on patent owner's October 7, 2011 petition, entitled "Renewed Petition to Stay *Inter Partes* Reexamination (37 CFR 1.182)" (patent owner's October 7, 2011 renewed petition).

This decision also addresses requester's October 27, 2011 opposition paper, entitled "Opposition to Renewed Petition to Stay *Inter Partes* Reexamination (37 CFR 1.182)" (requester's October 27, 2011 opposition).

Patent owner's October 7, 2011 renewed petition, requester's October 27, 2011 opposition, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

SUMMARY

Patent owner's October 7, 2011 renewed petition is **dismissed**. The present *inter partes* reexamination proceeding **will continue**, and **will not be suspended**.

DECISION

The patent owner requests the Office to suspend the present *inter partes* reexamination proceeding.¹

¹ The Office notes that the present petition was filed after the mailing of the Right of Appeal Notice, i.e., when an Office action was outstanding. To have a petition to suspend a reexamination proceeding considered, the patent owner must file any required response to an outstanding Office action either prior to, or concurrent with, its petition. The Office will not consider on the merits a petition to suspend a reexamination proceeding when such a response by the patent owner is due. See MPEP 2686.04. In the instant case, however, prosecution has progressed up to the February 1, 2012 filing of requester's respondent's brief, and an Office action is not presently outstanding. The patent owner is reminded, however, that had prosecution not progressed in this proceeding to the point where an Office action was no longer outstanding, this petition would have been dismissed as untimely.

MPEP 2686.04 provides, in pertinent part (emphasis added):²

[35 U.S.C. 314(c)]³ thus authorizes the Director of the USPTO **to suspend (stay) reexamination proceedings, where there is good cause to do so**, pending the conclusion of litigation based on a potential for termination of a reexamination prosecution under 35 U.S.C. 317(b). Thus, a District Court decision that is pending appeal on the validity of the same claims considered in an *inter partes* reexamination proceeding may provide the requisite statutory “good cause” for suspension, due to the real possibility that the 35 U.S.C. 317(b) estoppel may attach in the near future to bar/terminate the reexamination proceeding.

Factors to be considered in determining whether it is appropriate to suspend action in the reexamination are:

- A. Whether the third party requester is a party to the litigation;
- B. Whether the claims in suit are identical to the claims under reexamination;
- C. Whether the issue(s) raised in the reexamination proceeding are the same issue(s) that were raised or could have been raised by the requester in the litigation;
- D. Whether the litigation has advanced to a late enough stage that there is a sufficient probability that a final decision will be adverse to the requester; and
- E. Whether there is a concurrent *ex parte* reexamination proceeding for the patent.

In the June 6, 2011 decision dismissing patent owner’s initial petition to suspend⁴ the present reexamination proceeding, the Office determined that elements A and E have been satisfied.

Regarding element B, the patent owner asserts that the claims at issue in the reexamination are identical to those in the copending litigation, *SynQor, Inc. v. Artesyn Technologies, Inc. et al.*, Civil Action No. 2:07-CV-497-TJW-CE (E.D. Tex.). In patent owner’s initial petition, the patent owner stated that “[p]rior to trial, the District Court instructed the parties to agree on a representative number of claims for trial management purposes. SynQor [the patent owner] and the Defendants [including the third party requester of the present proceeding] agreed to try claims 2, 8, 10, and 19 as representative claims for the ‘190 patent [the patent under reexamination].” In the June 6, 2011 decision, the Office determined that element B had not been shown to have been satisfied, because the patent owner did not provide evidence of the

² See particularly, MPEP 2686.04, subsections II(B) and III.

³ 35 U.S.C. 314(c) provides, in pertinent part (emphasis added):

Unless otherwise provided by the Director for good cause, all *inter partes* reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, shall be conducted with special dispatch within the Office.

⁴Filed on March 22, 2011.

court's requirement to select "representative claims", or evidence showing which claims were represented by the representative claims.

With the present petition, the patent owner submits, among other exhibits, 1) Exhibit E, a copy of requester/defendant's December 2, 2009 invalidity contentions, which was apparently submitted in court, and which fails to identify that claim 17 of the '190 patent, which is under reexamination, is an "asserted claim" of the '190 patent in the litigation; 2) Exhibit F, a copy of the court's March 25, 2010 order granting requester's motion to compel the patent owner "to reduce the number of claims it asserts"; 3) Exhibit N, a copy of the court's November 29, 2010 order limiting the patent owner to the assertion of ten claims at trial; and 4) Exhibit V, a copy of the court's August 17, 2011 final judgment, in which the court refers to "claims 2, 8, 10, and 19 of the '190 patent" as the "asserted" claims of the '190 patent, and states that the jury failed to find that "any of the asserted claims are invalid". The patent owner states, on page 13 of the present petition, that it "ultimately chose to try the issue of infringement of the '190 Patent [solely] based on representative claims 2, 8, 10, and 19". Finally, the patent owner also states, on page 13 of the present petition, that it "has disclaimed claim 17 in a contemporaneous amendment". However, in its subsequently-filed January 4, 2012 appellant's brief, the patent owner admits that "[n]o amendments were filed" in the present proceeding.

Thus, even as an initial matter, the patent owner has not provided evidence that all of the patent claims under reexamination were originally asserted in the copending litigation (see, e.g. Exhibit F, as outlined above). In addition, the patent owner has not provided any evidence that the parties agreed, or that the court determined, that claims 2, 8, 10 and 19 of the '190 patent, which were the only claims of the '190 patent that were ultimately litigated, are "representative" of the claims that were originally asserted in the copending litigation. No evidence can be found which shows that the court referred to the claims in suit as "the representative claims". Rather, the court appears to have consistently referred to the claims in suit as "the asserted claims". Furthermore, the patent owner has not provided any evidence that the requester/co-defendant agreed that claims 2, 8, 10, and 19 would be "representative" of the claims originally asserted by the patent owner in the litigation. In fact, the requester, in its October 27, 2011 opposition, argues that it "had absolutely no input, say, or control over which claims of the '190 patent [that the patent owner] would present to the jury at trial in the Litigation". The evidence proffered by the patent owner only appears to show that the patent owner was given the opportunity to select which claims were to be litigated, and not that the parties agreed, or that the court determined, that the claims selected by the patent owner were to be "representative" of the claims originally asserted in the litigation. Thus, the patent owner has not provided evidence showing that the claims at issue in the reexamination are identical to those in the copending litigation. In fact, the evidence of record shows that they are not identical.

For the reasons given above, element B has not been shown to have been satisfied.

Regarding element C, the Office determined, in the June 6, 2011 decision, that the issue(s) raised in the reexamination proceeding are the same issue(s) that were raised or could have been raised by the requester in the litigation. Upon reconsideration, however, and in view of the fact that the evidence of record now shows that the claims under reexamination are not identical to those litigated in court, the patent owner has not shown that any issues raised in the reexamination proceeding with respect to the non-litigated claims could have been raised by the requester in the

compending litigation. The patent owner points to *Katz Interactive Call Processing Patent Litigation v. American Air*, 639 F.3d 1303, 97 USPQ2d 1737 (Fed. Cir. 2011) to show that “the Court’s judgment will have a *res judicata* effect against [the requester/co-defendant] on all claims of the ‘190 Patent even though only claims 2, 8, 10 and 19 were presented to the jury”.⁵ However, the decision in *Katz*, which the court expressly limited to the circumstances before it,⁵ is inapplicable here. The district court in *Katz* was seeking to eliminate duplicative claims, and allowed the plaintiff/patent owner the opportunity to select the claims that it wanted to assert. The issue on appeal was whether the district court’s approach was fair to the patent owner. The Federal Circuit accepted plaintiff/patent owner’s assertion that the district court’s judgments could preclude *the plaintiff/patent owner* from litigating the unselected claims in later actions brought against the same or other parties. The Federal Circuit, however, viewed the approach as fair because it gave the plaintiff/patent owner the opportunity to select which claims it would assert, and further gave the plaintiff/patent owner the ability to raise additional claims that were not duplicative. *Id.* In the present case, however, the patent owner has not pointed to any part of the *Katz* decision where the Federal Circuit suggested that the approach in *Katz* would likewise limit the *defendant* in *Katz* regarding whether the issue of invalidity of the unasserted claims may be raised in a future litigation. Unlike *Katz*, the issue here is not whether the patent owner had a fair opportunity to raise the unasserted claims in the district court. Instead, the question is whether the requester had a fair opportunity to litigate the validity of the claims that were not asserted against it. The patent owner has not shown that the requester in the present case had a fair opportunity. The patent owner selected which claims would be asserted, not the requester. The patent owner has not shown how the requester could have raised, in the compending litigation, any issues that were raised in the reexamination proceeding with respect to the non-litigated claims, also as argued by the requester in its October 27, 2011 opposition.⁶

“Good cause” for suspension pending the conclusion of litigation is based on a potential for the termination of reexamination prosecution under 35 U.S.C. 317(b). See MPEP 2686.04, quoted above. If a claim under reexamination is not the subject of the compending litigation, then the estoppel provisions of 35 U.S.C. 317(b) would not apply to the final outcome of the compending litigation as to that patent claim, because there would be no “final decision that the party has not sustained its burden of proving the invalidity” of the patent claim. Thus, there is no “potential for termination” of this reexamination proceeding as to the non-litigated claims. A suspension of the present reexamination proceeding would unfairly deprive the requester of its statutory right to a determination of the patentability of the claims that are not the subject of the litigation, and thus not potentially subject to the estoppel provisions of 35 U.S.C. 317.

Therefore, upon reconsideration, element C has not been shown to have been satisfied.

⁵ 639 F.3d at 1309.

⁶ The patent owner also argues that the requester/defendant, as in *Katz*, requested that the court compel the patent owner to reduce the number of asserted claims. Whether the court required the patent owner to select a reduced number of asserted claims at the request of the requester, however, does not alter the fact that the patent owner has not shown that the court determined, or that the requester agreed, that claim 1 was “representative” of the originally asserted claims, i.e., that the claims under reexamination and the claims in litigation are identical, and has not shown how the requester could have raised, in the compending litigation, any issues raised in the reexamination proceeding with respect to the non-litigated claims.

Regarding element D, the patent owner provides evidence that the proceedings in the district court have concluded, and that the district court has entered a final judgment on the jury verdict. A brief review of the record reveals that the requester appealed the final judgment of the district court to the Federal Circuit on October 28, 2011. The requester, however, states in its October 28, 2011 appeal that “this matter is not yet ripe for appeal” because the district court “has not yet disposed of all of [the requester’s] pending claims”. Furthermore, even if it is later determined that the matter is ripe for appeal, the patent owner has not provided evidence that the appeal has been fully briefed. For these reasons, the patent owner has not shown that litigation has advanced to a late enough stage that there is a sufficient probability that a final decision will be adverse to the requester. Thus, item D has not been shown to have been satisfied.

See also *Sony Computer Entertainment America, Inc. v. Dudas*, 85 USPQ2d 1594 (E.D. Va. 2006), where the court upheld the Office’s determination of “good cause” to suspend two related *inter partes* reexamination proceedings. The facts of the present case, however, are clearly distinguishable from *Sony*. In *Sony*, the request for *inter partes* reexamination was not filed until after a final judgment in the district court was rendered. In the present case, however, the request for *inter partes* reexamination was filed well before trial began. In addition, reexamination in *Sony* was limited to the claims that were being litigated. In the present case, however, the claims under reexamination differ from those in the copending litigation. Furthermore, unlike *Sony*, the Office has already issued a right of appeal notice; while in *Sony*, an action on the merits had not yet been issued by the Office. Also, in *Sony*, an appeal to the Federal Circuit had been filed and had been fully briefed. Thus, a final decision in *Sony* was on the horizon. In the present case, however, there is evidence that the matter on appeal before the Federal Circuit may not be ripe for appeal, and even if it is later determined that the matter is ripe for appeal, the patent owner has not provided any evidence that the appeal has been fully briefed. In other words, the patent owner has not shown that a final decision *as to all claims under reexamination* is expected in the near future. Furthermore, the present proceeding has progressed on the merits. Without a final decision adverse to the requester as to *all* claims under reexamination, no estoppel can attach as to all claims, to mandate termination of the present ordered reexamination proceeding. The fact that estoppel could possibly attach as to some of the claims at some uncertain point in the future, as argued by patent owner, does not provide the requisite showing of good cause for suspension.

Accordingly, patent owner’s October 7, 2011 renewed petition under 37 CFR 1.182 to suspend the present reexamination proceeding is **dismissed**. Pursuant to MPEP 2686.04, the present *inter partes* reexamination proceeding **will continue**, and **will not be suspended**.

CONCLUSION

- The October 7, 2011 patent owner renewed petition is **dismissed**.
- The present *inter partes* reexamination proceeding **will continue**, and **will not be suspended**.

- Telephone inquiries related to this decision should be directed to the undersigned at (571) 272-7724.

/Cynthia L. Nessler/
Cynthia L. Nessler
Senior Legal Advisor
Office of Patent Legal Administration

2 22 2012



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JOHN S. PRATT, ESQ
KILPATRICK TOWNSEND & STOCKTON LLP
1100 PEACHTREE STREET
SUITE 2800
ATLANTA GA 30309

(For Patent Owner) **MAILED**

APR 18 2011

CENTRAL REEXAMINATION UNIT

PERKINS COIE LLP
PATENT-SEA
P.O. BOX 1247
SEATTLE, WA 98111-1247

(For Requester)

In re: Hans et alia
Reexamination Proceeding
Control No. 95/001,212
Request Deposited: August 18, 2009
For: U.S. Patent No. 7,245,636

:
: **DECISION**
: **DISMISSING**
: **PETITIONS**
:

The *inter partes* reexamination is before the Central Reexamination Unit to address the following papers:

1. The patent owner (PO) paper of April 29, 2010 entitled "PETITION UNDER 37 C.F.R. §1.182 TO STRIKE IMPROPER ARGUMENT IN THIRD PARTY REQUESTOR'S COMMENTS".
2. The PO paper of July 1, 2010 entitled "PETITION UNDER 37 C.F.R. §1.182 TO STRIKE IMPROPER ARGUMENT IN THIRD PARTY REQUESTOR'S COMMENTS".
3. The third party requester (3PR) paper of July 13, 2010 entitled "OPPOSITION TO PATENT OWNER'S 'PETITION UNDER 37 C.F.R. §1.182 TO STRIKE IMPROPER ARGUMENT IN THIRD PARTY REQUESTOR'S COMMENTS'".
4. The PO paper of December 23, 2010 entitled "PETITION UNDER 37 C.F.R. §1.182 TO STRIKE IMPROPER ARGUMENT IN THIRD PARTY REQUESTOR'S COMMENTS".

Art Unit: 3992

5. The 3PR paper of December 28, 2010 entitled "OPPOSITION TO PATENT OWNER'S 'PETITION UNDER 37 C.F.R. §1.182 TO STRIKE IMPROPER ARGUMENT IN THIRD-PARTY REQUESTER'S COMMENTS'".

The Notice of April 22, 2010 found the PO response of March 1, 2010 non-compliant and mooted the 3PR comments of March 31, 2010. Therefore, the April 29, 2010 petition is **dismissed as moot**.

Regarding the PO paper filed July 1, 2010, PO filed an Information Disclosure Statement (IDS) on January 13, 2010 including the ETSI TS 101297 v7.0.0, US Patent Number 6,535,979, and WO98/48528. On January 27, 2010, PO filed an IDS including the Tdoc NP-99260, Change Request A043r1. So, the 3PR IDS listing contains only duplicate citations of art that is already of record and should be lined through as duplicate entries. PO's requested relief to not consider the listings on 3PR's IDS is moot because PO has already made these references of record.

PO also argues that the 3PR comments of June 2, 2010 contain application of the PO-cited art to claim limitations that appear in original claims. However, PO has added new claims 21-42 in the response of May 7, 2010. The new claims depend from and/or include all the limitations that appear in the original claims. Therefore, when 3PR submits a proposed rejection as to the new claims, they must discuss the art with respect to limitations that appear in the original claims. It is noted that if the examiner chooses to reject the new claims with the newly proposed rejections and does not choose to extend the rejections to the original claims, 3PR would not have appeal rights as to a "non-adoption" of proposed rejections of original, unamended claims.

The July 1, 2010 petition is **dismissed**. The 3PR petition filed July 13, 2010 is **dismissed as moot**.

The December 23, 2010 and December 28, 2010 petitions are **dismissed as premature** as the examiner has not yet acted on the paper and made a determination to consider the comments or not.

Inquiries regarding this decision may be directed to Eric Keasel, Supervisory Patent Examiner, at (571) 272-4929.

This decision is not a final agency decision and is without prejudice to request reconsideration or higher-level review.



Eric Keasel
SPE, Central Reexamination Unit



The above-captioned reexamination proceedings are before the Office of Patent Legal Administration for *sua sponte* consideration of whether the proceedings should be merged under 37 CFR 1.989.

BACKGROUND

1. U.S. Patent No. 6,564,604 (“the ‘604 patent”) issued to Ronald Kefferstein et al. on May 20, 2003, with 7 claims.
2. A request for *inter partes* reexamination of claims 1-7 of the ‘604 patent was filed on August 20, 2009, by a third party requester, and was assigned control number 95/001,214 (“the ‘1214 *inter partes* proceeding”). The real party in interest is Severstal North America, Inc.
3. On September 25, 2009, *inter partes* reexamination was ordered for claims 1-7 of the ‘604 patent based on the examiner’s determination that the August 20, 2009 request raised a substantial new question of patentability affecting these claims. The order was accompanied by a non-final rejection action.
4. On November 25, 2009, patent owner submitted a response to the September 25, 2009 non-final rejection action. The November 25, 2009 patent owner response included the addition of new claims 8-16.
5. The ‘1214 requester filed comments on December 28, 2009, on patent owner’s November 25, 2009 response.
6. A second request for *inter partes* reexamination of claims 1-7 of the ‘604 patent was filed on April 30, 2010, by a third party requester, and was assigned control number 95/001,350 (“the ‘1350 *inter partes* proceeding”). The real party in interest is Corus Staal BV.
7. On May 20, 2010, *inter partes* reexamination was ordered for claims 1-7 of the ‘604 patent, and for new claims 8-16 contained in the ‘1214 reexamination proceeding, based on the examiner’s determination that the April 30, 2010 request raised a substantial new question of patentability affecting these claims. No Office action has been issued in the ‘1350 proceeding.
8. A third request for *inter partes* reexamination of claims 1-7 of the ‘604 patent was filed on May 12, 2010, by a third party requester, and was assigned control number 95/001,353 (“the 1353 *inter partes* proceeding”). The real party in interest is Voestalpine Stahl GmbH.
9. On June 2, 2010, *inter partes* reexamination was ordered for claims 1-7 of the ‘604 patent, and for new claims 8-16 contained in the ‘1214 reexamination proceeding, based on the examiner’s determination that the May 12, 2010 request raised a substantial new question of patentability affecting these claims. No Office action has been issued in the ‘1353 proceeding.

DECISION

I. MERGER OF PROCEEDINGS

Reexamination has been ordered in three proceedings for the same claims of the same patent. All three proceedings are *inter partes* proceedings. All three proceedings are still pending, and have not been terminated. Therefore, consideration of merger pursuant to 37 CFR 1.989 is ripe at this point in time.

37 CFR 1.989 provides:

(a) If any reexamination is ordered while a prior *inter partes* reexamination proceeding is pending for the same patent and prosecution in the prior *inter partes* reexamination proceeding has not been terminated, a decision may be made to merge the two proceedings or to suspend one of the two proceedings. Where merger is ordered, the merged examination will normally result in the issuance and publication of a single reexamination certificate under § 1.997.

In accordance with 37 CFR 1.989(a), the 95/001,214, 95/001,350 and 95/001,353 proceedings are merged. The merged proceeding will be conducted in accordance with the guidelines and requirements that follow.

II. THE SAME CLAIMS MUST BE MAINTAINED IN ALL THREE PROCEEDINGS

Patent owner is required to maintain the same claims (and specification) in all three files throughout the merged proceeding. Presently, the '1214 proceeding includes additional claims 8-16. Thus, the claims are not currently the same in all three files. An Office action requiring an amendment placing the claims in identical form is being issued concurrently with this decision. Patent owner must respond to the Office action in accordance with the procedures in 37 CFR 1.111. The third party requesters will then have an opportunity to comment on patent owner's response in accordance with the procedures in 37 CFR 1.947.

III. CONDUCT OF MERGED PROCEEDING

A. Governing regulations for the merged proceeding:

The present decision merges three *inter partes* reexamination proceedings. The merged proceeding is governed by 37 CFR 1.902 through 1.997. Pursuant to 37 CFR 1.989(a), the merged examination will normally result in the issuance and publication of a single reexamination certificate under 37 CFR 1.997.

It is noted that reexamination was ordered for claims 1-7 of the '604 patent in the '1214 proceeding, for claims 1-7 of the '604 patent and newly added claims 8-16 in the '1350 proceeding, and for claims 1-7 of the '604 patent and newly added claims 8-16 in the '1353 proceeding. The examiner will conduct reexamination in the merged proceeding for claims 1-7 of the '604 patent and for the newly added claims 8-16.

B. Papers mailed/filed:

All papers mailed by the Office throughout the merged proceeding will take the form of a single action which applies to all three proceedings. All papers issued by the Office, or filed by the patent owner and the third party requester(s), will contain the identifying data for all three proceedings and will be entered in each reexamination file. All papers filed by the patent owner and the third party requester(s) must consist of a single paper, **filed in duplicate**, each bearing a signature and identifying data for all three proceedings, for entry into each file.

All papers filed by the patent owner and the third party requester(s) should be directed:

by Mail to: Attn: Mail Stop "*Inter Partes* Reexam"
Central Reexamination Unit
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

by FAX to: (571) 273-9900
Central Reexamination Unit

by Hand to: Customer Service Window
Attn: Central Reexamination Unit
Randolph Building, Lobby Level
401 Dulany Street
Alexandria, VA 22314

by EFS: Registered users may submit papers via the
electronic filing system EFS-Web, at:

<https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html>

Patent owner and requester(s) are reminded that every paper filed in the merged proceeding subsequent to this decision must be served on the other parties, and every paper filed must reflect that such paper was served on the other parties, pursuant to 37 CFR 1.903. All papers are to be addressed to the Central Reexamination Unit as provided above.

C. Amendments:

The filing of any amendments to the specification, claims, or drawings must comply with 37 CFR 1.943, which incorporates the provisions of 37 CFR 1.530 and the guidelines of MPEP § 2666.01, which in turn references the guidelines of MPEP § 2250.

37 CFR 1.121 does not apply to amendments in reexamination. Accordingly, clean copies of the amended claims are not required and are not to be submitted; rather amendments are to be presented via markings pursuant to 37 CFR 1.530(f), except that a claim should be canceled by a statement canceling the claim, without presentation of the text of the claim.

Pursuant to 37 CFR 1.530(i), all amendments must be made relative to the patent specification,

including the claims, and drawings, which are in effect as of the date of filing the request for reexamination. *Amendments are not to be made relative to previous amendments.* Thus, for all amendments, all words not appearing in the patent are always underlined, and only words being deleted from the patent appear in brackets.

D. Fees:

Where a paper is filed which requires payment of a fee (e.g., extension of time fee, excess claims fee, petition fee, appeal fee, brief fee, oral hearing fee), only a single fee need be paid. For example, only one fee need be paid for patent owner's appellant brief (or that of one of the *inter partes* reexamination requesters) which may be filed, even though the brief relates to merged multiple proceedings, and copies must be filed (as pointed out above) for each file in the merged proceeding.

E. Citation of Patents and Printed Publications:

Upon return of the present merged proceeding to the examiner, the examiner will review the files to ensure that each file contains identical citations of prior patents and printed publications, and will cite such documents as are necessary as part of the next action in order to place the files in that condition.

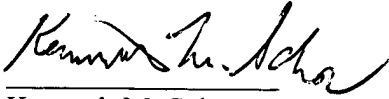
F. Appeal Procedure Reminders for *Inter Partes* Reexamination

The parties are reminded of the procedures for taking appeal in an *inter partes* reexamination as explained in MPEP 2674 and 2675. The appeal must only be taken from (1) the rejection(s) of the claims in the Right of Appeal Notice (RAN) that the *patent owner* proposes to contest, or (2) the finding(s) of patentability of claims in the RAN that the *third party requester* proposes to contest. Therefore, in the notice of appeal, the patent owner must identify each claim rejected by examiner that the patent owner intends to contest and the third party requester must identify each rejection *that was previously proposed by that third party requester* that the third party requester intends to contest. (37 CFR 41.61) The appellant's brief shall present a concise statement of each issue. Further, no new ground of rejection can be proposed by a third party requester appellant, unless such ground was withdrawn by the examiner during the prosecution of the proceeding, and the third party requester has not yet had an opportunity to propose it as a third party requester proposed ground of rejection. (37 CFR 41.67(c)(1)(vi))

CONCLUSION

1. *Inter partes* Reexamination Control No. 95/001,214, *inter partes* Reexamination No. 95/001,350 and *inter partes* Reexamination Control No. 95/001,353 are merged into a single proceeding, to be conducted in accordance with the procedure set forth above.
2. Jurisdiction over the merged reexamination is being forwarded via the Central Reexamination Unit Director to the examiner for the preparation of an Office action, to be issued in due course for the merged proceeding.
3. Any questions concerning this communication should be directed to Raul Tamayo in the

3. Any questions concerning this communication should be directed to Raul Tamayo in the Office of Patent Legal Administration, at (571) 272-7728.



Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

September 7, 2010



UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,220	08/12/2009	7536046	2756-00900	9941
41230	7590	09/15/2010	EXAMINER	
CUMMINS-ALLISON CORP. C/O NIXON PEABODY LLP 300 S. Riverside Plaza 16th Floor CHICAGO, IL 60606			ART UNIT	PAPER NUMBER

DATE MAILED: 09/15/2010

Please find below and/or attached an Office communication concerning this application or proceeding.



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

PERKINS COIE LLP

POST OFFICE BOX 1208

SEATTLE, WA 98111-1208

Date:

MAILED

SEP 15 2010

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001220

PATENT NO. : 7536046

TECHNOLOGY CENTER : 3999

ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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CHICAGO, IL 60606

(For Patent Owner)

MAILED

SEP 15 2010

CENTRAL REEXAMINATION UNIT

PERKINS COIE LLP
POST OFFICE BOX 1208
SEATTLE, WA 98111-1208

(For Third Party Requester)

In re Raterman et al.
Inter Partes Reexamination Proceeding
Control No.: 95/001,220
Filed: August 12, 2009
For: U.S. Patent No. 7,536,046

:
: **DECISION DISMISSING**
: **PETITION UNDER**
: **37 CFR 1.183**
:

This is a decision on the July 14, 2010 patent owner petition entitled "RENEWED PETITION FOR SUSPENSION OF THE RULES PURSUANT TO 37 CFR SECTION 1.183" requesting waiver of the 37 CFR 1.943(b) requirement that responses by the patent owner, in an *inter partes* reexamination proceeding, not exceed fifty (50) pages in length.

The petition is before the Office of Patent Legal Administration.

The petition fee of \$400.00 pursuant to 37 CFR 1.17(f) for the petition under 37 CFR 1.183 has been paid in the July 14, 2010 petition.

The petition is dismissed as moot.

BACKGROUND

1. U.S. Patent No. 7,536,046 (the '046 patent) issued on May 19, 2009.
2. A request for reexamination of the '046 patent was filed on August 12, 2009. The request was assigned control No. 95/001,220 (the '1220 reexamination proceeding).
3. Reexamination was ordered for the '1220 proceeding on October 26, 2009.

4. Also on October 26, 2009, a first Office action rejecting claims 1-30, 35-48, and 53-124 was mailed. A shortened statutory period of two months was set for the filing of a response to the Office action. Reexamination was not requested for claims 31-34 and 49-52.
5. On November 25, 2009, the patent owner filed a petition under 37 CFR 1.183 requesting waiver of the 37 CFR 1.943(b) requirement that responses by the patent owner, in an *inter partes* reexamination proceeding, not exceed fifty (50) pages in length.
6. On December 28, 2009, the patent owner filed a supplemental petition under 37 CFR 1.183 requesting waiver of the 37 CFR 1.943(b) requirement that responses by the patent owner not exceed fifty (50) pages in length.
7. Concurrently with its December 28, 2009 supplemental petition, the patent owner timely submitted (1) a response to the October 26, 2009 non-final Office action, and (2) an information disclosure statement. The patent owner response was accompanied by six (6) declarations and eight (8) exhibits, and the information disclosure statement was accompanied by ninety-three (93) non-patent literature (NPL) documents.
8. On January 27, 2010, third party requester timely filed comments pursuant to 37 CFR 1.947 that was accompanied by twenty-five (25) exhibits.
9. On June 30, 2010, the Office mailed a decision dismissing the November 25, 2009 patent owner petition, which was supplemented by the December 28, 2009 patent owner petition, as incomplete.
10. On July 14, 2010, patent owner filed the present petition entitled "RENEWED PETITION FOR SUSPENSION OF THE RULES PURSUANT TO 37 CFR SECTION 1.183" requesting waiver of the 37 CFR 1.943(b) requirement that responses by the patent owner, in an *inter partes* reexamination proceeding, not exceed fifty (50) pages in length.
11. Concurrently with its July 14, 2010 renewed petition, patent owner filed a copy of its December 28, 2008 response and the accompanying declarations and Exhibits 1-8.

DECISION

37 CFR 1.183 provides:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 CFR 1.943(b) provides:

Responses by the patent owner and written comments by the third party requester shall not exceed 50 pages in length, excluding amendments, appendices of claims, and reference materials such as prior art references.

MPEP 2667(I), provides in pertinent part:

Any affidavit or declaration (or a clearly defined portion thereof) that contains opinion(s) of the affiant/declarant, or argument(s) that the art either does or does not anticipate or render obvious the claims, or specific claim elements, of the patent under reexamination, is considered to be part of the comments submitted by the patent owner, or by the third party requester, and is subject to the page limit requirements of 37 CFR 1.943. Affidavits or declarations that are excluded from the page limit requirements include, for example, declarations attempting to swear behind (antedate) the filing date of a reference, or to establish the date of a printed publication, or declarations that provide comparative test data and an analysis of same. However, if the patent owner's affidavit or declaration includes any argument as to how an outstanding/proposed rejection is overcome, then the page(s) of the affidavit or declaration upon which the argument appears would be included against of the page limit count

I. Patent Owner's Renewed Petition

On June 30, 2010, the Office mailed a decision dismissing patent owner's original petition filed on November 25, 2009, which was supplemented by its December 28, 2009 petition, as incomplete. The original petition was incomplete due to patent owner's failure to properly label and identify the six declarations and eight exhibits referred to in patent owner's response. Consequently, the Office was unable to determine the effective page length of patent owner's response for purposes of evaluating patent owner's request for waiver of the page limit. The June 30, 2010 Office decision stated that patent owner may file, within 15 days from the date of the decision, a renewed petition that sufficiently identifies the declarations and Exhibits 1-8 that accompanied the December 28, 2009 patent owner response along with a copy of the patent owner response and accompanying declarations and Exhibits 1-8

In this instance, patent owner has filed a copy of the patent owner response and accompanying declarations and Exhibits 1-8 concurrently with the present renewed petition. In the renewed petition, patent owner includes a table identifying each of the six declarations and Exhibits 1-8 by title, date, and number of pages.

In the present renewed petition under 37 CFR 1.183, patent owner requests suspension of 37 CFR 1.943(b) with respect to the 50-page limit for the patent owner response to the October

26, 2009 non-final Office action, and requests that the page limit be extended to 100 pages.¹ In support of its request for waiver of the rule, patent owner asserts that the October 26, 2009 Office action rejected 116 of the 124 claims of the patent at issue, and those rejections incorporated by reference 366 pages of the claim charts (Appendices 3-6) submitted with the request for reexamination.² The patent owner also asserts that the 366 pages of the claim charts “refer to declarations of Emery and Dolsen, which in turn refer to a number of additional exhibits and declarations, which in turn refer to still additional exhibits.”³

Further in support of its request for waiver of the 50-page limit of 37 CFR 1.943(b), patent owner asserts in the present renewed petition that “there exist several substantial issues with respect to the alleged prior art, such as ‘enablement’ issues regarding some of the exhibits relied upon in those rejections,” and that patent owner’s response “shows that some of the exhibits are not enabling.”⁴

II. Analysis and Findings

The present renewed petition under 37 CFR 1.183 has been fully considered. 37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party. In this instance, the petitioner has made a showing in support of the request for waiver of 37 CFR 1.943(b) by attempting to draft a response in compliance with the 50-page limit, and submitting the response entitled “PATENT OWNER'S RESPONSE TO OFFICE ACTION IN INTER PARTES REEXAMINATION DATED OCTOBER 26, 2009 ” on December 28, 2009.

The December 28, 2009 patent owner response is accompanied by six declarations and Exhibits 1-8. The response consists of 77 pages. The following sections of the response are not included in the page limit count: the title page, 35 pages listing the claims, and the certificate of service page.

It is noted that, any portion of an affidavit/declaration that does not strictly adhere to presenting and explaining the evidence is subject to the 50-page limit of 37 CFR 1.943(b). Thus, opinion evidence that goes beyond explaining the evidence - legal arguments, e.g. assertions of obviousness and anticipation, are counted as remarks, and are thus part of the 50-page limit of 37 CFR 1.943(b).

Four of the six declarations accompanying the response include legal arguments that the art either does or does not anticipate or render obvious the claims of the patent at issue. The declaration of Clay Collins and the declaration of Francisco Lopez do not contain legal arguments that the art either does or does not anticipate or render obvious the claims at issue.

¹ Renewed Petition at page 3.

² *Id.* at page 4

³ *Id.*

⁴ *Id.*

The following declarations contain legal arguments regarding whether the claims are obvious over or anticipated by the prior art:

- (1) The declaration of William Jones on pages 3-5;
- (2) The declaration of John DiBlasio on page 4;
- (3) The declaration of Douglas Mennie⁵ on pages 2-4; and
- (4) The declaration of William Sherman III on pages 3-4.

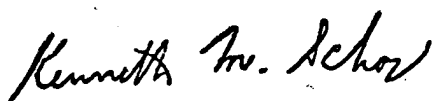
Exhibits 1-8 do not contain legal arguments regarding whether the prior art anticipates or renders obvious the claimed invention at issue in the present reexamination proceeding.⁶

Therefore, a total of 49 pages of the patent owner response (nine pages from the four declarations discussed above) are counted toward the page-limit, which is within the 50 page limit of 37 CFR 1.943(b).

Accordingly, patent owner's petition under 37 CFR 1.183 is **dismissed as moot**, as the response of December 28, 2009 to the October 26, 2009 non-final Office action is page-length compliant.

CONCLUSION

1. The patent owner petition under 37 CFR 1.183 is **dismissed as moot**, as patent owner's December 28, 2009 response, accompanied by six declarations and Exhibits 1-8, is page-length compliant.
2. Jurisdiction for the instant reexamination proceeding is returned to the Central Reexamination Unit (CRU).
3. Any questions concerning this communication should be directed to Susy Tsang-Foster, Legal Advisor, at 571-272-7711.



Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

Kenpet8
9-14-10

⁵ The six page Douglas Mennie declaration executed on December 28, 2009.

⁶ The 11 page declaration of Douglas Mennie executed on October 1, 2002 included in Exhibit 4 and the 10 pages of infringement claim charts in Exhibit G included within Exhibit 4 do not contain legal arguments that the prior art anticipates or renders obvious the claimed invention at issue in the present reexamination proceeding.



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United States Patent and Trademark Office
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P.O. Box 1450
Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,220	08/12/2009	7536046	2756-00900	9941

41230 7590 04/15/2011

CUMMINS-ALLISON CORP.
C/O NIXON PEABODY LLP
300 S. Riverside Plaza
16th Floor
CHICAGO, IL 60606

EXAMINER

ART UNIT

PAPER NUMBER

DATE MAILED: 04/15/2011

Please find below and/or attached an Office communication concerning this application or proceeding.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

Inter partes Mahbub A. Siddiqui

v.

Cummins-Allison Corp.

Reexamination Control Nos. 95/001,220

Patent 7,536,046

Technology Center 3900

DECISION ON PETITION

This is a decision on patent owner's "Petition under 37 C.F.R. § 1.183" filed March 24, 2011 ("Present Petition"). Petitioner is requesting waiver of the 15 page limit of 37 C.F.R. § 1.943(c), to permit entry of a 30-page respondent brief. The petition fee of \$400 in accordance with 37 C.F.R. § 1.17(f) was charged to petitioner's deposit account on March 24, 2011.

FINDINGS

1. On August 12, 2009, third party requester filed a request for *inter partes* reexamination of U.S. Patent No. 7,536,046, which was assigned control no. 95/001,220.
2. Reexamination was ordered on October 26, 2009, and a non-final Office action was mailed on the same date.
3. Prosecution was conducted and a Right of Appeal Notice was mailed on December 17, 2010.
4. Requester filed a Notice of Appeal on January 13, 2011.
5. Requester filed an appellant brief on March 11, 2011.
6. On March 24, 2011, patent owner filed the present petition.
7. On April 11, 2011, patent owner filed a respondent brief.

RELEVANT AUTHORITY

37 CFR § 1.183 provides:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

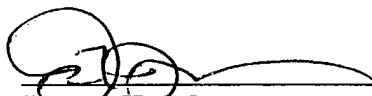
37 CFR § 1.943(c) provides:

Appellant's briefs filed by the patent owner and the third party requester shall not exceed thirty pages or 14,000 words in length, excluding appendices of claims and reference materials such as prior art references. All other briefs filed by any party shall not exceed fifteen pages in length or 7,000 words. If the page limit for any brief is exceeded, a certificate is required stating the number of words contained in the brief.

DECISION

In the present petition, patent owner is requesting waiver of 37 C.F.R. § 1.943(c), which limits the respondent brief to 15 pages or 7,000 words in length, to permit a 30-page respondent brief. However, a review of the record reveals that the patent owner's respondent brief filed on April 11, 2011, is 16 pages and is stated to be less than 7,000 words in a certificate accompanying the brief. Therefore, the present petition is **dismissed as moot**.

In view of the foregoing, the present petition is DISMISSED.



James T. Moore
Acting Chief Administrative Patent Judge

Inter Partes Reexamination Control No. 95/001,220
Patent No. 7,536,046

Counsel for Patent Owner:

Cummins-Allison Corp.
c/o NIXON PEABODY LLP
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Chicago, IL 60606

Counsel for Third Party Requester:

Seth M. Reiss, AAL
A LIMITED LIABILITY LAW COMPANY
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Wood, Herron & Evans, LLP
2700 Carew Tower
441 Vine Street
Cincinnati, OH 45202

(For Patent Owner)

MAILED

OCT 17 2011

Richard D. McLeod, Esq.
Klarquist Sparkman, LLP
121 SW Salmon Street
Suite 1600
Portland, OR 97204

(For Requester)

CENTRAL REEXAMINATION UNIT

In re Juan C. Vélez et al.
Inter Partes Reexamination Proceeding
Control No. 95/001,221
Filed: August 12, 2009
For: U.S. Patent No. 7,043,450

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: **DECISION GRANTING**
: **PETITION UNDER**
: **37 CFR 1.137(b)**

In re Juan C. Vélez et al.
Inter Partes Reexamination Proceeding
Control No. 95/001,308
Filed: February 2, 2010
For: U.S. Patent No. 7,043,450

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This is a decision on the August 15, 2011 patent owner petition under 37 CFR 1.137(b) to accept a delayed response to Office action and revive the present terminated merged reexamination proceeding ("the August 15, 2011 patent owner petition to revive").

The August 15, 2011 patent owner petition to revive is before the Office of Patent Legal Administration (OPLA) for consideration.

The August 15, 2011 patent owner petition to revive is **granted**.

The August 12, 2011 Notice of Intent to Issue Inter Partes Reexamination Certificate (NIRC) based on the termination of prosecution for failure to timely respond to the Office action of September 28, 2010, is **withdrawn**.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

35 U.S.C. 41(a)(7) provides, in pertinent part:

REVIVAL FEES. — On filing each petition ... for an unintentionally delayed response by the patent owner in any reexamination proceeding ...

35 U.S.C. 133 provides:

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Director in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Director that such delay was unavoidable.

35 U.S.C. 314(a) provides, in pertinent part:

IN GENERAL. — Except as otherwise provided in this section, reexamination shall be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133 of this title.

37 CFR 1.137 provides, in pertinent part:

(b) *Unintentional*. If the delay in reply by ... patent owner was unintentional, a petition may be filed pursuant to this paragraph to revive ... a reexamination prosecution terminated under §§ 1.550(d) or 1.957(b) or limited under § 1.957(c) A grantable petition pursuant to this paragraph must be accompanied by:

- (1) The reply required to the outstanding Office action or notice, unless previously filed;
- (2) The petition fee as set forth in § 1.17(m);
- (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Director may require additional information where there is a question whether the delay was unintentional

*

*

(d) *Terminal disclaimer*.

*

*

- (3) The provisions of paragraph (d)(1) of this section do not apply to ... reexamination proceedings.

37 CFR 1.945(a) provides, in pertinent part:

The patent owner will be given at least thirty days to file a response to any Office action on the merits of the *inter partes* reexamination.

37 CFR 1.957(b) provides, in pertinent part:

If no claims are found patentable, and the patent owner fails to file a timely and appropriate response in an *inter partes* reexamination proceeding, the prosecution in the reexamination proceeding will be a terminated prosecution and the Director will proceed to issue and publish a certificate concluding the reexamination proceeding under § 1.997 in accordance with the last action of the Office.

37 CFR 1.958(b) provides, in pertinent part:

Any response by the patent owner not timely filed in the Office may be accepted if the delay was unintentional. A grantable petition to accept an unintentionally delayed response must be filed in compliance with § 1.137(b).

MPEP 2668 provides, in pertinent part:

II. PETITION BASED ON UNINTENTIONAL DELAY

The unintentional delay fee provisions of 35 U.S.C. 41(a)(7) are imported into, and are applicable to, any reexamination proceeding by Sec. 4605(a) of the American Inventors Protection Act of 1999. Accordingly, the Office will consider, in appropriate circumstances, a petition showing unintentional delay under 37 CFR 1.137(b) where untimely papers are filed by the patent owner subsequent to the order for reexamination. Any such petition must provide a verified statement that the delay was unintentional, a proposed response to continue prosecution (unless it has been previously filed), and the petition fee required by 37 CFR 1.17(m).

*

*

IV. FURTHER DISCUSSION OF THE PETITION REQUIREMENTS

See also MPEP § 711.03(c), subsection III, for a detailed discussion of the requirements of petitions filed under 37 CFR 1.137(a) and (b).

DECISION

The Petition Under 37 CFR 1.137(b) is Granted

A grantable petition under 37 CFR 1.137(b) for a reexamination proceeding must be accompanied by: (1) a response to the outstanding Office action; (2) the petition fee set forth in 37 CFR 1.17(m); and (3) a proper statement under 37 CFR 1.137(b)(3) that the entire delay in filing the required response from the due date of the response to the filing of a grantable petition was unintentional.

Regarding item (1), this merged reexamination proceeding prosecution was terminated under 37 CFR 1.957(b) due to patent owner's failure to timely submit a response to the September 28, 2010 Office action pursuant to 37 CFR 1.945(a). 37 CFR 1.945(a) provides that the patent owner will be given at least thirty days to file a response to any Office action on the merits of the *inter partes* reexamination. The September 28, 2010 Office action set a two-month period for response. A complete response to the September 28, 2010 Office action was not filed until November 30, 2010, which was untimely. However, for the purpose of evaluating whether the August 15, 2011 patent owner petition to revive is a grantable petition, the submission of the (i) November 30, 2010 Amendment In Response To Non-Final Office Action and (ii) Declaration Of Juan C. Vélez And Daren Murrer satisfies item (1).¹

Patent owner has been charged the \$810.00 petition fee, thereby satisfying item (2).

A proper statement under 37 CFR 1.137(b)(3) was submitted as part of the August 15, 2011 patent owner petition to revive, thereby satisfying item (3).

The present proceeding is a merged reexamination proceeding; thus, the petition does not require a terminal disclaimer.²

Accordingly, the August 15, 2011 patent owner petition to revive is **granted**.

The August 12, 2011 Notice of Intent to Issue Inter Partes Reexamination Certificate (NIRC) based on the termination of prosecution for failure to timely respond to the Office action of September 28, 2010, is **withdrawn**.

CONCLUSION

1. The August 15, 2011 patent owner petition under 37 CFR 1.137(b) has been **granted**.
2. The August 12, 2011 Notice of Intent to Issue *Inter Partes* Reexamination Certificate (NIRC) based on the termination of prosecution for failure to timely file an appropriate response to the Office action of September 28, 2010, is **withdrawn**.
3. Patent owner's response to the September 28, 2010 Office action is hereby entered in the record, thus triggering a comment right for third party requester

¹ This decision is not directed to either (i) the persuasiveness and propriety of the arguments presented in patent owner's November 30, 2010 Amendment and Declaration as to each of the rejections set forth in the September 28, 2010 Office action or (ii) the November 30, 2010 Amendment's compliance with formal matters; such is the examiner's province.

² See: 37 CFR 1.137(d)(3).

under 37 CFR 1.947. Accordingly, third party requester may file comments to patent owner's response as per 37 CFR 1.947 within 30 days of the mailing date of this decision.

4. Any inquiry concerning this decision should be directed to the undersigned at (571) 272-7728.



Raul Tamayo
Legal Advisor
Office of Patent Legal Administration

September 30, 2011



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FLACHSBART & GREENSPOON, LLC
333 N. MICHIGAN AVE.
27TH FLOOR
CHICAGO IL 60601

MAILED
(For Patent Owner)
MAR 31 2011

CENTRAL REEXAMINATION UNIT

NOVAK DRUCE & QUIGG, LLP
(NDQ REEXAMINATION GROUP)
1000 LOUISIANA STREET
FIFTY-THIRD FLOOR
HOUSTON, TX 77002

(For Requester)

In re: Knotts
Reexamination Proceeding
Control No. 95/001,222
Request Deposited: August 19, 2009
For: U.S. Patent No. 7,430,425

:
:
: **DECISION**
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This is a decision on the July 23, 2010 paper entitled "PETITION UNDER 37 C.F.R. 1.181 TO WITHDRAW ACTION CLOSING PROSECUTION AS PREMATURE".

The subsequent action (mailed October 27, 2010) withdrew the ACP, entered the response and then closed prosecution. In view of the subsequent action, the request to withdraw the first ACP is dismissed as moot.

CONCLUSION

1. Petitioner's request to withdraw the first ACP as premature is **dismissed**.
2. Inquiries regarding this decision may be directed to Eric Keasel, Supervisory Patent Examiner, at (571) 272-4929.

Application/Control Number: 95/001,222

Page 2

Art Unit: 3992

3. This decision is not a final agency decision and is without prejudice to request reconsideration or higher-level review.

A handwritten signature in cursive script, appearing to read "Eric Keasel", written over a horizontal line.

Eric Keasel

SPE, AU 3992, Central Reexamination Unit



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,223	09/22/2009	7324833	AFF.0004B2US	1290
21906	7590	11/19/2010	EXAMINER	
TROP, PRUNER & HU, P.C. 1616 S. VOSS ROAD, SUITE 750 HOUSTON, TX 77057-2631			ART UNIT	PAPER NUMBER

DATE MAILED: 11/19/2010

Please find below and/or attached an Office communication concerning this application or proceeding.



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
KENYON & KENYON LLP
ONE BROADWAY
NEW YORK, NY 10004

Date:

MAILED

NOV 19 2010

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001223
PATENT NO. : 7324833
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,264	11/13/2009	7324833	AFF.0004B5US	6910
21906	7590	11/19/2010	EXAMINER	
TROP, PRUNER & HU, P.C. 1616 S. VOSS ROAD, SUITE 750 HOUSTON, TX 77057-2631			ART UNIT	PAPER NUMBER

DATE MAILED: 11/19/2010

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
NOVAK DRUCE & QUIGG, LLP
(NDQ REEXAMINATION GROUP)
1000 LOUISIANA STREET, FIFTY-THIRD FLOOR
HOUSTON, TX 77002

Date:

MAILED

NOV 19 2010

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001264
PATENT NO. : 7324833
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,333	11/07/2008	7324833	AFF.0004B1US	6333
21906	7590	11/19/2010	EXAMINER	
TROP, PRUNER & HU, P.C. 1616 S. VOSS ROAD, SUITE 750 HOUSTON, TX 77057-2631			ART UNIT	PAPER NUMBER

DATE MAILED: 11/19/2010

Please find below and/or attached an Office communication concerning this application or proceeding.



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KNOBBE MARTENS OLSON & BEAR LLP
2040 MAIN STREET
FOURTEENTH FLOOR
IRVINE, CA 92614

Date:

MAILED

NOV 19 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010333
PATENT NO. : 7324833
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified ex parte reexamination proceeding (37 CFR 1.550(f)).

Where this copy is supplied after the reply by requester, 37 CFR 1.535, or the time for filing a reply has passed, no submission on behalf of the ex parte reexamination requester will be acknowledged or considered (37 CFR 1.550(g)).



United States Patent and Trademark Office

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NOV 19 2010

TROP, PRUNER & HU, P.C.
1616 S. VOSS ROAD, SUITE 750
HOUSTON, TX 77057-2631

(For Patent Owner) **CENTRAL REEXAMINATION UNIT**

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(For second *Inter Partes* Requester)

KNOBBE, MARTENS OLSON & BEAR, LLP
2040 MAIN ST. 14TH FLOOR
IRVINE, CA 92614

(For *Ex Parte* Requester)

Inter Partes Reexamination Proceeding
Control No. 95/001,223
Filed: September 22, 2009
For: U.S. Patent No. 7,324,833

Inter Partes Reexamination Proceeding
Control No. 95/001,264
Filed: November 13, 2009
For: U.S. Patent No. 7,324,833

Ex Parte Reexamination Proceeding
Control No. 90/010,333
Filed: November 7, 2008
For: U.S. Patent No. 7,324,833

**DECISION
GRANTING-IN-PART
PETITION**

This is a decision on the September 14, 2010 patent owner petition entitled "PETITION UNDER 37 C.F.R. § 1.183 TO WAIVE PAGE LIMIT REQUIREMENT FOR THE PATENT OWNER REPLY UNDER 37 C.F.R. § 1.943(b)."

The petition requests waiver of the requirement of 37 CFR 1.943(b) that the patent owner response not exceed fifty (50) pages in length, and requests that the page limit be extended to 141 pages in order to fully address the June 14, 2010 non-final Office action. Patent owner timely filed its response pursuant to 37 CFR 1.945 concurrently with the petition.

The petition is before the Office of Patent Legal Administration for consideration.

Patent owner's petition under 37 CFR 1.183 to waive the 37 CFR 1.943(b) limit as to the number of pages permitted in patent owner's response is granted to the extent that the page limit for patent owner's response is extended to not exceed 81 pages in length, excluding amendments, appendices of claims, and reference materials such as prior art references.

FEES

The petition fee of \$400.00 pursuant to 37 CFR 1.17(f) for patent owner's petition under 37 CFR 1.183 has been paid.

REVIEW OF RELEVANT FACTS

1. On January 29, 2008, the Office issued U.S. Patent No. 7,324,833 (the '833 patent) to White *et al.*
2. On November 7, 2008, a request for *ex parte* reexamination of all the claims in the '833 patent was filed by a third party requester. The request was assigned control number 90/010,333 (the '10333 proceeding).
3. On December 19, 2008, *ex parte* reexamination was ordered on all the claims of the '833 patent in the '10333 proceeding.
4. On August 5, 2009, a non-final Office action was mailed in the '10333 proceeding, rejecting all the claims of the '833 patent.
5. On September 22, 2009, a first request for *inter partes* reexamination of all the claims in the '833 patent was filed by a third party requester and real party in interest, Volkswagen Group of Americas, Inc. The request was assigned control number 95/001,223 (the '1223 proceeding).
6. On October 2, 2009, patent owner timely filed, in the '10333 proceeding, an amendment and response to the August 5, 2009 Office action, amending claims 1 and 17. No claims were added or canceled.
7. On November 9, 2009, *inter partes* reexamination was ordered in the '1223 proceeding.

8. On November 13, 2009, a second request for *inter partes* reexamination of all the claims in the '833 patent, was filed by a third party requester and real party in interest, Apple, Inc. The request was assigned control number 95/001,264 (the '1264 proceeding).
9. On February 5, 2010, *inter partes* reexamination was ordered in the '1264 proceeding.
10. On June 14, 2010, the '10333, '1223, and '1264 proceedings were merged. A non-final Office action was mailed on even date.
11. On July 15, 2010, patent owner filed a request for a one-month extension of time pursuant to 37 CFR 1.956 for filing a response to the June 14, 2010 non-final Office action.
12. On July 21, 2010, the Office mailed a decision granting the requested one-month extension, setting the response due date to September 14, 2010.
13. On September 14, 2010, patent owner filed the instant petition entitled "PETITION UNDER 37 C.F.R. § 1.183 TO WAIVE PAGE LIMIT REQUIREMENT FOR THE PATENT OWNER REPLY UNDER 37 C.F.R. § 1.943(b)." Concurrently with the petition, patent owner timely filed a response to the June 14, 2010 non-final Office action.

DECISION

I. Relevant Regulations and Procedure

37 CFR 1.183 provides:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 CFR 1.943(b) provides:

Responses by the patent owner and written comments by the third party requester shall not exceed 50 pages in length, excluding amendments, appendices of claims, and reference materials such as prior art references.

MPEP § 2667(I), (TYPES OF PAPERS RETURNED WITH CENTRAL REEXAMINATION UNIT DIRECTOR OR REEXAMINATION LEGAL ADVISOR APPROVAL REQUIRED), provides in pertinent part:

Any affidavit or declaration (or a clearly defined portion thereof) that contains opinion(s) of the affiant/declarant, or argument(s) that the art either does or does not anticipate or render obvious the claims, or specific claim elements, of the patent under reexamination, is considered to be part of the comments submitted by the patent owner, or by the third party requester, and is subject to the page limit requirements of 37 CFR 1.943. Affidavits or declarations that are excluded from the page limit

requirements include, for example, declarations attempting to swear behind (antedate) the filing date of a reference, or to establish the date of a printed publication, or declarations that provide comparative test data and an analysis of same. However, if the patent owner's affidavit or declaration includes any argument as to how an outstanding/proposed rejection is overcome, then the page(s) of the affidavit or declaration upon which the argument appears would be included against of the page limit count. Likewise, if a third party requester affidavit or declaration includes any argument as to how a rejection is supported, then the page(s) of the affidavit or declaration upon which the argument appears would be included against of the page limit count. Similarly, attached exhibits presenting data or drawings are not included against the page limit count, unless an exhibit or drawing includes argument as to how the outstanding rejection is overcome. Any page(s) of the exhibit or sheet(s) of drawings that include such argument would be included against the page limit count.

II. Patent Owner's Petition

In the instant petition, patent owner requests waiver of the requirement under 37 CFR 1.943(b) with respect to the 50-page limit for patent owner's response filed on September 14, 2010 to address the June 14, 2010 non-final Office action, and requests that the page limit be extended to 141 pages.¹ In support of its request for waiver of the rule, patent owner argues that large portions of the request were incorporated by reference into the 46 page Office action and that patent owner's 141 page submission is much smaller than the more than 800 pages constituting the three different Requests for reexamination and accompanying exhibits.² Patent owner asserts that "this waiver is in keeping with the substantial interest of justice, in that the Patent Owner should have the opportunity to adequately respond and amend the claims in view of the pending claim rejections" and that "[e]nforcing the page limit would prevent the Patent Owner from making a full and complete response to the Office Action as required by the patent statute and the rules."³

III. Analysis and Findings

37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party. The burden is on petitioner to set forth with specificity the facts that give rise to an extraordinary situation in which justice requires suspension of a rule. A showing which petitioner can make in support of a request for waiver of the 50-page limit of 37 CFR 1.943(b) can be an attempt to draft comments in compliance with the 50-page limit, and submission of the resulting comments paper that is in excess of 50 pages concurrently with a petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b), requesting entry of the submitted comments. Such a comments submission can be evaluated for economizing, extraneous material, and arrangement, without repetition of information already of record. In this way, petitioner can rely on the proposed comments submission: (1) for justification that more pages are needed to complete the comments submission, and (2) to set forth an accurate determination of exactly how many additional pages are needed to complete the comments submission.

¹ Petition at page 2.

² *Id.*

³ *Id.*

The instant petition under 37 CFR 1.183 has been fully considered. In this instance, petitioner patent owner's September 14, 2010 response includes 37 pages of remarks, which are subject to the 50 page limit. The following sections of the response are not included in the page limit: the cover page, the five page listing of claims, the signature page, and the two pages of certificate of service.

The patent owner response is also accompanied by Appendix A, Appendix B, declarations of Paul Polansky under 37 CFR 1.132 and of Russell White under 37 CFR 1.132, and four pages of certificate of service for these two declarations.

There are no *per se* rules for determining whether a document, such as an affidavit or declaration, contains a legal argument that will cause the document to be subject to the page count. Each determination is made on a case-by-case basis. In determining whether a document such as an affidavit or declaration under 37 CFR 1.132, or any other document of a submission, includes legal argument, the Office analyzes whether the document is providing factual evidence, i.e., evidence of **technological** facts, or whether the affidavit or declaration is merely an extension of the arguments of counsel. Factual evidence includes, for example, declarations that swear behind the filing date of a reference, that establish the date of a printed publication, that provide a technical explanation or technical definition of terms of art used by a reference, or that provide comparative test results and a scientific, or technological, analysis of the results (see, e.g., MPEP 716.02). If a document is limited to factual evidence, the document is not included in the page count. In addition, affidavits or declarations **limited to** establishing commercial success, long-felt need and failure of others, skepticism of experts, or copying, as per MPEP 716.03 -716.06, respectively, will not be included in the page count.

Appendix A is a 4-page claim chart showing support for the new claims, and is counted toward the page limit. Appendix B consists of Office actions, applicant's responses to those Office actions, and an interview summary, all of which are from the original prosecution of the instant patent under reexamination. The copies of these documents, which are of record for the patented file, do not count toward the page limit.

The declaration of Polansky and the accompanying Appendices A-Y do not contain any legal arguments and therefore do not count toward the page limit.

The declaration of White is accompanied by Exhibits A-M and contain legal arguments as follows: On page 2, declarant White states: "The following facts establish that the claims of the '833 patent are not obvious..." On page 8, declarant White states: "For at least these reasons, the claims of the '833 patent are not obvious." The remaining pages of the White declaration are strictly drawn to evidence of commercial success and/or copying, which do not count toward the page limit. Attached Exhibit C is a 31-page Claim Construction order that is replete with legal arguments and relied upon by patent owner in its remarks; therefore, the claim construction order is counted toward the page limit. Exhibit D is patent owner's infringement contentions and contain legal arguments regarding the priority date of the patent claims on pages 3-5, 7-9, and 11, which count toward the page limit.

Accordingly, the September 14, 2010 patent owner response *in toto* is 81 pages in length.

Upon review of the submitted response for economizing, extraneous material, and arrangement, without repetition of information already of record, it is found that the 31 pages of arguments in excess of 50 required to complete the patent owner's response are not unreasonable in this instance, in view of the present facts and circumstances. The June 14, 2010 non-final Office action is 46 pages in length (excluding 6 cover sheets) and incorporates by reference 36 pages of the Request and more than 57 pages of the claim charts accompanying the Request. The June 14, 2010 non-final Office is effectively more than 139 pages in length.

37 CFR 1.183 permits waiver of the page limitation requirement of the regulations in an extraordinary situation when justice requires. Under the facts and circumstances currently of record in the present merged reexamination proceeding, the instant patent owner petition is deemed to establish that a waiver of 37 CFR 1.943(b) to the extent of permitting patent owner's response to run 81 pages in length is appropriate in the interest of justice.

Accordingly, patent owner's petition under 37 CFR 1.183 is **granted** to the extent that the page limit of 37 CFR 1.943(b) is waived as to the **31 pages** of the arguments portion of patent owner's September 14, 2010 response that exceed the 50-page limit.

CONCLUSION

1. Patent owner's petition under 37 CFR 1.183 is **granted-in-part**, and the page limit of 37 CFR 1.943(b) is **waived to the extent that** patent owner's response to the June 14, 2010 Office action **not exceed 81 pages** in length, excluding appendices of claims and reference materials, such as prior art references. **This waiver makes the September 14, 2010 patent owner response page-length compliant.**
2. Telephone inquiries related to the present decision should be directed to the Susy Tsang-Foster, Legal Advisor, at 571-272-7711.



Cynthia L. Nessler
Senior Legal Advisor
Office of Patent Legal Administration

11-18-10
Cindypet/



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United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,223	09/22/2009	7324833	AFF.0004B2US	1290
21906	7590	01/06/2011	EXAMINER	
TROP, PRUNER & HU, P.C. 1616 S. VOSS ROAD, SUITE 750 HOUSTON, TX 77057-2631			ART UNIT	PAPER NUMBER

DATE MAILED: 01/06/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

KENYON & KENYON LLP

ONE BROADWAY

NEW YORK, NY 10004

Date:

MAILED

JAN 06 2011

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

CENTRAL REEXAMINATION UNIT

REEXAMINATION CONTROL NO. : 95001223

PATENT NO. : 7324833

TECHNOLOGY CENTER : 3999

ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,264	11/13/2009	7324833	AFF.0004B5US	6910
21906	7590	01/06/2011	EXAMINER	
TROP, PRUNER & HU, P.C. 1616 S. VOSS ROAD, SUITE 750 HOUSTON, TX 77057-2631			ART UNIT	PAPER NUMBER

DATE MAILED: 01/06/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
NOVAK DRUCE & QUIGG, LLP
(NDQ REEXAMINATION GROUP)
1000 LOUISIANA STREET, FIFTY-THIRD FLOOR
HOUSTON, TX 77002

Date:
MAILED

JAN 06 2011

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001264
PATENT NO. : 7324833
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,333	11/07/2008	7324833	AFF.0004B1US	6333
21906	7590	01/06/2011	EXAMINER	
TROP, PRUNER & HU, P.C. 1616 S. VOSS ROAD, SUITE 750 HOUSTON, TX 77057-2631			ART UNIT	PAPER NUMBER

DATE MAILED: 01/06/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
KNOBBE MARTENS OLSON & BEAR LLP
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FOURTEENTH FLOOR
IRVINE, CA 92614

Date:

MAILED

JAN 06 2011

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010333
PATENT NO. : 7324833
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified ex parte reexamination proceeding (37 CFR 1.550(f)).

Where this copy is supplied after the reply by requester, 37 CFR 1.535, or the time for filing a reply has passed, no submission on behalf of the ex parte reexamination requester will be acknowledged or considered (37 CFR 1.550(g)).



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TROP, PRUNER & HU, P.C.
1616 S. VOSS ROAD, SUITE 750
HOUSTON, TX 77057-2631

(For Patent Owner)

MAILED

JAN 06 2011

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ONE BROADWAY
NEW YORK, NY 10004

(For first *Inter Partes* Requester)

NOVAK, DRUCE & QUIGG LLP
(NDQ REEXAMINATION GROUP)
1000 LOUISIANA AVENUE
FIFTY-THIRD FLOOR
HOUSTON, TX 77002

(For second *Inter Partes* Requester)

KNOBBE, MARTENS OLSON & BEAR, LLP
2040 MAIN ST. 14TH FLOOR
IRVINE, CA 92614

(For *Ex Parte* Requester)

Inter Partes Reexamination Proceeding
Control No. 95/001,223
Filed: September 22, 2009
For: U.S. Patent No. 7,324,833

Inter Partes Reexamination Proceeding
Control No. 95/001,264
Filed: November 13, 2009
For: U.S. Patent No. 7,324,833

Ex Parte Reexamination Proceeding
Control No. 90/010,333
Filed: November 7, 2008
For: U.S. Patent No. 7,324,833

**DECISION
DISMISSING
PETITION**

This is a decision on the October 20, 2010 patent owner petition entitled "PETITION UNDER 37 C.F.R. § 1.183" (the petition under 37 CFR 1.183), requesting waiver of the 37 CFR 1.98 copy requirement and the 37 CFR 1.903 service requirement with respect to "non-U.S. references" (i.e., non-U.S. patent documents and non-patent literature) cited in patent owner's concurrently filed information disclosure statement (IDS) submissions.

The petition is before the Office of Patent Legal Administration for consideration.

The petition fee of \$400.00 pursuant to 37 CFR 1.17(f) for patent owner's petition under 37 CFR 1.183 has been paid.

Patent owner's petition under 37 CFR 1.183 is dismissed for the reasons set forth herein.

BACKGROUND

1. On January 29, 2008, the Office issued U.S. Patent No. 7,324,833 (the '833 patent) to White *et al.*
2. On November 7, 2008, a request for *ex parte* reexamination of the '833 patent was filed by a third party requester. The request was assigned control number 90/010,333 (the '10333 proceeding).
3. On December 19, 2008, *ex parte* reexamination was ordered for the '10333 proceeding.
4. On September 22, 2009, a first request for *inter partes* reexamination of the '833 patent was filed by a third party requester and real party in interest, Volkswagen Group of Americas, Inc.. The request was assigned control number 95/001,223 (the '1223 proceeding).
5. On November 9, 2009, *inter partes* reexamination was ordered for the '1223 proceeding.
6. On November 13, 2009, a second request for *inter partes* reexamination of the '833 patent was filed by a third party requester and real party in interest, Apple, Inc.. The request was assigned control number 95/001,264 (the '1264 proceeding).
7. On February 5, 2010, *inter partes* reexamination was ordered for the '1264 proceeding.
8. On June 14, 2010, the '10333, '1223, and '1264 proceedings were merged (the merged proceeding). A non-final Office action was mailed on even date.
9. On September 14, 2010, patent owner timely filed a response to the June 14, 2010 non-final Office action.¹
10. On October 20, 2010, patent owner filed the instant petition under 37 CFR 1.183, concurrently with IDS submissions.

¹ On July 21, 2010, the Office mailed a decision granting patent owner's July 15, 2010 request for a one-month extension of time, setting the response due date to September 14, 2010.

DECISION

I. Relevant Regulations and Procedure

37 CFR 1.98(a)(2) provides that any IDS filed under § 1.97 shall include:

A legible copy of:

- (i) Each foreign patent;
- (ii) Each publication or that portion which caused it to be listed, other than U.S. patents and U.S. patent application publications unless required by the Office;
- (iii) For each cited pending unpublished U.S. application, the application specification including the claims, and any drawing of the application, or that portion of the application which caused it to be listed including any claims directed to that portion; and
- (iv) All other information or that portion which caused it to be listed.

37 CFR 1.555(a) provides in-part (emphasis added):

The duty to disclose all information known to be material to patentability in a reexamination proceeding is deemed to be satisfied if all information known to be material to patentability of any claim in the patent after issuance of the reexamination certificate was cited by the Office or submitted to the Office in an information disclosure statement. However, the duties of candor, good faith, and disclosure have not been complied with if any fraud on the Office was practiced or attempted or the duty of disclosure was violated through bad faith or intentional misconduct by, or on behalf of, the patent owner in the reexamination proceeding. Any information disclosure statement must be filed with the items listed in § 1.98(a) as applied to individuals associated with the patent owner in a reexamination proceeding, and should be filed within two months of the date of the order for reexamination, or as soon thereafter as possible.

37 CFR 1.183 provides:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 CFR 1.903 provides:

The patent owner and the third party requester will be sent copies of Office actions issued during the *inter partes* reexamination proceeding. After filing of a request for *inter partes* reexamination by a third party requester, any document filed by either the patent owner or the third party requester must be served on every other party in the reexamination proceeding in the manner provided in § 1.248. Any document must

reflect service or the document may be refused consideration by the Office. The failure of the patent owner or the third party requester to serve documents may result in their being refused consideration.

II. Patent Owner's Petition

In the instant petition, patent owner requests waiver of the requirement under 37 CFR 1.98 that patent owner submit copies of "non-U.S. references" (i.e., non-U.S. patent documents and non-patent literature; subsequently referred to herein as "references") cited on patent owner's IDS submissions filed concurrently with the instant petition on October 20, 2010.² In support of its request for waiver of the rule, patent owner states that it has recently filed (in four boxes) copies of the same references in connection with IDS submissions filed in co-pending reexamination proceeding control no. 95/001,262 (the '1262 proceeding) and that "[t]o avoid the need to re-send these duplicative documents, Patent Owner respectfully requests this petition be granted."³ Patent owner also requests waiver of the requirement under 37 CFR 1.903 that patent owner serve copies of these same references on second *inter partes* requester (Apple Inc.), as patent owner has already served these same documents on Apple Inc. in the co-pending '1262 proceeding.⁴ Patent owner states that it "makes this petition to avoid the expense and burden on the Patent Owner, Patent Office and Requester that the preparation, filing, uploading to PAIR, and so forth would require of all of these parties" and that "[t]his burden is especially unwarranted, as all of the documents that would be avoided by the granting of this petition have already been provided both to the Patent Office and to Requester Apple."⁵

III. Analysis and Findings

37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party. The burden is on petitioner to set forth with specificity the facts that give rise to an extraordinary situation in which justice requires suspension of a rule.

Waiver of the copy requirement of 37 CFR 1.98(a)(2)

As a general rule, waiver of a rule in the interest of justice is not available when there is recourse within the rules of practice. In this instance, petitioner requests waiver of the rules governing submission of documents to the Office based on the alleged burden of submitting to the Office physical copies of numerous references in multiple reexamination proceedings. In lieu of submitting to the Office physical copies of the references, however, petitioner patent owner may use the Office's Web-based electronic filing system (EFS-Web) to submit electronic copies of the references to the Office. In this way, petitioner need only scan the references into an acceptable electronic format (e.g., Adobe Portable Document Format (PDF)) once, and petitioner can then submit the scanned references to the Office via EFS-Web in any number of reexamination proceedings.

² Petition at pages 1-2.

³ *Id.* at page 2.

⁴ *Id.*

⁵ *Id.*

Additionally, Office systems, as currently configured, do not have the capability of copying, in bulk, references from the IFW of one reexamination proceeding into the IFWs of other reexamination proceedings. Any such copying by the Office would be on an individual citation basis and would be lengthy and tedious. Thus, if the Office were to grant petitioner's request, the logistics of insuring that each of the references is properly included in the IFW of the instant merged proceeding would be shifted to the Office. Accuracy of the reexamination file should be paramount when determining who is better positioned to provide the required copies of references cited in an IDS submission. Patent owner has greater knowledge of the references cited in the IDS and is better able to address issues that may arise during introduction of the copies of the references into the instant merged proceeding. For these reasons, patent owner is better positioned to supply the required copies of the IDS references in question, and therefore must comply with 37 CFR 1.98(a)(2).

Accordingly, for all of the reasons set forth above, petitioner has not presented facts that demonstrate an extraordinary situation in which justice requires suspension of 37 CFR 1.98(a)(2), and the petition is dismissed.

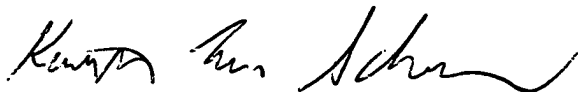
Waiver of the service requirement of 37 CFR 1.903

35 U.S.C. 314(b)(1) provides: "With the exception of the *inter partes* reexamination request, any document filed by either the patent owner or the third-party requester shall be served on the other party." 37 CFR 1.183 is clear that it applies only to a "requirement of the regulations in this part which is not a requirement of the statutes" (emphasis added), and it should be equally clear that a requirement of the statute cannot be waived.

Accordingly, patent owner's petition under 37 CFR 1.183 as to waiver of the service requirement of 37 CFR 1.903 is dismissed.

CONCLUSION

1. Patent owner's October 20, 2010 petition under 37 CFR 1.183 is dismissed.
2. Telephone inquiries related to the present decision should be directed to Nicole Dretar Haines, Legal Advisor, at 571-272-7717.



Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

January 5, 2011
Ken pet 8/



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,223	09/22/2009	7324833	AFF.0004B2US	1290
21906	7590	04/18/2011	EXAMINER	
TROP, PRUNER & HU, P.C. 1616 S. VOSS ROAD, SUITE 750 HOUSTON, TX 77057-2631			ART UNIT	PAPER NUMBER

DATE MAILED: 04/18/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
KENYON & KENYON LLP
ONE BROADWAY
NEW YORK, NY 10004

Date:

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APR 18 2011

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001223
PATENT NO. : 7324833
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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HOUSTON, TX 77057-2631

(For Patent Owner) CENTRAL REEXAMINATION UNIT

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Inter Partes Reexamination Proceeding
Control No. 95/001,223
Filed: September 22, 2009
For: U.S. Patent No. 7,324,833

Inter Partes Reexamination Proceeding
Control No. 95/001,264
Filed: November 13, 2009
For: U.S. Patent No. 7,324,833

Ex Parte Reexamination Proceeding
Control No. 90/010,333
Filed: November 7, 2008
For: U.S. Patent No. 7,324,833

**DECISION
GRANTING
PETITION**

This is a decision on the 95/001,264 third party requester (Apple, Inc., hereinafter "Apple") petition entitled "PETITION UNDER 37 C.F.R. § 1.183 TO WAIVE THE PROVISIONS OF 37

C.F.R. § 1.943(B) TO INCREASE THE NUMBER OF PAGES PERMITTED FOR REQUESTER'S WRITTEN COMMENTS BEYOND THE 50-PAGE LIMITATION," filed on December 20, 2010. The petition requests waiver of the requirement of 37 CFR 1.943(b) that the written comments by third party requester not exceed fifty (50) pages in length, and requests that the page limit be extended to 91 pages. Third party requester Apple timely filed its comments pursuant to 37 CFR 1.947 concurrently with the petition.

The petition is before the Office of Patent Legal Administration for consideration.

Third party requester Apple's petition under 37 CFR 1.183 is granted.

DECISION

In the instant petition, third party requester Apple requests waiver of the requirement under 37 CFR 1.943(b) with respect to the 50-page limit for its comments filed on December 20, 2010, and requests that the page limit be extended to 91 pages.¹ In support of its request for waiver of the rule, third party requester Apple argues that additional pages are needed to "provide detailed discussion of the grounds of rejection proposed for the amended and newly added claims that would satisfy the requirements of MPEP § 2617" and to "fully address the patentability of the amended and new claims."² Third party requester Apple further argues that it must provide detailed arguments under the Office's rules in responding "to the Patent Owner's Reply of September 14, 2010, the amended and new claims, the declaration of Russell W. White and Paul J. Polansky, and the Office Action mailed June 14, 2010."³

The third party requester Apple's instant petition under 37 CFR 1.183 has been fully considered. In this instance, petitioner third party requester Apple's December 20, 2010 written comments include 66 pages of remarks, which are subject to the 50 page limit.

The third party requester Apple's written comments are also accompanied by Exhibits A-E.

A document is deemed to be subject to the 50-page length requirement when the document includes legal argument, i.e., arguments of counsel such as, e.g., arguments that the claims are patentable or unpatentable, or that are directed to how an outstanding or proposed rejection is overcome, or, in the case of a document filed by the requester, how an outstanding or proposed rejection is supported. There are no *per se* rules for determining whether a document, such as an affidavit or declaration, contains a legal argument that will cause the document to be subject to the page count. Each determination is made on a case-by-case basis. In determining whether a document such as an affidavit or declaration under 37 CFR 1.132, or any other document of a submission, includes legal argument, the Office analyzes whether the document is providing factual evidence, i.e., evidence of **technological** facts, or whether the document is merely an extension of the arguments of counsel. Factual evidence includes, for example, declarations that swear behind the filing date of a reference, that establish the date of a printed publication, that

¹ Petition at page 9.

² *Id.* at page 8.

³ *Id.*

provide a technical explanation or technical definition of terms of art used by a reference, or that provide comparative test results and a scientific, or technological, analysis of the results (see, e.g., MPEP 716.02). If a document is limited to factual evidence, the document is not included in the page count. In addition, affidavits or declarations **limited to** establishing commercial success, long-felt need and failure of others, skepticism of experts, or copying, as per MPEP 716.03 -716.06, respectively, will not be included in the page count.

After brief review, Exhibit A includes a 26-page declaration of Dr. Bruce Maggs, which is replete with legal arguments. For this reason, the entirety of the declaration is counted toward the page limit. Examples of legal arguments in the Maggs declaration, which are not exhaustive, that count toward the page limit are: In paragraph 9, on page 2, declarant Maggs states: "In my opinion, *the claims* of the '833 patent were all well known in the art before the filing date of the patent." In paragraph 11 on page 3, declarant Maggs states: "One of ordinary skill in the art would have been motivated to combine the references as presented in the *inter partes* request..." (also see, at a minimum, paragraphs 17, 18, 20-22, 26-39, 43-44, 47, 48, 50-52, 54-59, 61-67).

Accordingly, the December 20, 2010 third party requester Apple's comments *in toto* is 92 pages in length.

Upon review of the submitted response for economizing, extraneous material, and arrangement, without repetition of information already of record, it is found that the 42 pages of arguments in excess of 50 required to complete the third party requester Apple's comments are not unreasonable in this instance, in view of the present facts and circumstances. The September 14, 2010 patent owner response amends claims 1, 17, and 19 and adds 14 new claims. In addition, the examiner, in the June 14, 2010 non-final Office action, did not adopt at least 30 of Apple's proposed rejections.

37 CFR 1.183 permits waiver of the page limitation requirement of the regulations in an extraordinary situation when justice requires. Under the facts and circumstances currently of record in the present merged reexamination proceeding, the third party requester Apple's instant petition is deemed to establish that a waiver of 37 CFR 1.943(b) to the extent of permitting third party requester Apple's comments to run 92 pages in length is appropriate in the interest of justice.

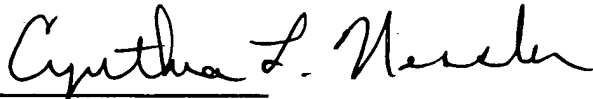
Accordingly, third party requester's petition under 37 CFR 1.183 is **granted** to the extent that the page limit of 37 CFR 1.943(b) is waived to the extent of permitting requester Apple's comments submission to exceed the page limit by up to **42 pages**. This waiver makes requester Apple's December 20, 2010 comments submission page-length compliant.

CONCLUSION

1. Third party requester Apple's petition under 37 CFR 1.183 is **granted**, and the page limit of 37 CFR 1.943(b) is **waived to the extent that** third party requester Apple's comments filed on December 20, 2010 may exceed the page limit by up to 42 pages. This waiver makes the

December 20, 2010 third party requester Apple's comments submission page-length compliant.

2. Telephone inquiries related to the present decision should be directed to the Susy Tsang-Foster, Legal Advisor, at 571-272-7711.



Cynthia L. Nessler
Cynthia L. Nessler
Senior Legal Advisor
Office of Patent Legal Administration

4/15/11
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,223	09/22/2009	7324833	AFF.0004B2US	1290
21906	7590	04/18/2011	EXAMINER	
TROP, PRUNER & HU, P.C. 1616 S. VOSS ROAD, SUITE 750 HOUSTON, TX 77057-2631			ART UNIT	PAPER NUMBER

DATE MAILED: 04/18/2011

Please find below and/or attached an Office communication concerning this application or proceeding.



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Date:

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CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001223
PATENT NO. : 7324833
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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(For *Ex Parte* Requester)

Inter Partes Reexamination Proceeding

Control No. 95/001,223

Filed: September 22, 2009

For: U.S. Patent No. 7,324,833

Inter Partes Reexamination Proceeding

Control No. 95/001,264

Filed: November 13, 2009

For: U.S. Patent No. 7,324,833

Ex Parte Reexamination Proceeding

Control No. 90/010,333

Filed: November 7, 2008

For: U.S. Patent No. 7,324,833

DECISION
GRANTING-IN-PART
PETITION AND
EXPUNGING
IMPROPER PAPER

This is a decision on the 95/001,223 third party requester (Volkswagen Group of America, Inc., hereinafter "VWGoA") petition entitled "PETITION UNDER 37 C.F.R. § 1.183 TO WAIVE THE PAGE LIMIT FOR REQUESTER'S RESPONSE UNDER 37 C.F.R. § 1.943(b)," filed on December 20, 2010.

The petition requests waiver of the requirement of 37 CFR 1.943(b) that the written comments by third party requester VWGoA not exceed fifty (50) pages in length, and requests that the page limit be extended to 138 pages. Third party requester VWGoA timely filed its comments pursuant to 37 CFR 1.947 concurrently with the petition.

The petition is before the Office of Patent Legal Administration for consideration.

Third party requester VWGoA's petition under 37 CFR 1.183 to waive the 37 CFR 1.943(b) limit as to the number of pages permitted in written comments by third party requester VWGoA is granted to the extent that the page limit for written comments by third party requester is VWGoA extended to not exceed 92 pages in length.

For the reasons set forth below, third party requester VWGoA's comments submission is an improper paper and is being expunged without consideration. Since the third party requester VWGoA's paper has been scanned into the record, i.e., the Office's Image File Wrapper (IFW) file of the present merged reexamination proceeding, the December 20, 2010 third party requester comments submission by VWGoA is being expunged from the record by closing it and marking it "not public".

DECISION

I. DECISION GRANTING-IN-PART PETITION TO WAIVE THE REQUIREMENTS OF 37 CFR 1.943(b)

In the instant petition, third party requester VWGoA requests waiver of the requirement under 37 CFR 1.943(b) with respect to the 50-page limit for its comments filed on December 20, 2010, and request that the page limit be extended to 138 pages.¹ In support of its request for waiver of the rule, third party requester VWGoA argues that additional pages are needed to present new proposed grounds of rejection, which are either necessitated by patent owner's addition of 14 new claims in its response or by VWGoA's recent discovery of new prior art based on depositions that were conducted by patent owner in the concurrent litigation involving the '833 patent in April and May 2010, after the date of VWGoA's request for *inter partes* reexamination.² VWGoA also asserts that the new claims add subject matter that was not previously claimed in any of the original claims of the '833 patent.³ Finally, VWGoA argues that MPEP § 2617 requires a detailed explanation for the newly proposed rejections.⁴

The instant petition under 37 CFR 1.183 has been fully considered. In this instance, petitioner third party requester VWGoA's December 20, 2010 written comments include 42 pages of remarks, which are subject to the 50 page limit. The third party requester's written comments

¹ Petition at page 8.

² *Id.* at 8-9.

³ *Id.* at 8.

⁴ *Id.* at 9.

are also accompanied by 80 pages of claim charts for the new proposed grounds of rejection, Exhibits 1-12, and a declaration of Scott Andrews under 37 CFR 1.132.⁵

A document is deemed to be subject to the 50-page length requirement when the document includes legal argument, i.e., arguments of counsel such as, e.g., arguments that the claims are patentable or unpatentable, or that are directed to how an outstanding or proposed rejection is overcome, or, in the case of a document filed by the requester, how an outstanding or proposed rejection is supported. There are no *per se* rules for determining whether a document, such as an affidavit or declaration, contains a legal argument that will cause the document to be subject to the page count. Each determination is made on a case-by-case basis. In determining whether a document such as an affidavit or declaration under 37 CFR 1.132, or any other document of a submission, includes legal argument, the Office analyzes whether the document is providing factual evidence, i.e., evidence of **technological** facts, or whether the document is merely an extension of the arguments of counsel. Factual evidence includes, for example, declarations that swear behind the filing date of a reference, that establish the date of a printed publication, that provide a technical explanation or technical definition of terms of art used by a reference, or that provide comparative test results and a scientific, or technological, analysis of the results (see, e.g., MPEP 716.02). If a document is limited to factual evidence, the document is not included in the page count. In addition, affidavits or declarations **limited to** establishing commercial success, long-felt need and failure of others, skepticism of experts, or copying, as per MPEP 716.03 -716.06, respectively, will not be included in the page count.

The 80-page claim chart for the new proposed grounds of rejection is counted toward the page limit.

Exhibit 2 is VWGoA's 27-page post-trial brief filed in the concurrent litigation containing legal arguments regarding the '833 patent claims and is counted toward the page limit.

Exhibit 3 is a 27-page comparison of the parent '812 application as filed and the '833 patent as filed to support VWGoA's arguments regarding priority of the '833 patent claims and is counted toward the page limit.

The 12-page declaration of Andrews contains 8 pages of legal arguments. Examples of legal arguments in the Andrews declaration, which are not exhaustive are:

On page 2, paragraph 10, declarant Andrews states: "In my opinion, claims 1 to 35 of the '833 patent include subject matter not disclosed in the '812 application."

⁵ This decision would normally be limited to the page-limit issue and the propriety of third party requester's written comments would be reviewed by the Central Reexamination Unit (CRU). However, in response to VWGoA's statement on page 8 of the instant petition that it is presenting new proposed grounds of rejection based on new prior art, this decision notifies the requester that its comments submission facially fails to comply with 35 U.S.C. 314(b)(2) and 37 CFR 1.947.

On page 3, paragraph 12, declarant Andrews states: "In my opinion, the '812 application does not describe the following features included in claim 17 of the '833 patent."

On page 5, paragraph 20, declarant Andrews states: "Nor does the '812 application describe or suggest even such a hypothetical (and not described) portable radio 500..."

On page 6, paragraph 22, declarant Andrews states: "Nor does the '812 application describe or suggest even such a hypothetical (and not described) vehicle system..."

On page 7, paragraph 24, declarant Andrews states: In contrast to these systems described in the '812 application, the claims of the '833 patent require two devices..."

On page 9, paragraph 28, declarant Andrews states: "Therefore, conventional audio systems, at the time of filing the '812 application...were incapable of presenting graphical user interfaces or graphical menus of the type described in the claims of the '833 patent."

On page 10, paragraph 33, declarant Andrews states: "Based on the foregoing, it is my opinion that the '812 application does not describe the audio system described claim 1 of the '833 patent."

On page 11, paragraph 34, declarant Andrews states: "Furthermore, it is my opinion that the '812 application does not describe the audio system described in claim 17 of the '833 patent."

In addition, the Andrews declaration is accompanied by Exhibits A-C.

Exhibit B is a copy of application 09/537,812, which is the parent application of the '833 patent. This copy is not counted toward the page limit because it is presumed to have been reviewed by the examiner of the present merged proceeding.

Accordingly, the December 20, 2010 third party requester VWGoA's comments submission *in toto* is 184 pages in length, as to the pages counted toward the regulatory page limit.

Upon review of the submitted response for economizing, extraneous material, and arrangement, without repetition of information already of record, it is found that the 134 pages of arguments in excess of 50 required to complete third party requester VGWoA's comments are unreasonable in this instance, in view of the present facts and circumstances. The patent owner added only 14 new claims, and amended three original claims. As an initial matter, the submission of 134 additional pages of arguments to address the limited number of newly added claim limitations is deemed to be unreasonable.

In the decision addressing third party requester Apple's December 20, 2011 petition under 37 CFR 1.183 to waive the provisions of 37 CFR 1.943(b), which is being mailed on even date, the third party requester Apple's written comments submission was determined to be 92 pages in length, and was deemed page length compliant in view of the waiver granted therein.

In a balancing of the equities, and after a review of the comments submission, the third party requester VWGoA's petition under 37 CFR 1.183 is **granted** to the extent that the page limit of 37 CFR 1.943(b) is waived as to the **42 pages** of the portions of requester's written comments, which are included in the regulatory page count, that exceed the 50-page limit (assuming that requester revises the comments submission to properly limit it by deleting the comments that are directed to improperly proposed new prior art rejections, as discussed below).

Third party requester VWGoA's written comments submission does not comply with the page limit of ninety-two (92) pages in length granted in this decision by waiver, and thus lacks an entry right in the present merged proceeding. The written comments submission was entered (scanned) into the Office's IFW system before discovery of the defect in the paper, and as such, cannot be physically removed from the IFW. Therefore, the written comments paper is being expunged from the record by closing it and marking it "not public" in the IFW of the present merged reexamination proceeding.

II. THIRD PARTY REQUESTER VWGoA'S DECEMBER 20, 2010 COMMENTS SUBMISSION IS FACIALLY IMPROPER

The Office notes that third party requester VGWoa's comments submission improperly proposes rejections based on newly submitted prior art. For example, a brief review of VGWoa's comments submission reveals that the requester newly proposes rejections, based on newly submitted prior art, of unamended (original) claims.⁶ Such rejections are based on, for example, the Simon et al. and Empeg Car User Guide (hereinafter "Empeg") references.⁷ Third party requester VWGoA justifies these newly proposed prior art rejections as follows: With respect to the Simon et al. reference, third party requester VGWoa asserts that the reference, "first became known to VWGoA not earlier than April 27, 2010," the date on which patent owner held a deposition of the first named inventor Simon in connection with the concurrent litigation.⁸ With respect to the Empeg reference, VWGoA asserts that it is permissible under 37 CFR 1.948(a)(2) to cite this reference to rebut patent owner's response, that is to address the new claims presented in patent owner's response.⁹ In addition, VWGoA asserts that since the Empeg reference is applied to the new claims that are dependent claims, it is necessary to apply the reference against the independent claims as well.¹⁰

⁶ See for example, pages 1-39 of the 80-page claim chart attached to the December 20, 2010 VWGoA's comments, which contain newly proposed prior art rejections for unamended (original) claims.

⁷ *Id.*

⁸ See page 32 of the December 20, 2010 VWGoA's written comments.

⁹ *Id.*

¹⁰ *Id.*

The requester is reminded that the provisions of 37 CFR 1.948(a)(1)-(3) set forth the limitation on what newly cited prior art the requester may *file* in an *inter partes* reexamination, as part of, for example, a document entitled “information disclosure statement,” which is filed with requester’s comments. If the submission of newly cited prior art meets the rule, then the newly cited prior art is entered into the proceeding, i.e., the reference is made of record, considered, and the consideration is indicated by the examiner’s initials on the document entitled “information disclosure statement.” To newly propose a rejection based on such prior art, however, the requester must also show how the newly proposed rejection is necessitated by patent owner’s amendment of the claims, i.e., how the presence of a teaching, in each reference cited alone, or, if the reference is cited in a combination, in at least one of the references of the reference combination, corresponds to at least one claim limitation newly added by patent owner’s amendment. See 37 CFR 1.947 and MPEP 2666.05.

35 U.S.C. § 314(b)(2) limits the content of requester’s comments to “addressing issues raised by the action of the Office or the patent owner’s response thereto.” Even if the requester shows that the new prior art is submitted in compliance with 37 CFR 1.948, this does not necessarily permit requester to propose a new ground of rejection based on additional art, as (1) 37 CFR 1.947 must be satisfied in order for requester to be permitted to propose a new ground of rejection, and (2) 37 CFR 1.947 cannot be waived to the extent that it promulgates a requirement of the statute – in this instance, 35 U.S.C. § 314(b)(2). If the requester were permitted to newly propose rejections based on newly cited prior art, without showing how these rejections were necessitated by amendment, then the provisions of 35 U.S.C. § 314(b)(2) and 37 CFR 1.947 would essentially be a nullity. For example, an entirely new proposed ground of rejection, and one which is based on 37 CFR 1.948(a)(3) art, is not permitted by 35 U.S.C. 314(b)(2) because it would not address “issues raised by the action of the Office or the patent owner’s response.”

Therefore, the December 20, 2010 requester VWGoA comments do not have a right of entry under 37 CFR 1.947 and 1.948 and 35 U.S.C. § 314(b)(2). There is simply no statutory or regulatory authority for entry of the newly proposed prior art rejections not necessitated by an amendment to the patent claims. As pointed out above, the written comments paper was entered (scanned) into the Office’s IFW system before discovery of the defect in the paper, and as such, cannot be physically removed from the IFW system. Therefore, the written comments submission is being expunged from the record by closing it and by marking it “not public”.

In view of the above discussion as to the VWGoA comments filed on December 20, 2010 being improper, the comments are expunged from the record in the manner described above.

This decision primarily addresses requester’s petition under 37 CFR 1.183 for waiver of the page length requirements under 37 CFR 1.943(b), and does not include a complete analysis of the propriety, or lack thereof, of requester’s comments submission, pursuant to, for example, 37 CFR §§ 1.947 or 1.948, or MPEP 2666.05. As to the compliance of requester’s comments submission with any regulation other than 37 CFR 1.943(b), or any applicable statute or published procedure, this decision only notifies the requester that requester’s comments submission *facially* fails to comply with 35 U.S.C. 314(b)(2), 37 CFR 1.947, and MPEP 2666.05.

Any replacement comments submission filed in response to this decision will be reviewed by the examiner for compliance with all of the applicable statutes, regulations, and procedures.

THIRD PARTY REQUESTER OPTIONS

For the above reasons, the December 20, 2010 comments submission submitted by the third party requester VWGoA is improper.

Third party requester is given fifteen (15) days from the mailing date of this decision to file a replacement comments submission, which must be limited to 92 pages pursuant to the page limit waiver granted-in-part in this decision. The requester should review the entire replacement written comments submission, prior to its filing, for compliance with all applicable statutes, regulations, and published Office procedures, particularly 37 CFR §§ 1.943(b), 1.947, and 1.948, and MPEP 2666.05.

Any replacement comments submission filed in response to the notification must be strictly limited to (i.e., must not go beyond) the comments in the original (expunged) comments submission. No comments that add to those in the expunged paper will be considered for entry, other than what is strictly necessary to conform to the guidelines set forth in this decision.

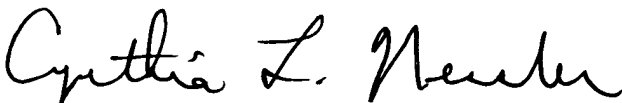
If no replacement comments submission from the third party requester is timely received, the reexamination proceeding will be forwarded to the examiner for appropriate action, without entry of written comments by the third party requester.

CONCLUSION

1. Third party requester VWGoA's December 20, 2010 petition under 37 CFR 1.183 is granted in-part, and the page limit of 37 CFR 1.943(b) is waived to the extent that third party requester VWGoA's 37 CFR 1.947 comments submission after the September 14, 2010 patent owner response is not to exceed 92 pages in length. **This waiver is conditional on the submission being in at least 12 point font and at least one-and-a-half spaced, with appropriate margins.**
2. Third party requester VWGoA's written comments submission, filed on December 20, 2010, is improper, and will NOT be made a part of the record of the present merged proceeding.
3. Since third party requester VWGoA's comments submission and accompanying exhibits were scanned into the electronic Image File Wrapper (IFW) of the present merged proceeding, these papers are expunged by closing them in the present merged reexamination proceeding's IFW files and marking them as "non-public."
4. Third party requester VWGoA is given fifteen (15) days from the mailing date of this decision to file a replacement comments submission. Any replacement comments submission filed in

response to the notification **must be strictly limited to (i.e., must not go beyond) the comments in the original (now expunged) comments submission**. No comments that add to those in the original paper will be considered for entry, other than what is strictly necessary to conform to the guidelines set forth in this decision.

- 5, No copy of the third party requester VWGoA's December 20, 2010 written comments submission will be maintained in the record, or elsewhere in the Office.
6. Telephone inquiries related to this decision should be directed to Susy Tsang-Foster, Legal Advisor, at (571) 272-7711.



Cynthia L. Nessler
Senior Legal Advisor
Office of Patent Legal Administration

4/15/11
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(For *Ex Parte* Requester)

Inter Partes Reexamination Proceeding
Control No. 95/001,223
Filed: September 22, 2009
For: U.S. Patent No. 7,324,833

Inter Partes Reexamination Proceeding
Control No. 95/001,264
Filed: November 13, 2009
For: U.S. Patent No. 7,324,833

Ex Parte Reexamination Proceeding
Control No. 90/010,333
Filed: November 7, 2008
For: U.S. Patent No. 7,324,833

**DECISION
DENYING
PETITION AND
EXPUNGING
IMPROPER PAPERS**

This is a decision on the 95/001,223 third party requester (Volkswagen Group of America, Inc., hereinafter "VWGoA") petition entitled "PETITION UNDER 37 C.F.R. § 1.181 FOR RECONSIDERATION," filed on May 3, 2011.

The present petition for reconsideration requests that:

- (1) The April 18, 2011 Office decision granting-in-part the requester VWGoA's December 20, 2010 petition requesting waiver of the page limit requirement of 37 CFR 1.943(b) be vacated;
- (2) The requester VWGoA's December 20, 2010 petition requesting waiver of the page limit requirement of 37 CFR 1.943(b) be granted in its entirety; and
- (3) The requester VWGoA's expunged December 20, 2010 comments submission be entered into the record and considered.

The petition for reconsideration is before the Office of Patent Legal Administration for consideration.

SUMMARY

The petition for reconsideration is granted only to the extent that the April 18, 2011 Office decision has been reconsidered, but is denied as to the underlying relief requested.

The April 18, 2011 Office decision **properly granted-in-part** requester VWGoA's December 20, 2010 petition requesting waiver of the page limit requirement of 37 CFR 1.943(b) for its comments submission, and **properly expunged** VWGoA's December 20, 2010 comments submission that newly proposed rejections of unamended (original) claims that were based on newly cited prior art.

Exhibit 2, which is a copy of requester VWGoA's December 20, 2010 comments submission attached to the present petition, and the replacement comments filed concurrently with the present petition **are improper papers and are being expunged** without consideration. Since these papers have been scanned into the record, i.e., the Office's Image File Wrapper (IFW) file of the above-captioned merged reexamination proceeding, they are being expunged from the record by closing them and marking them "not public."

This decision is designated as a final agency action under 5 U.S.C. § 704.

BACKGROUND

1. On January 29, 2008, the Office issued U.S. Patent No. 7,324,833 (the '833 patent) to White *et al.*, with claims 1-35.
2. On November 7, 2008, a request for *ex parte* reexamination of all the claims in the '833 patent was filed by a third party requester. The request was assigned control number 90/010,333 (the '333 proceeding).

3. On December 19, 2008, *ex parte* reexamination was ordered on all the claims of the '833 patent in the '333 proceeding.
4. On August 5, 2009, a non-final Office action was mailed in the '333 proceeding, rejecting all the claims of the '833 patent.
5. On September 22, 2009, a first request for *inter partes* reexamination of all the claims in the '833 patent was filed by a third party requester and real party in interest, VWGoA. The request was assigned control number 95/001,223 (the '1223 proceeding).
6. On October 2, 2009, patent owner timely filed, in the '333 proceeding, an amendment and response to the August 5, 2009 Office action, amending claims 1 and 17. No claims were added or canceled.
7. On November 9, 2009, *inter partes* reexamination was ordered in the '1223 proceeding.
8. On November 13, 2009, a second request for *inter partes* reexamination of all the claims in the '833 patent, was filed by a third party requester and real party in interest, Apple, Inc. (hereinafter "Apple"). The request was assigned control number 95/001,264 (the '1264 proceeding).
9. On February 5, 2010, *inter partes* reexamination was ordered in the '1264 proceeding.
10. On June 14, 2010, the '333, '1223, and '1264 proceedings were merged. A non-final Office action was mailed on even date. Before the merger, no Office action was issued in the '1223 *inter partes* proceeding, nor in the '1264 *inter partes* proceeding, and no further Office action was issued in the '333 *ex parte* proceeding. The June 14, 2010 non-final Office action incorrectly stated on page 2 that claims 1, 17, and 19 were amended in the '333 proceeding. Only claims 1 and 17 were amended in the October 2, 2009 patent owner response filed in the '333 *ex parte* proceeding. The June 14, 2010 non-final Office action also stated on page 2 that claims 1-27 are not the same in all three proceedings and stated on page 3 that for examination purposes, the set of claims in the '333 proceeding would be utilized – i.e., the current set of claims in the '333 proceeding would be tentatively in effect for all three proceedings.¹

¹ It is noted that in the June 14, 2010 non-final Office action that was mailed concurrently with the June 14, 2010 decision merging the '333, '1223, and the '1264 proceedings, the examiner's use of the amended claim set from the *ex parte* proceeding, where claims 1 and 17 were amended, as the claim set in effect for the merged proceeding, is a harmless procedural error. The examiner should have waited for the patent owner to file a housekeeping amendment that placed the same amendment in each of the three proceedings before issuing the June 14, 2010 non-final Office action. In its September 14, 2010 patent owner response, the amendment shows claims 1, 17, and 19 in their original form and adds new claims 36-49. Claims 1-35 are original patent claims as is confirmed by patent owner's remarks on page 7 of patent owner's September 14, 2010 response. The patent owner's September 14, 2010 amendment returning claims 1 and 17 to their original form remedied the procedural error to the extent that the scope of the original claims that was in front of the requesters at the critical time had not been changed by the patent owner's response to the June 14, 2010 non-final Office action. Thus, the proposed rejections for the original claims as set forth in the requests by both *inter partes* requesters are still before the examiner for his consideration.

11. On December 20, 2010, third party requester Apple filed a petition entitled "PETITION UNDER 37 C.F.R. § 1.183 TO WAIVE THE PROVISIONS OF 37 C.F.R. § 1.943(B) TO INCREASE THE NUMBER OF PAGES PERMITTED FOR REQUESTER'S WRITTEN COMMENTS BEYOND THE 50-PAGE LIMITATION." Concurrently with the petition, third party requester Apple timely filed comments pursuant to 37 CFR 1.947.
12. On December 20, 2010, third party requester VWGoA filed a petition entitled " PETITION UNDER 37 C.F.R. § 1.183 TO WAIVE THE PAGE LIMIT FOR REQUESTER'S RESPONSE UNDER 37 C.F.R. § 1.943(b)." Concurrently with the petition, third party requester VWGoA timely filed comments pursuant to 37 CFR 1.947.
13. On April 18, 2011, the Office mailed a decision granting third party requester Apple's December 20, 2010 petition. The page limit waiver granted in the decision rendered requester Apple's December 20, 2010 comments submission page-length compliant.
14. On April 18, 2011, the Office mailed a decision granting-in-part requester VWGoA's December 20, 2010 petition (hereinafter "the April 18, 2011 decision"). The decision waived the page limit requirement of 37 CFR 1.943(b) to the extent that the page limit for requester VWGoA's written comments was extended not to exceed 92 pages in length. The requester's VWGoA's December 20, 2010 written comments submission, having a effective page length of 184 pages, did not comply with the page limit of 92 pages that was granted in the decision by waiver and thus lacked an entry right in the merged proceeding. Furthermore, the requester's VWGoA's December 20, 2010 written comments submission was found to be facially improper for proposing rejections based on newly submitted prior art for unamended (original) claims. Accordingly, the April 18, 2011 decision expunged requester's VWGoA's December 20, 2010 written comments submission from the record.
15. On May 3, 2011, third party requester VWGoA filed the instant petition entitled " PETITION UNDER 37 C.F.R. § 1.181 FOR RECONSIDERATION." Concurrently with the petition, third party requester VWGoA filed its replacement comments submission.

RELEVANT STATUTES, REGULATIONS, AND EXAMINING PROCEDURE

35 U.S.C. § 314(b)(2) states (emphasis added):

Each time that the patent owner files a response to an action on the merits from the Patent and Trademark Office, the third-party requester shall have **one opportunity** to file written comments **addressing issues raised by the action of the Office or the patent owner's response thereto**, if those written comments are received by the Office within 30 days after the date of service of the patent owner's response.

37 CFR 1.947 states (emphasis added):

Each time the patent owner files a response to an Office action on the merits pursuant to § 1.945, a third party requester may **once file written comments** within a period of 30 days from the date of service of the patent owner's response. These comments **shall be limited to issues**

raised by the Office action or the patent owner's response. The time for submitting comments by the third party requester may not be extended. For the purpose of filing the written comments by the third party requester, the comments will be considered as having been received in the Office as of the date of deposit specified in the certificate under § 1.8.

37 CFR 1.948(a) states (emphasis added):

After the *inter partes* reexamination order, the third party requester may only cite additional prior art as defined under § 1.501 if it is filed as part of a comments submission under § 1.947 or § 1.951(b) and is limited to prior art:

- (1) which is necessary to rebut a finding of fact by the examiner;
- (2) which is necessary to rebut a response of the patent owner; or
- (3) which for the first time became known or available to the third party requester after the filing of the request for *inter partes* reexamination proceeding. Prior art submitted under paragraph (a)(3) of this section must be accompanied by a statement as to when the prior art first became known or available to the third party requester and must include a **discussion of the pertinency of each reference** to the patentability of at least one claim.

The Manual of Patent Examining Procedure (MPEP), Section 2666.05 (II) states in pertinent part (emphasis added):

The third party requester comments must be directed to points and issues covered by the Office action and/or the patent owner's response.

Third party requester comments are limited to issues covered by the Office action or the patent owner's response. New prior art can be submitted with the comments **only** where the prior art (A) is necessary to rebut a finding of fact by the examiner, (B) is necessary to rebut a response of the patent owner, or (C) for the first time became known or available to the third party requester after the filing of the request for *inter partes* reexamination.

As to item (A) above, 37 CFR 1.948(a)(1) permits the requester to provide new prior art rebutting the examiner's interpretation/finding of what the art of record shows. **However, a statement in an Office action that a particular claimed feature is not shown by the prior art of record (which includes references that were cited by requester) does NOT permit the requester to then cite new art to replace the art originally advanced by requester. Such a substitution of a new art for the art of record is not a rebuttal of the examiner's finding that a feature in question is not taught by the art of record.** Rather, such a substitution would amount to a rebuttal of a finding that a feature in question is not taught by any art in existence. A finding that the feature in question is not taught by any art in existence could not realistically be made for the reexamination proceeding, since the proceeding does not include a comprehensive validity search, and such was not envisioned by Congress as evidenced by the 35 U.S.C. 314(c) mandate that reexamination proceedings are to be conducted in the Office with special dispatch.

As to item (B) above, 37 CFR 1.948(a)(2) permits the requester to provide a new proposed rejection, where such new proposed rejection is necessitated by patent owner's amendment of the claims.

As to item (C) above, prior art submitted under 37 CFR 1.948(a)(3) must be accompanied by a statement that explains the circumstances as to when the prior art first became known or available to the third party requester, including the date and manner that the art became known or available, and why it was not available earlier. The submission must also include a discussion of the pertinency of each reference to the patentability of at least one claim.

Where the **third party requester written comments are directed to matters other than issues and points covered by the Office action or the patent owner's response**, or where the prior art submitted with the comments does not satisfy at least one of (A) - (C) above, **the written comments are improper**. If the written comments are improper, the examiner should return the written comments (the entire paper) with an explanation of what is not proper; if the comments have been scanned into the Image File Wrapper (IFW) for the reexamination proceeding prior to the discovery of the impropriety, they should be expunged from the record, with notification being sent to the third party requester. The notification to the third party requester is to provide a time period of fifteen (15) days for the third party requester to rectify and refile the comments. If, upon the second submission, the comments are still not proper, the comments will be returned to third party requester with an explanation of what is not proper, and at that point the comments can no longer be resubmitted. The loss of right to submit further comments applies only to the patent owner response at hand. See MPEP § 2666.20. To the extent that 37 CFR 1.947 provides that the third party requester "may once" file written comments, that provision is hereby waived to the extent of providing the third party requester the one additional opportunity to **remedy a comments paper containing merits-content that goes beyond what is permitted by the rules**; 37 CFR 1.947 is not waived to provide any further opportunity in view of the statutory requirement for special dispatch in reexamination.

Any replacement comments submitted in response to the notification **must be strictly limited to (i.e., must not go beyond)** the comments in the original (returned) comments submission. No comments that add to those in the returned paper will be considered for entry.

DECISION ON PETITION UNDER 37 CFR 1.181

Requester VWGoA urges that the following points be reviewed:

A. Whether the Office erred by (1) refusing to enter and consider requester VWGoA's original comments submission, filed on December 20, 2010, and (2) expunging the original comments submission from the record;² and

B. Whether the April 18, 2011 decision properly limited requester VWGoA's comments to only 92 of the requested 184 pages.³

The present decision addresses both requester points.

² Petition for reconsideration at pages 7 and 13.

³ *Id.* at page 7. It is noted that requester VWGoA's December 20, 2010 petition requested 138 pages for its comments, not the 184 pages that it is requesting in the present petition for reconsideration. In the April 18, 2011 decision, the Office determined that requester VWGoA's comments submission was 184 pages in length, as to the pages counted toward the regulatory page limit.

A. The April 18, 2011 Decision Properly Denied Entry of, and Expunged, the Requester VWGoA Original Comments Submission Filed on December 20, 2010:

1. The Statute Does Not Permit Requester to Newly Propose Rejections For Unamended (Original) Claims Based on Newly Cited Prior Art

The April 18, 2011 Office decision held that requester VWGoA's newly proposed rejections in its December 20, 2010 submission, which applied newly cited prior art against unamended (original) claims of the '833 patent, were not permitted by 35 U.S.C. § 314(b)(2).⁴ Such newly proposed rejections were based on the Simon et al. and the Empeg Car User Guide (hereinafter "Empeg") references.⁵ Requester VWGoA argues that this holding is improper. To support its argument, requester VWGoA contends that the language in 35 U.S.C. § 314 (b)(2) "is permissive and open-ended, rather than limiting."⁶ Requester VWGoA argues that the language in 35 U.S.C. § 314 explains that the requester "shall have" certain rights, and that "the statute requires that the third-party requester be given **at least** 'one opportunity to file written comments' whenever the patent owner files as [sic] response, and that those comments be permitted to address **at least** 'issues raised by the action of the Office or the patent owner's response thereto.'"⁷ Based on its interpretation of the statute, requester VWGoA contends that the Office's rules implementing this statutory provision are improperly closed-ended, and limiting.⁸

Requester VWGoA's interpretation of 35 U.S.C. § 314(b)(2) is not found to be correct. The relevant language of the statute is that "the third-party requester shall have **one opportunity** to file written comments **addressing issues raised by the action of the Office or the patent owner's response thereto.**" (Emphasis added) Based on the plain meaning of the language in the statute, the statute is not construed to provide third party-requester with an extra opportunity to submit written comments or the right to comment on issues that are not limited to those raised by patent owner's response or the Office action, and there is no legislative history to the contrary.

In December 2000, the Office issued final rules to implement *inter partes* reexamination, which was newly enacted by the America Inventors Protection Act (AIPA) of 1999 (Public Law No. 106-113. *See Rules to Implement Optional Inter Partes Reexamination Proceedings; Final Rule*, 65 Fed. Reg. 76756 (December 7, 2000), effective date of February 5, 2001. In this rule making the Office did not construe the language in 35 U.S.C. § 314(b) contrary to its plain language when implementing the statute through 37 CFR 1.947.⁹

⁴ *Id.* at page 18.

⁵ See for example, pages 1-39 of the 80-page claim chart attached to the December 20, 2010 VWGoA's comments, which contain newly proposed prior art rejections for unamended (original) claims.

⁶ Petition for reconsideration at page 17.

⁷ *Id.*

⁸ *Id.* at pages 17-18.

⁹ One comment on the notice of proposed rule making suggested that the patent owner should have the right of the last comment, which the Office did not adopt. The Office's response, which is provided in the notice, explains that providing the patent owner with an opportunity to reply to third party comments would unduly prolong the pendency of the proceeding, contrary to the special dispatch requirement set forth in 35 U.S.C. § 314(c). The Office also noted that a patent owner response to the third party comments could be considered a (supplemental) patent owner

In the Office's implementation of *inter partes* reexamination, the rules which limit requester's written comments to issues raised in the patent owner response or in the Office action, and which provide only one opportunity to file comments after a patent owner response, were established through notice and comment. The final rule making notice points out that only three comments directed to proposed 37 CFR 1.947 were received. None of these comments challenged the Office's interpretation of the statute that is set forth in 37 CFR 1.947. To date, the text of 37 CFR 1.947 has not been amended since the rule first became effective on February 5, 2001.

It is to be noted that since the inception of optional *inter partes* reexamination, the Office has construed the statute to: 1) limit requester's comments to issues raised in the patent owner response or in the Office action, and 2) provide only one opportunity to file written comments, each time that a patent owner files a response to an Office action. If the Office were to adopt the petitioner's reading of the statute, the Office would be changing a well-established Office procedure, which would be contrary to *Cooper Techs. Co. v. Dudas*, 536 F.3d 1330, 87 USPQ 2d 1705 (Fed. Cir. 2008). In *Cooper*, the Federal Circuit stated:¹⁰

In this case, the Patent Office expressly interpreted "original application" as used in the AIPA, shortly after the AIPA was enacted. *See 65 Fed. Reg. at 76,757*. "[T]he Supreme Court has instructed that '**an administrative practice has particular weight when it involves a contemporaneous construction of a statute by the [persons] charged with the responsibility of setting its machinery in motion, of making the parts work efficiently and smoothly while they are yet untried and new.**'" *Daewoo Elecs. Co. v. Int'l Union of Elec., Elec., Technical, Salaried & Machine Workers, AFL-CIO*, 6 F.3d 1511, 1522 (Fed. Cir. 1993) (quoting *Zenith Radio Corp. v. United States*, 437 U.S. 443, 450, 98 S. Ct. 2441, 57 L. Ed. 2d 337 (1978) (second alteration in the original)). We therefore must give the Patent Office's construction "particular weight" in our analysis. [Emphasis added]

Pursuant to the Office's "contemporaneous construction" of 35 U.S.C. § 314(b), each time a patent owner files a response to an Office action, a requester may file comments only once, and such comments are limited to issues raised by the Office action or by the patent owner's response.

As a further point, had Congress intended to provide the requester with "at least one" opportunity to file comments, and to permit the requester to address "at least" the issues raised by the Office action or by the patent owner's response, the statute or legislative history would have explicitly stated so. The phrase "at least" does not appear in the text of 35 U.S.C. § 314(b) or in the legislative history. Further, the plain meaning of the language of the statute does not compel such a reading, as advocated by the requester.

response to the Office action, which would trigger a further right to third party comment under 35 U.S.C. § 314(b)(2), and thus create an endless cycle. Similarly, to provide requester with more than one opportunity to file comments is not only contrary to 35 U.S.C. § 314(b)(2), but also contrary to the statutory mandate for special dispatch.

¹⁰*Cooper Techs. Co. v. Dudas*, 536 F.3d at 1341.

Requester has referred to MPEP 2666.05, entitled “Third Party Comments after Patent Owner Response” to support its argument that the actions of the third party requester are limited by the rules of the Office, and not by the statute. Specifically, requester argues that this section of the MPEP waives the provision of the “may once” file written comments under 37 CFR 1.947 to permit requester to rectify improper comments by filing replacement comments.¹¹ Requester argues that this waiver in the MPEP would not be possible if the language of the statute (rather than the Office rules) limited the requester to one opportunity to file comments.¹² However, the first **improper comments submission** does not have an entry right and, for this reason, it was never officially “filed.” It is the corrected comments, the content of which is strictly limited to (i.e., must not go beyond) that of the original comments, that serves the function of the **one filing** of a comments submission under 37 CFR 1.947.

For all of the reasons given above, the April 18, 2011 decision properly expunged requester VWGoA’s December 20, 2010 comments submission. The statute simply does not permit a requester to newly propose rejections of unamended (original) claims over newly cited prior art as part of its comments submission, which is filed pursuant to 37 CFR 1.947.

2. The Provisions of 37 CFR 1.947 Do Not Conflict With Those of 37 CFR 1.948 That Permit Requester to Newly Cite the Simon et al. and the Empeg references

Requester contends that “the restrictive and limiting language of 37 C.F.R. § 1.947 cannot be used to impose the requirement that the newly cited prior art be applied only to new and amended claims as the Expungement Decision held,” since “[t]his interpretation of the rules would conflict with the other provisions of 37 C.F.R. and the M.P.E.P.”¹³ Specifically, requester argues that the April 18, 2011 decision, which explained that any newly proposed rejections over newly cited prior art may only be applied to claims which have been newly amended, limits the requester to applying prior art that may only be submitted under 37 CFR 1.948(a)(2). The requester further asserts that MPEP 2666.05(II) requires requester to include a discussion of any prior art submitted under 37 CFR 1.948(a)(3), regardless of whether that art also qualifies under 37 CFR 1.948(a)(2).¹⁴

As an initial matter, in the present petition for reconsideration, requester VWGoA’s statements regarding which specific subsections of 37 CFR 1.948(a) apply to the Simon et al. and the Empeg references appear to be inconsistent with those in its December 20, 2010 comments submission. In the present petition, requester VWGoA states that “[a]s VWGoA explained in its December Comments, the new citations to the Simon et al. and the Empeg references in that submission were proper under 37 C.F.R. §§ 1.948(a)(2) and (3), because those references were ‘necessary to rebut a response of the patent owner’ and ‘for the first time became known or available to [VWGoA] after the filing of the request for *inter partes* reexamination proceeding.’”¹⁵ This statement suggests that both references were cited under 37 CFR 1.948(a)(2) and (a)(3).

¹¹ *Id.* at page 18.

¹² *Id.* at page 18

¹³ *Id.* at page 19.

¹⁴ *Id.* at page 19.

¹⁵ Petition for reconsideration at page 16.

In contrast, in its December 20, 2010 comments paper, requester VWGoA justified its proposed rejections over these newly cited prior art references as follows: With respect to the Simon et al. reference, third party requester VWGoA asserts that the reference, “first became known to VWGoA not earlier than April 27, 2010,” the date on which patent owner held a deposition of the first named inventor Simon in connection with the concurrent litigation.¹⁶ With respect to the Empeg reference, VWGoA asserts that it is permissible under 37 CFR 1.948(a)(2) to cite this reference to rebut patent owner’s response, that is, to address the new claims presented in patent owner’s response.¹⁷ In addition, VWGoA asserts that since the Empeg reference is applied to the new claims that are dependent claims, it is necessary for VWGoA to apply the reference against the respective independent claims as well.¹⁸ In view of requester’s VWGoA’s December 20, 2010 comments, the Simon et al. reference was submitted under 37 CFR 1.948(a)(3) and the Empeg reference was submitted under 37 CFR 1.948(a)(2).

Regardless of which subsections of 37 CFR 1.948(a) apply to the newly cited Simon et al. and Empeg references, requester’s principal argument regarding the provisions of 37 CFR 1.948(a) is that “the limitations imposed by Section 1.947 do not apply to the discussion of new prior art that is properly cited under Section 1.948.”¹⁹ Requester argues that the guidance in MPEP 2666.05(II) together with the statement in MPEP 2648 that claims “will be reexamined in view of all prior art during the reexamination under 37 CFR 1.937” permits requester to apply the Simon et al. and the Empeg references to unamended (original) claims in a newly proposed rejection, as part of its comments submission submitted under 37 CFR 1.947.²⁰

However, there is nothing in MPEP 2666.05(II) that would permit prior art properly cited, i.e., made of record under 37 CFR 1.948(a)(1) and (a)(3) to be applied in a new rejection as to unamended (original) claims.

As to the statement in MPEP 2648 that claims “will be reexamined in view of all prior art during the reexamination under 37 CFR 1.937,” MPEP 2648 points out that the examiner will reexamine the claims in view of all of the prior art that is properly of record, in accordance with 37 CFR 1.937; accordingly, the examiner will apply any of that art which the examiner believes to have a bearing on patentability. While prior art properly made of record under 37 CFR 1.948(a)(1) and (a)(3) is available to the examiner for consideration, if such art does not have a bearing on patentability, the examiner is clearly not required to apply it. The statement in MPEP 2648 does not support requester’s argument that requester is permitted to newly propose art rejections for any unamended claim, simply by virtue of having made that art of record under 37 CFR 1.948(a)(1) and (a)(3). The MPEP would not make such a permissive statement, because the 37 CFR 1.947 provision that requester’s comments are limited to issues raised by the patent owner response, or by the Office action, is a statutory requirement (as discussed in detail above) that cannot be waived. Furthermore, the first line of section 2666.05(II) of the MPEP reiterates

¹⁶ See page 32 of the December 20, 2010 VWGoA’s written comments.

¹⁷ *Id.*

¹⁸ *Id.*

¹⁹ *Id.* at page 20.

²⁰ *Id.*

this statutory requirement as follows: “The third party requester comments must be directed to points and issues covered by the Office action and/or the patent owner’s response.”

In the present petition, the requester appears to be confusing a prior art citation submitted under 37 CFR 1.948 with the requirement for properly setting forth a proposed prior art rejection, as detailed in MPEP 2617. The requester is reminded that the provisions of 37 CFR 1.948(a)(1)-(3) are directed only as to what newly cited prior art the requester may *file* in an *inter partes* reexamination, as part of, for example, a document entitled “information disclosure statement,” which is filed with requester’s comments under 37 CFR 1.947. If the submission of newly cited prior art meets the rule, then the newly cited prior art is entered into the proceeding, i.e., the reference is made of record and considered, and the consideration is indicated by the examiner’s initials on the document entitled “information disclosure statement.” 37 CFR 1.948(a), however, does not authorize the requester to newly propose a *rejection* of unamended (original) claims based on prior art newly submitted under the rule. To newly propose a rejection based on such new prior art, the requester must also show how the newly proposed rejection is necessitated by patent owner’s amendment of the claims, i.e., how the presence of a teaching, in each reference cited alone, or, if the reference is cited in a combination, in at least one of the references of the reference combination, corresponds to at least one claim limitation newly added by patent owner’s amendment. See 37 CFR 1.947 and MPEP 2666.05.²¹

Finally, the requester argues that the limitations imposed by 37 CFR 1.947 do not apply to the discussion of new prior art that is properly cited under 37 CFR 1.948.²² 37 CFR 1.948(a)(3) requires that any prior art submitted under this provision must be accompanied by a statement that includes a discussion of the pertinency of each reference to the patentability of at least one claim. However, the provisions of 37 CFR 1.948(a)(3) do not require, nor permit, requester to propose a rejection of the claims based on the newly cited prior art. They only require a discussion of the *pertinence* of the newly cited prior art to the claims.

For all of the reasons given above, the provisions of 37 CFR 1.947 are not deemed to conflict with the provisions of 37 CFR 1.948(a), contrary to requester’s arguments.

3. Requester’s December 20, 2010 Comments Submission and the May 3, 2011 Replacement Comments Submission Are Improper

²¹ It is understood that new art may be added to an existing proposed rejection in order to rebut a point newly made in the Office action or a patent owner response if the point being rebutted is identified in requester comments, but that is not the same as making a new proposed rejection as is the case here. In this regard, MPEP 2666.05(II), reproduced above, explicitly prohibits the use of prior art cited under 37 CFR 1.948(a)(1) to replace the art originally advanced by the requester, where the Office action which the requester is addressing includes a statement that a particular claimed feature is not shown by the prior art originally cited against that claim. The relevant portion of MPEP 2666.05(II) states:

“However, a statement in an Office action that a particular claimed feature is not shown by the prior art of record (which includes references that were cited by requester) does NOT permit the requester to then cite new art to replace the art originally advanced by requester. Such a substitution of a new art for the art of record is not a rebuttal of the examiner’s finding that a feature in question is not taught by the art of record.”

²² *Id.* at page 20.

In view of the above discussion, requester VWGoA's argument that it was permitted to propose new rejections over the Simon et al. and Empeg references (that were cited under 37 CFR 1.948(a) and MPEP 2666.05(II)) for unamended claims in its December 2010 comments submission under 37 CFR 1.947²³ is not persuasive. 35 U.S.C. § 314(b)(2) limits the content of requester's comments to "addressing issues raised by the action of the Office or the patent owner's response thereto." Requester is not permitted to propose rejections based on the newly cited prior art submitted under 37 CFR 1.948(a)(2) or (a)(3) for unamended (original) claims since neither the Office action, nor the patent owner's response, raised an issue with regard to these claims.

Thus, the Office properly expunged the original December 20, 2010 comments submission, because it included newly proposed rejections which do not have a right of entry under 35 U.S.C. § 314(b)(2) and 37 CFR 1.947, i.e., the newly proposed rejections of the unamended (original) claims based on the newly cited Simon et al. and Empeg references. As explained in the April 18, 2011 decision, there is no statutory or regulatory authority for entry of newly proposed rejections that are not necessitated by an amendment to the patent claims.²⁴

Requester has attached Exhibits 1-3 to the present petition for reconsideration. Exhibit 1 is a copy of the April 18, 2011 Office decision, which granted-in-part requester VWGoA's December 20, 2010 petition under 37 CFR 1.183, and expunged requester VWGoA's December 20, 2010 comments submission. Exhibit 2 is a copy of the original December 20, 2010 comments submission by requester VWGoA. Exhibit 3 is a copy of requester VWGoA's December 20, 2010 petition under 37 CFR 1.183. However, the original comments submission is improper for reasons discussed above, as well as in the April 18, 2011 decision on requester's VWGoA's December 20, 2010 petition. Accordingly, Exhibit 2, which is attached to the present petition, is improper and is being expunged from the record.

Requester has also filed replacement comments concurrently with the present petition for reconsideration. Contrary to requester's assertion,²⁵ the replacement comments do not comply with the restrictions imposed by the Office's April 18, 2011 decision. In its May 3, 2011 transmittal letter for the replacement comments, requester VWGoA asserts "[s]ince claims 36 to 49 are all dependent claims, the Replacement Comments include claim charts applying the newly-cited prior [art] against the respective independent and intervening claims solely for the purpose of fully supporting the new proposed grounds of rejection applied against the newly-added dependent claims."²⁶

The replacement claim charts apply newly cited prior art against the original, independent claims,²⁷ which is prohibited by 35 U.S.C. § 314(b)(2) and 37 CFR 1.947, as extensively

²³ *Id.*

²⁴ See April 18, 2011 decision on VWGoA's December 20, 2010 petition at page 6.

²⁵ See Footnote 1 on page 2 of the petition for reconsideration.

²⁶ See page 2 of the May 3, 2011 transmittal letter for the replacement comments.

²⁷ Claims 1-35 are unamended (original) claims. The replacement charts apply newly cited prior art against some of the unamended (original) claims. See for example, pages 12-26, 42 and 43 of the replacement claim charts where the Empeg reference is applied against original claims 1, 3, 12, 17, 20, 28, 34, and 35, and pages 29-39 of the replacement claim charts where the Simon reference is applied against original claims 1, 17, 20, 28, 34, and 35.

discussed *supra*. In the May 3, 2011 transmittal letter for its replacement comments, requester VWGoA justifies applying the newly cited art to the unamended (original) claims in order to support the rejections of the dependent new claims. This argument is unpersuasive as the requester need only address the limitations of the dependent claims and how the newly cited art is needed to modify the rejections of record for the new dependent claims. The newly cited prior art must address the features of the new dependent claims; however, it is unnecessary and impermissible to apply the newly cited prior art to the unamended (original) claims from which these new claims depend (which unamended (original) claims do not contain the features of the new dependent claims).

Accordingly, the replacement comments submission is an improper paper, and it is being expunged.

Since Exhibit 2, which is attached to the present petition, and the replacement comments submission filed concurrently with the present petition have been scanned into the record, i.e., the Office's Image File Wrapper (IFW) file of the present merged reexamination proceeding, these papers are being expunged from the record by closing them and by marking them "not public."

B. The April 18, 2011 Decision Properly Granted-in-Part Requester VWGoA's December 20, 2010 Petition to Waive the Requirements of 37 CFR 1.943(b):

The present petition for reconsideration requests that requester VWGoA's December 20, 2010 petition under 37 CFR 1.183 for additional pages be granted in its entirety.²⁸ Requester VWGoA alleges that "the Office appears to have awarded VWGoA only 42 additional pages for its replacement comments solely on the length of Apple's comments submission."²⁹ Requester argues that it is unreasonable for the Office to base any decision on its request for additional pages on the unrelated comments filed by Apple.³⁰ Requester explains that the difference between Apple's request for 42 additional pages and VWGoA's request for 134 additional pages is that VWGoA submitted 80 pages of claim charts to support its new rejections proposed in its December 20, 2010 comments.³¹ Requester also argues that the Office also appeared to base its decision on the page limit issue on the incorrect interpretation of the rules which would limit VWGoA to asserting any new prior art against only new and amended claims of the '833 patent.³²

However, the Office pointed out in the April 18, 2011 decision that a substantial portion of the original claim charts was devoted to applying the newly cited Simon et al. and Empeg references against unamended (original) claims.³³ Since these newly proposed rejections for unamended (original) claims are improper for the reasons discussed in the April 18, 2011 decision and reiterated above, it is reasonable for the Office not to grant the 134 additional pages that are

²⁸ Petition for reconsideration at page 22.

²⁹ *Id.* at page 21.

³⁰ *Id.*

³¹ *Id.*

³² *Id.* at page 20.

³³ See footnote 6 on page 5 of the April 18, 2011 Office decision.

presently requested for the improper purpose of providing an explanation of how the newly cited references are applied to the unamended (original) claims.

Accordingly, requester's VWGoA's request that the December 20, 2010 petition under 37 CFR 1.183 to be granted in its entirety is denied.

For all the reasons given above, the requester VWGoA's petition under 37 CFR 1.181(a)(3) is denied.

CONCLUSION

1. The petition for reconsideration is granted only to the extent that the April 18, 2011 Office decision has been reconsidered, but is **denied as to the underlying relief requested**.
2. This decision is designated as a final agency action under 5 U.S.C. § 704.
3. The proceeding is being referred to the CRU for issuance of an Office action in due course addressing patent owner's September 14, 2010 response and requester Apple's December 20, 2010 written comments.
4. Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop
 Commissioner for Patents
 Post Office Box 1450
 Alexandria, VA 22313-1450
5. Any questions concerning this communication should be directed to Susy Tsang-Foster, Legal Advisor, at (571) 272-7711 or, in her absence, to the undersigned at (571) 272-7710.

/Kenneth M. Schor/

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

9-15-11
Kenpet8/



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,224	10/22/2009	7283340	29268-0013	1988
44564	7590	02/07/2011	EXAMINER	
BOND, SCHOENECK & KING, PLLC 10 BROWN ROAD, SUITE 201 ITHACA, NY 14850-1248			ART UNIT	PAPER NUMBER

DATE MAILED: 02/07/2011

Please find below and/or attached an Office communication concerning this application or proceeding.



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
MALVERN U. GRIFFIN III
SUTHERLAND ASBILL & BRENNAN LLP
999 PEACHTREE STREET NE
ATLANTA, GA 30309-3996

Date:

MAILED

FEB 07 2011

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001224
PATENT NO. : 7283340
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

**Decision on Petition for Extension
of Time in Reexamination**

Control No.: 95/000,477 & 95/001,224

MAILED

FEB 07 2011

CENTRAL REEXAMINATION UNIT

1. THIS IS A DECISION ON THE PETITION FILED 01 February 2011.

2. THIS DECISION IS ISSUED PURSUANT TO:

- A. ☐ 37 CFR 1.550(c) – The time for taking any action by a patent owner in an *ex parte* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.
- B. ☒ 37 CFR 1.956 – The time for taking any action by a patent owner in an *inter partes* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.
- The petition is before the Central Reexamination Unit for consideration.

3. FORMAL MATTERS

Patent owner requests that the period for responding to the Office action mailed on 07 January 2011 which sets a one (1) month period for filing a response thereto, be extended by and additional two (2) months.

- A. ☒ Petition fee per 37 CFR §1.17(g):
- i. ☐ Petition includes authorization to debit a deposit account.
 - ii. ☐ Petition includes authorization to charge a credit card account.
 - iii. ☐ Other: electronic payment via EFS.
- B. ☒ Proper certificate of service was provided. (Not required in reexamination where patent owner is requester.)
- C. ☒ Petition was timely filed.
- D. ☒ Petition properly signed.

4. DECISION (See MPEP 2265 and 2665)

- A. ☐ Granted or ☒ Granted-in-part for an additional one (1) month, because petitioner provided a factual accounting that established sufficient cause. (See 37 CFR 1.550(c) and 37 CFR 1.956).
☒ Other/comment: MPEP § 2265 notes "requests for more than one month will be granted only in extraordinary situations."
- B. ☐ Dismissed because:
- i. ☐ Formal matters (See unchecked box(es) (A, B, C and/or D) in section 4 above).
 - ii. ☐ Petitioner failed to provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period.
 - iii. ☐ Petitioner failed to explain why, in spite of the action taken thus far, the requested additional time is needed.
 - iv. ☐ The statements provided fail to establish sufficient cause to warrant extension of the time for taking action (See attached).
 - v. ☐ The petition is moot.
 - vi. ☐ Other/comment: _____

5. CONCLUSION

Telephone inquiries with regard to this decision should be directed to J. Harrison at 571-272-4449. In his/her absence, calls may be directed to M. Reinhart at 571-272-1611 in the Central Reexamination Unit.

_____/Mark Reinhart/
[Signature]

(Title) SPE AU 3992



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Bond, Schoeneck & King, PLLC
10 Brown Road, Suite 201
Ithaca, NY 14850-1248

(For Patent Owner)

Andrews Kurth LLP
1350 I Street, N.W.
Suite 1100
Washington, DC 20005

(For '477 Third Party Requester)

MAILED

DEC 16 2011

Sutherland, Asbill & Brennan, LLP
999 Peachtree Street, NE
Atlanta, GA 30309-3996

(For '1224 Third Party ~~Central~~ REEXAMINATION UNIT)

Inter Partes Reexamination Proceeding
Control No. 95/000,477
Filed: June 16, 2009
For: U.S. Patent No. 7,283,340

:
:
: **DECISION**
: **DIMISSING**
: **PETITIONS AND**
: **EXPUNGING**
: **IMPROPER PAPER**
:
:

Inter Partes Reexamination Proceeding
Control No. 95/001,224
Filed: October 22, 2009
For: U.S. Patent No. 7,283,340

This is a decision on: (1) the patent owner paper entitled "PETITION TO DISMISS THIRD PARTY'S CORRECTED NOTICE OF CROSS APPEAL UNDER 37 C.F.R. §§ 1.182" (patent owner petition to strike corrected notice of cross appeal), filed on September 13, 2011, (2) the '1224 third party requester's paper entitled "THIRD-PARTY REQUESTER'S OPPOSITION PAPER IN RESPONSE TO THE PATENT OWNER'S PETITION TO DISMISS CORRECTED NOTICE OF CROSS APPEAL" (third party requester opposition), filed on October 13, 2011, and (3) the patent owner paper entitled "RESPONSE TO REQUESTER'S OPPOSITION PAPER IN RESPONSE TO PATENT OWNER'S PETITION TO DISMISS THIRD PARTY'S CORRECTED NOTICE OF CROSS APPEAL UNDER 37 C.F.R. §§ 1.182" (patent owner opposition paper), filed on October 20, 2011.

The papers are before the Office of Patent Legal Administration.

In light of the November 17, 2011 communication from the Central Reexamination Unit (CRU), finding the '1224 third party requester's August 26, 2011 corrected notice of cross appeal defective, the September 13, 2011 patent owner petition to strike the corrected notice of cross appeal and the October 13, 2011 third party requester opposition are dismissed as moot.


IMPROPER PAPER

The patent owner petition to strike the '1224 third party requester's corrected notice of cross appeal was filed on September 13, 2011. The '1224 third party requester opposition to patent owner's petition to strike the corrected notice of cross appeal was filed on October 13, 2011. On October 20, 2011, patent owner filed an opposition paper in response to the October 13, 2011 third party requester opposition. The October 20, 2011 patent owner opposition paper is an unauthorized paper in the instant merged 95/000,477 and 95/001,224 reexamination proceeding (the merged proceeding). After an opposition to a patent owner petition is filed by a third party requester (regardless of whether such opposition has an entry right or not) any further paper in opposition, rebuttal or response to the third party requester opposition paper is improper and will not be considered, as there is a limitation on party iterations of input, especially given the statutory mandate for special dispatch in reexamination. See MPEP § 2267. There is no indication anywhere in the reexamination statute, or its legislative history, nor in the case law, that multiple iterations of input in petitionable matters prior to decision on the base petition was ever contemplated as an exception to the statutory mandate for special dispatch in reexamination.

In view of the above, the October 20, 2011 patent owner opposition paper is an improper paper, and it will not be made of record in the files of the merged proceeding. Because the October 20, 2011 patent owner opposition paper has been scanned into the electronic Image File Wrapper (IFW) of the 95/001,224 proceeding, the paper is being expunged by marking it "closed" and "non-public" in the IFW, and will not constitute part of the record of the merged proceeding. No copy of the October 20, 2011 patent owner opposition paper will be maintained of record in the Office. A copy of this decision will be made of record in the files of the merged proceeding.

CONCLUSION

1. The September 13, 2011 "PETITION TO DISMISS THIRD PARTY'S CORRECTED NOTICE OF CROSS APPEAL UNDER 37 C.F.R. §§ 1.182" and October 13, 2011 "THIRD-PARTY REQUESTER'S OPPOSITION PAPER IN RESPONSE TO THE PATENT OWNER'S PETITION TO DISMISS CORRECTED NOTICE OF CROSS APPEAL" are dismissed as moot.
2. The October 20, 2011 "RESPONSE TO OPPOSITION PAPER IN RESPONSE TO PATENT OWNER'S PETITION TO DISMISS THIRD PARTY'S CORRECTED NOTICE OF CROSS APPEAL UNDER 37 C.F.R. §§ 1.182" is an improper paper and is being expunged from the record of the merged proceeding.
3. Any questions concerning this communication should be directed to Nicole D. Haines, Legal Advisor, at 571-272-7717.


Pinchus M. Laufer
Senior Legal Advisor
Office of Patent Legal Administration

12-15-2011



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,227	08/25/2009	7580733	8282-83120-02	5216
7590 09/22/2010				
DONALD N. HALGREN 35 CENTRAL STREET MANCHESTER, MA 01944			EXAMINER	
			ART UNIT	PAPER NUMBER

DATE MAILED: 09/22/2010

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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/001,227 02	08/25/09	7580733	8282-83120-

ROBERT F. SCOTTI
KLARQUIST SPARKMAN LLP
121 SW SALMON STREET
SUITE 1600
PORTLAND, OR 97204

EXAMINER	
FOSTER, ROLAND G.	
ART UNIT	PAPER

3992

DATE MAILED:
MAILED

SEP 22 2010

**INTER PARTES REEXAMINATION
COMMUNICATION**

CENTRAL REEXAMINATION UNIT

BELOW/ATTACHED YOU WILL FIND A COMMUNICATION FROM THE UNITED STATES PATENT AND TRADEMARK OFFICE OFFICIAL(S) IN CHARGE OF THE PRESENT REEXAMINATION PROCEEDING.

All correspondence relating to this *inter partes* reexamination proceeding should be directed to the **Central Reexamination Unit** at the mail, FAX, or hand-carry addresses given at the end of this communication.



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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/001,227 02	08/25/09	7580733	8282-83120-

ROBERT F. SCOTTI
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PORTLAND, OR 97204

EXAMINER

FOSTER, ROLAND G.

ART UNIT PAPER

3992

DATE MAILED:

**INTER PARTES REEXAMINATION
COMMUNICATION**

BELOW/ATTACHED YOU WILL FIND A COMMUNICATION FROM THE UNITED STATES PATENT AND TRADEMARK OFFICE OFFICIAL(S) IN CHARGE OF THE PRESENT REEXAMINATION PROCEEDING.

All correspondence relating to this *inter partes* reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of this communication.



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D. N. HALGREN
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MANCHESTER MA 01944

(For Patent Owner)

ROBERT F. SCOTTI
KLARQUIST SPARKMAN, LLP
121 SW SALMON STREET, SUITE 1600
PORTLAND, OR 97204

(For *Inter Partes* Requester)

MAILED

SEP 22 2010

CENTRAL REEXAMINATION UNIT

In re Crowley, *et al.*
Inter Partes Reexamination Proceeding
Control No. 95/001,227
Filed: August 25, 2009
For: U.S. Patent No. 7,580,733

: **DECISION**
: **DISMISSING**
: **PETITIONS AND**
: **EXPUNGING**
: **IMPROPER PAPERS**

This is a decision on patent owner's June 17, 2010 petition paper entitled "PETITION TO EXPUNGE UNDER 37 CFR 1.59(b) BY PATENT OWNER AMBIT CORPORATION" (hereinafter "the petition under 37 CFR 1.59") and patent owner's concurrently-filed June 17, 2010 petition paper entitled "PETITION TO UNDER 37 CFR 1.182 TO DECIDE A QUESTION NOT SPECIFICALLY PROVIDED FOR UNDER THE RULES OR IN THE ALTERNATIVE UNDER 37 CFR 1.183 TO SUSPEND ONE OF THE REQUIREMENTS SET FORTH IN MPEP §724.05" (hereinafter "the petition under 37 CFR 1.182/1.183").

The petition under 37 CFR 1.59 and the petition under 37 CFR 1.181/1.183 are before the Office of Patent Legal Administration for consideration. The petition fee of \$200 for the petition under 37 CFR 1.59 pursuant to 37 CFR 1.17(g) was charged to patent owner's credit card on June 18, 2010. The petition fee of \$400 for the petition under 37 CFR 1.182/1.183 pursuant to 37 CFR 1.17(f) was charged to patent owner's credit card on June 18, 2010.

The petitions under 37 CFR 1.59 and 37 CFR 1.182/1.183 are dismissed.

BACKGROUND

1. On August 25, 2009, the Office issued United States Patent Number 7,580,733 ("the '733 patent") to Crowley, *et al.*
2. On August 25, 2009, a request for *inter partes* reexamination of the '733 patent was filed by a third party requester, which request was assigned Reexamination Control No. 95/001,227 ("the '1227 proceeding").

3. On November 24, 2009, the Office issued an order granting *inter partes* reexamination in the '1227 proceeding.
4. On March 25, 2010, patent owner filed an Information Disclosure Statement in the '1227 proceeding under 37 CFR 1.555, listing a document entitled "EA Current Revision Previous Revision(s) Flow Charts Substantiation Sheets, Last Updated 6/2/03."
5. On June 17, 2010, patent owner filed the instant petitions under 37 CFR 1.59 and under 37 CFR 1.182/1.183.
6. Concurrently, on June 17, 2010, patent owner filed an Information Disclosure Statement, listing a document entitled "D.I. 144-17 submitted in case 1:09-cv-10217-WGY, filed February 5, 2010; 8 pages."

DISCUSSION

I. Relevant Statutes, Regulations and Procedures

CFR 1.59(b) provides:

An applicant may request that the Office expunge information, other than what is excluded by paragraph (a)(2) of this section, by filing a petition under this paragraph. Any petition to expunge information from an application must include the fee set forth in § 1.17(g) and establish to the satisfaction of the Director that the expungement of the information is appropriate in which case a notice granting the petition for expungement will be provided.

37 CFR 1.182 provides:

All situations not specifically provided for in the regulations of this part will be decided in accordance with the merits of each situation by or under the authority of the Director, subject to such other requirements as may be imposed, and such decision will be communicated to the interested parties in writing.

Any petition seeking a decision under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 CFR 1.183 provides:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

MPEP 724.05(II) provides (in-part):

A petition to expunge information unintentionally submitted in an application (other than information forming part of the original disclosure) may be filed under 37 CFR 1.59(b), provided that:

(A) the Office can effect such return prior to the issuance of any patent on the application in issue;

(B) it is stated that the information submitted was unintentionally submitted and the failure to obtain its return would cause irreparable harm to the party who submitted the information or to the party in interest on whose behalf the information was submitted;

(C) the information has not otherwise been made public;

(D) there is a commitment on the part of the petitioner to retain such information for the period of any patent with regard to which such information is submitted;

(E) it is established to the satisfaction of the Director that the information to be returned is not material information under 37 CFR 1.56; and

(F) the petition fee as set forth in 37 CFR 1.17(g) is included.

II. The Petition under 37 CFR 1.59

A. Request to Expunge Information

On March 25, 2010, petitioner patent owner submitted an Information Disclosure Statement (IDS), listing a 92-page document (pages DL 0002238 – DL 0002329) entitled “EA Current Revision Previous Revision(s) Flow Charts Substantiation Sheets, Last Updated 6/2/03” and labeled “CONFIDENTIAL - ATTORNEY'S EYES ONLY.” In the June 17, 2010 petition under 37 CFR 1.59, petitioner requests that this information (hereinafter “the protected information”) be expunged because it “is understood by the Petitioner to be proprietary information of Delta Air Lines, Inc. and is subject to a Protective Order....”¹

Petitioner states that “[t]he information to be expunged was unintentionally submitted by the Petitioner as part of the Information Disclosure Statement filed on March 25, 2010” and that “the failure to obtain the return of this information (EA Current Revision Previous Revision(s) Flow Charts Substantiation Sheets, Last Updated 6/2/03, DL 0002238 - DL 0002329) would cause irreparable harm to Delta Air Lines, Inc. and/or AMBIT Corporation.”² Petitioner further states: that “Delta Air Lines, Inc. commits to retain the information to be expunged for the period of any patent which issues from this application;”³ that other than selected pages of the protected information which have been resubmitted in the June 17, 2010 IDS, the remaining protected

¹ Petition under 37 CFR 1.59 at page 3. *See also*, Exhibit #1 to the petition under 37 CFR 1.59, Stipulation and Protective Order, dated May 4, 2009 (pertaining to civil litigation 1:09-cv-10217-WGY involving U.S. Patent No. 7,400,858) and Exhibit #2 to the petition under 37 CFR 1.59, Order to Modify Protective Order, dated April 4, 2010 (pertaining to civil litigation 1:09-cv-11408-WGY involving the ‘733 patent).

² *Id.* The March 25, 2010 IDS submission also included information that is not subject to a protective order.

³ Pursuant to its request in the concurrently-filed petition under 37 CFR 1.182/1.183, petitioner requests that Delta Airlines, Inc., and not petitioner, be permitted to retain the information for the period of the ‘733 patent.

information submitted with the March 25, 2010 IDS “has not otherwise been made public, other than through any presentation that may have been made by the United States Patent and Trademark Office on PAIR;” and that “[i]t is the Petitioner's belief that the information to be expunged is not material information under 37 C.F.R. 1.56.”⁴

In this instance, petitioner has established that the protected information submitted with the March 25, 2010 IDS is covered by the Stipulation and Protective Order dated May 4, 2009 (“the protective order”).⁵ Under MPEP § 724.05(II), a petition to expunge information unintentionally submitted in an application (other than information forming part of the original disclosure) may be filed under 37 CFR 1.59(b), provided that items (A)-(F) of that paragraph are satisfied. However, pursuant to item (E), protected information inadvertently submitted in an IDS will only be expunged from the record if it is established to the satisfaction of the Director that the information to be returned is not material information under 37 CFR 1.56. Thus, if the examiner determines that the inadvertently submitted protected information is material to patentability, such information would be made part of the public record.

In this instance, petitioner has not provided any evidence that Delta Airlines, Inc. has consented to waiver of the May 4, 2009 protective order in the event the examiner determines that the protected information inadvertently submitted on March 25, 2010 is material to patentability, and has also not provided any evidence that Office personnel are permitted to review the protected information under the terms of the protective order. Thus, the submission of the protected information is inappropriate and could result in a potential violation of the protective order; therefore, the entire March 25, 2010 IDS submission is being expunged from the record of the ‘1227 proceeding as an improper paper by marking the papers “closed” and “not public” in the Image File Wrapper (IFW).⁶ Accordingly, the June 17, 2010 petition under 37 CFR 1.59 is dismissed as moot.

This decision does not relieve patent owner of the duty to disclose to the Office information patent owner is aware of which is material to patentability pursuant to 37 CFR 1.555, regardless of whether the “material” information can be classified as a trade secret, or as proprietary material, or whether it is subject to a protective order.⁷ MPEP § 724 sets forth procedures designed to enable the Office to ensure as complete a patent file wrapper as possible insofar as “material” information is concerned, while preventing unnecessary public disclosure of trade secrets, proprietary material, and protective order material. Also, such information can be redacted to the extent deemed appropriate to satisfy the duty to disclose. Should a situation arise

⁴ *Id.* See also, Exhibit #5 to the petition under 37 CFR 1.59, letter from Delta Airlines, Inc., dated June 11, 2010 (stating “Delta Airlines, Inc. hereby agrees to retain a copy of the document titled “EA Current Revision Previous Revision(s) Flow Charts Substantiation Sheets, Last Updated 6/2/03” for the period of U.S. Patent No. 7,400,858 and U.S. Patent No. 7,580,733.”)

⁵ *E.g.*, see paragraphs 2 and 8 of the protective order. See also, Exhibit #2 to the petition under 37 CFR 1.59, Order to Modify Protective Order, dated April 4, 2010 (stating that the May 4, 2009 Stipulation and Protective Order pertaining to civil litigation 1:09-cv-10217-WGY, involving U.S. Patent No. 7,400,858, shall also apply to civil litigation 1:09-cv-11408-WGY, involving the ‘733 patent.)

⁶ The Office will not expunge portions of papers. Thus, even though portions of the March 25, 2010 IDS submission include information that is not covered by the protective order, the entire March 25, 2010 submission is being expunged as an improper paper.

⁷ See MPEP § 724.

where the duty to disclose is in conflict with the protective order, patent owner should approach the court for relief from the protective order as the Office can not prosecute an application or conduct a reexamination when information material to patentability is withheld.

Further filings that include information covered by the protective order will be expunged until evidence that permission has been granted for public disclosure of the information has been provided in this proceeding. Thus, as to portions of the March 25, 2010 IDS submission that include protected information, the protected information may be resubmitted for consideration pursuant to the procedures set forth in MPEP § 724 when permission for its submission is obtained despite the fact that such information will become part of the public record should the examiner find the information to be material information under 37 CFR 1.56.⁸

As to portions of the March 25, 2010 IDS submission that did not include protected information, petitioner may file a replacement IDS, via a petition under 37 CFR 1.182, listing only those documents identified in the March 25, 2010 IDS that are not subject to the protective order for consideration by the examiner.

B. IDS Submitted June 17, 2010

On June 17, 2010, concurrently with the petition under 37 CFR 1.59, patent owner filed an IDS, listing a document entitled "D.I. 144-17 submitted in case 1:09-cv-10217-WGY, filed February 5, 2010; 8 pages." The document submitted with the June 17, 2010 IDS contains eight pages of the protected information submitted with the March 25, 2010 IDS.⁹ Regarding the subset of protected information submitted with the June 17, 2010 IDS, patent owner states on page 3 of the petition under 37 CFR 1.59:

Delta Air Lines has previously submitted certain pages of the same document (DL 0002252, DL 0002259, DL 0002263, DL 0002265, DL 0002267, DL 0002269, DL 0002296 and DL 0002303) on the public record despite the "Confidential - Attorneys Eyes Only" designation printed thereon. *See* D.I. #144 and 144-16 in Civil Action No. 1:09-CV-10217-WGY in the United States District Court for the District of Massachusetts.

These selected pages may therefore remain on the public record at the Patent Office and have been resubmitted in an Information Disclosure Statement filed concurrently with this Petition.

Patent owner asserts that despite the protected information being designated "Confidential - Attorneys Eyes Only" and falling within paragraph 8(c) of the protective order,¹⁰ eight pages of

⁸ It is noted that on page 3 of the petition under 37 CFR 1.59, petitioner states "[i]t is Petitioner's belief that the information to be expunged is not material information under 37 C.F.R. 1.56." Accordingly, resubmission of such information for consideration by the examiner appears unnecessary.

⁹ The information submitted with the June 17, 2010 IDS contains a subset of the protected information submitted with the March 25, 2010 IDS, which information petitioner seeks to expunge and believes is not material information under 37 CFR 1.56. *See*, the petition under 37 CFR 1.59 at page 3. Thus, submission of the June 17, 2010 IDS does not appear to be necessary.

¹⁰ Petition under 37 CFR 1.59 at page 3.

such information are not protected information covered by the protective order because those pages of information were filed by Delta Airlines, Inc. in the related litigation proceedings.

In this instance, petitioner has not established that the subset of protected information submitted with the June 17, 2010 IDS is not covered by the May 4, 2009 protective order. For example, petitioner has not pointed to any paragraph of the protective order indicating that submission in a related litigation of any of information subject to the protective order would render that information no longer covered by the protective order. Thus, the Office continues to deem the information submitted with the June 17, 2010 IDS to be protected information that is subject to the May 4, 2009 protective order.

Because no evidence has been submitted that Delta Airlines, Inc. has consented to waiver of the protective order with respect to the subset of protected information submitted with the June 17, 2010 IDS, and no evidence has been submitted that Office personnel are permitted to review the information, it is inappropriate to submit such information and cause a potential violation of a protective order. Accordingly, the June 17, 2010 IDS submission is being expunged from the record of the '1227 proceeding as an improper paper by marking the papers "closed" and "not public" in the Image File Wrapper (IFW). As noted in Section (II)(A) of this decision, information covered by the court's protective order is not to be submitted without evidence that permission has been granted for public disclosure of the information, and further filings that include information covered by the protective order will be expunged until such permission has been provided in this proceeding.

III. The Petition under 37 CFR 1.182/1.183

Petitioner patent owner submitted, concurrently with the petition under 37 CFR 1.59, a petition under 37 CFR 1.182 to decide a question not specifically provided for under the rules, or in the alternative under 37 CFR 1.183 to suspend the requirements set forth in MPEP 724.05. In the petition under 37 CFR 1.182/1.183, petitioner requests that Delta Air Lines, Inc., rather than AMBIT Corporation, be permitted to retain the information to be expunged (i.e., the inadvertently submitted protected information filed with the March 25, 2010 IDS) for the period of any patent which issues from the application, because patent owner (AMBIT Corporation) "cannot legally retain a copy of this document beyond ninety (90) days after termination of the 10217 or the 11408 litigations."¹¹ In view of the dismissal of the concurrently-filed petition under 37 CFR 1.59, as set forth herein, the instant petition under 1.182/1.183 is dismissed as moot.

CONCLUSION

1. Patent owner's June 17, 2010 petition under 37 CFR 1.59 is dismissed as moot.
2. Patent owner's June 17, 2010 petition under 37 CFR 1.182/1.183 is dismissed as moot.

¹¹ Petition under 37 CFR 1.182/1.183 at page 4.

3. The March 25, 2010 and the June 17, 2010 IDS submissions are being expunged from the file wrapper of the '1227 proceeding by marking the papers "closed" and "not public."
4. Jurisdiction for the '1227 reexamination proceeding is being returned to the Central Reexamination Unit (CRU).
5. Telephone inquiries with regard to this decision should be directed to Nicole Dretar, Legal Advisor, Office of Patent Legal Administration, at (571) 272-7717, or in her absence, to Pinchus M. Laufer, Legal Advisor, at (571) 272-7726.



Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

9-21-2010



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,228	09/25/2009	6849067	34297-0029	5550
23556	7590	02/09/2011	EXAMINER	
KIMBERLY-CLARK WORLDWIDE, INC. Tara Pohlkotte 2300 Winchester Rd. NEENAH, WI 54956			ART UNIT	PAPER NUMBER

DATE MAILED: 02/09/2011

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AMSTER, ROTHSTEIN & EBENSTEIN LLP
90 PARK AVENUE
NEW YORK, NY 10016

Date:

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FEB 09 2011

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001228
PATENT NO. : 6849067
TECHNOLOGY CENTER : 3999
ART UNIT : 3993

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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Tara Pohlkotte
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(For Patent Owner)

MAILED

FEB 09 2011

CENTRAL REEXAMINATION UNIT

AMSTER, ROTHSTEIN & EBENSTEIN LLP
90 PARK AVENUE
NEW YORK, NY 10016

(For Requester)

In re Fletcher et al.

Reexamination Proceeding

Control No.: 95/001,228

Filing Date: September 25, 2009

For: U.S. Patent No.: 6,849,067

:
: DECISION
: DISMISSING
: PETITIONS
:

The above reexamination proceeding is before the Director of TC 1600, who oversees the Central Reexamination Unit after receipt of a third party requester's petition of February 19, 2010 and a patent owner's petition of April 23, 2010, which are both being treated as petitions under 37 CFR § 1.181 to invoke supervisory authority to not enter the other parties' response and comments, respectively.

The third party requester's petition of February 19, 2010 is dismissed as premature.

The patent owner's petition of April 23, 2010 is dismissed as premature.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 6,849,067 (hereinafter, the '067 patent) issued on February 1, 2005.
2. On September 25, 2009, a request for *inter partes* reexamination of the '067 patent was filed. The request was assigned Control No. 95/001,228 (the '228 proceeding).
3. On December 16, 2009, *inter partes* reexamination was ordered for the '228 proceeding. On the same day, a non-final Office action was mailed in the '228 proceeding.
4. On February 16, 2010, patent owner filed a response to the December 16, 2009 Office action.
5. On February 19, 2010, third party requester filed the present petition under 37 CFR 1.182 to strike the patent owner's February 16, 2010 response as because it allegedly exceeds the 50-page limit of 37 CFR 1.943(b). This petition is being treated as a petition under 37 CFR 1.181.
6. On March 17, 2010, third party requested submitted comments that address the February 16, 2010 patent owner's response and the Office action.
9. On April 23, 2010, patent owner filed the present petition under 37 CFR 1.182, which is being treated as a petition under 37 CFR 1.181 to invoke supervisory authority, to strike the third party requester's revised comments, dated March 17, 2010.
10. The examiner has not acted on the February 16, 2010 response and the March 17, 2010 comments to date.

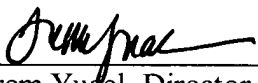
DECISION

As pointed out, the third party requester filed a petition to strike the patent owner's February 16, 2010 response, and the patent owner filed an April 23, 2010 petition to strike the third party requester's March 17, 2010 comments. Both petitions are being treated as petitions under 37 CFR 1.181 to invoke supervisory authority to not enter the opposing party's papers. However, there has been no decision by the examiner if either the patent owner's response of February 16, 2010 or the third party requester's comments of March 17, 2010 are in compliance with Office rules and procedures. Accordingly, it is premature to invoke supervisory authority regarding entry or refusal to enter the revised comments because the examiner has not made his or her decision. Thus, the third party requester's February 19, 2010 petition and the patent owner's April 23, 2010 petition are premature, and they are accordingly dismissed.

CONCLUSION

1. The February 19, 2010 third party requester's petition, which is treated as a petition under 37 CFR § 1.181, is dismissed as premature.

2. The April 23, 2010 patent owner's petition, which is treated as a petition under 37 CFR § 1.181, is dismissed as premature.
3. Telephone inquiries related to this decision should be directed Andy Kashnikow, Supervisory Patent Examiner, at (571) 272-4361.



Irem Yucel, Director
Technology Center 1600



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,228	09/25/2009	6849067	34297-0029	5550
23556	7590	06/23/2011	EXAMINER	
KIMBERLY-CLARK WORLDWIDE, INC. Tara Pohlkotte 2300 Winchester Rd. NEENAH, WI 54956			ART UNIT	PAPER NUMBER

DATE MAILED: 06/23/2011

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90 PARK AVENUE
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Date:

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JUN 23 2011

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001228
PATENT NO. : 6849067
TECHNOLOGY CENTER : 3999
ART UNIT : 3993

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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Tara Pohlkotte
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2300 WINCHESTER ROAD
NEENAH, WI 54956

(For Patent Owner)

MAILED

JUN 23 2011

CENTRAL REEXAMINATION UNIT

AMSTER, ROTHSTEIN & EBENSTEIN LLP
90 PARK AVENUE
NEW YORK, NY 10016

(For Requester)

In re Fletcher et al.
Reexamination Proceeding
Control No.: 95/001,228
Filing Date: September 25, 2009
For: U.S. Patent No.: 6,849,067

:
: **DECISION**
: **DISMISSING**
: **PETITION**
:

The above reexamination proceeding is before the Director of TC 1600, who oversees the Central Reexamination Unit after receipt of a patent owner's petition of June 14, 2011, which is being treated as a petition under 37 CFR § 1.181 to invoke supervisory authority to not enter the third party requester's comments.

The patent owner's petition of June 14, 2011 is dismissed as premature.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 6,849,067 (hereinafter, the '067 patent) issued on February 1, 2005.
2. On September 25, 2009, a request for *inter partes* reexamination of the '067 patent was filed. The request was assigned Control No. 95/001,228 (the '228 proceeding).
3. On December 16, 2009, *inter partes* reexamination was ordered for the '228 proceeding. On the same day, a non-final Office action was mailed in the '228 proceeding.
4. On February 16, 2010, patent owner filed a response to the December 16, 2009 Office action.
5. On February 19, 2010, third party requester filed a petition under 37 CFR 1.182 to strike the patent owner's February 16, 2010 response as because it allegedly exceeded the 50-page limit of 37 CFR 1.943(b). This petition was treated as a petition under 37 CFR 1.181.
6. On March 17, 2010, third party requested submitted comments that addressed the February 16, 2010 patent owner's response and the Office action.
9. On April 23, 2010, patent owner filed a petition under 37 CFR 1.182, which was treated as a petition under 37 CFR 1.181 to invoke supervisory authority, to strike the third party requester's revised comments, dated March 17, 2010.
10. On February 9, 2011, the Office mailed a decision dismissing both the patent owner's and third party requester's petitions.
11. On March 16, 2011, the Office mailed a notice of noncompliance regarding the patent owner's response and the third party requester's comments.
12. On April 15, 2011, the patent owner filed a replacement response in response to the March 16, 2011 notice.
13. On May 16, 2011, the third party requester filed replacement comments on the April 15, 2011 patent owner's response.
14. On June 14, 2011, patent owner filed the present petition under 37 CFR 1.182, which is being treated as a petition under 37 CFR 1.181 to invoke supervisory authority, to strike the third party requester's replacement comments, dated May 16, 2011.
15. The examiner has not acted on the April 15, 2011 response and the May 16, 2011 comments to date.

DECISION

As pointed out, the the patent owner filed a June 14, 2011 petition to strike the third party requester's May 16, 2011 comments. The petition is being treated as petition under 37 CFR 1.181 to invoke supervisory authority to not enter the opposing party's papers. However, there has been no decision by the examiner if the third party requester's replacement comments paper of May 16, 2011 is in compliance with Office rules and procedures. Accordingly, it is premature to invoke supervisory authority regarding entry or refusal to enter the replacement comments because the examiner has not made his or her decision. Thus, the patent owner's June 14, 2011 petition is premature, and it is accordingly dismissed.

CONCLUSION

1. The June 14, 2011 patent owner's petition, which is treated as a petition under 37 CFR § 1.181, is dismissed as premature.
2. Telephone inquiries related to this decision should be directed Andy Kashnikov, Supervisory Patent Examiner, at (571) 272-4361.



Irem Yucel, Director
Technology Center 1600



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,228	09/25/2009	6849067	34297-0029	5550
23556	7590	07/15/2011	EXAMINER	
KIMBERLY-CLARK WORLDWIDE, INC. Tara Pohlkotte 2300 Winchester Rd. NEENAH, WI 54956			ART UNIT	PAPER NUMBER

DATE MAILED: 07/15/2011

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JUL 15 2011

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001228
PATENT NO. : 6849067
TECHNOLOGY CENTER : 3999
ART UNIT : 3993

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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Tara Pohlkotte
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2300 WINCHESTER ROAD
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(Patent Owner)

MAILED

JUL 15 2011

CENTRAL REEXAMINATION UNIT

AMSTER, ROTHSTEIN & EBENSTEIN LLP
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NEW YORK, NY 10016

(For Third Party Requester)

Inter Partes Reexamination Proceeding
Control No. 95/001,228
Filed: September 25, 2009
For: U.S. Patent No. 6,849,067

: **DECISION**
: **GRANTING**
: **PETITION**
:

This is a decision on third party requester's petition paper entitled "REQUESTER'S PETITION UNDER 37 C.F.R. § 1.183 TO WAIVE PAGE LENGTH REQUIREMENT OF 37 C.F.R. §1.943(b)," filed on May 16, 2011. The petition requests waiver of the requirement of 37 CFR 1.943(b) that the written comments by third party requester not exceed fifty (50) pages in length, and requests that the page limit be extended to 83 pages. Third party requester timely filed comments under 37 CFR 1.947 concurrently with the petition.

The petition is before the Office of Patent Legal Administration for consideration.

The petition is granted.

DECISION

I. Relevant Regulations and Procedure

37 CFR 1.183 provides:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 CFR 1.943(b) provides:

Responses by the patent owner and written comments by the third party requester shall not exceed 50 pages in length, excluding amendments, appendices of claims, and reference materials such as prior art references.

MPEP § 2667(I), (TYPES OF PAPERS RETURNED WITH CENTRAL REEXAMINATION UNIT DIRECTOR OR REEXAMINATION LEGAL ADVISOR APPROVAL REQUIRED), provides in pertinent part:

Any affidavit or declaration (or a clearly defined portion thereof) that contains opinion(s) of the affiant/declarant, or argument(s) that the art either does or does not anticipate or render obvious the claims, or specific claim elements, of the patent under reexamination, is considered to be part of the comments submitted by the patent owner, or by the third party requester, and is subject to the page limit requirements of 37 CFR 1.943. Affidavits or declarations that are excluded from the page limit requirements include, for example, declarations attempting to swear behind (antedate) the filing date of a reference, or to establish the date of a printed publication, or declarations that provide comparative test data and an analysis of same. However, if the patent owner's affidavit or declaration includes any argument as to how an outstanding/proposed rejection is overcome, then the page(s) of the affidavit or declaration upon which the argument appears would be included against of the page limit count. Likewise, if a third party requester affidavit or declaration includes any argument as to how a rejection is supported, then the page(s) of the affidavit or declaration upon which the argument appears would be included against of the page limit count. Similarly, attached exhibits presenting data or drawings are not included against the page limit count, unless an exhibit or drawing includes argument as to how the outstanding rejection is overcome. Any page(s) of the exhibit or sheet(s) of drawings that include such argument would be included against the page limit count.

II. Third Party Requester's Petition

In the instant petition, third party requester requests waiver of the requirement under 37 CFR 1.943(b) with respect to the 50-page limit for third party requester's comments filed on May 16, 2011, and requests that the page limit be extended to 83 pages.¹ In support of its request for waiver of the rule, third party requester argues that additional pages are needed to address the 77 newly presented claims. Third party requester further argues that it must comply with the March 16, 2011 Notice of Re Defective Paper in *Inter Partes* Reexamination, which requires requester to propose rejections in accordance with the guidelines set forth in MPEP 2617.²

III. Analysis and Findings

The instant petition under 37 CFR 1.183 has been fully considered. In this instance, petitioner third party requester's May 16, 2011 written comments include 83 pages of remarks, which are

¹ Petition at page 3.

² *Id.* at page 2.

subject to the 50 page limit.³ The third party requester comments are also accompanied by Exhibits 1-16.

A document is deemed to be subject to the 50-page length requirement when the document includes legal argument, i.e., arguments of counsel such as, e.g., arguments that the claims are patentable or unpatentable, or that are directed to how an outstanding or proposed rejection is overcome, or, in the case of a document filed by the requester, how an outstanding or proposed rejection is supported. There are no *per se* rules for determining whether a document, such as an affidavit or declaration, contains a legal argument that will cause the document to be subject to the page count. Each determination is made on a case-by-case basis. In determining whether a document such as an affidavit or declaration under 37 CFR 1.132, or any other document of a submission, includes legal argument, the Office analyzes whether the document is providing factual evidence, i.e., evidence of **technological** facts, or whether the document is merely an extension of the arguments of counsel. Factual evidence includes, for example, declarations that swear behind the filing date of a reference, that establish the date of a printed publication, that provide a technical explanation or technical definition of terms of art used by a reference, or that provide comparative test results and a scientific, or technological, analysis of the results (see, e.g., MPEP 716.02). If a document is limited to factual evidence, the document is not included in the page count. In addition, affidavits or declarations **limited to** establishing commercial success, long-felt need and failure of others, skepticism of experts, or copying, as per MPEP 716.03 -716.06, respectively, will not be included in the page count.

Exhibits 1-3, 7-13, and 16 are free of legal argument. Exhibits 14 and 15 do not contain legal arguments by the requester regarding the claims under reexamination in the present proceeding. For these reasons, Exhibits 1-3 and 7-16 do not count toward the page limit.

As discussed on pages 3, 7 and 10 in the requester's May 16, 2011 comments, Exhibits 4-6 are copies of patent owner papers filed with the European Patent Office during the opposition of patent owner's foreign counterpart application. Since these are patent owner's legal arguments concerning the claims of the foreign counterpart application and not those of the requester regarding these claims of the foreign counterpart application, which are related to the claims under reexamination, these documents do not count toward the page limit.

Accordingly, the May 16, 2011 third party requester comments submission includes *in toto* 83 pages in length that count toward the regulatory page limit.

Upon review of the submitted response for economizing, extraneous material, and arrangement, without repetition of information already of record, it is found that the 33 pages of arguments in excess of 50 required to complete the third party requester's comments are not unreasonable in this instance, in view of the present facts and circumstances. This includes the fact that patent owner's response added 77 new claims. It is deemed equitable to waive the 50-page limit of 37 CFR 1.943(b) in this instance.

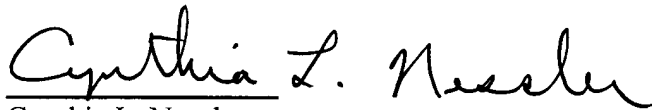
³ This decision is limited to the page-limit issue and the propriety of third party requester's written comments will be reviewed by the Central Reexamination Unit (CRU).

37 CFR 1.183 permits waiver of the page limitation requirement of the regulations in an extraordinary situation when justice requires. Under the facts and circumstances currently of record in the present reexamination proceeding, the instant third party requester petition is deemed to establish that a waiver of 37 CFR 1.943(b) to the extent of permitting third party requester's comments to run 83 pages in length is appropriate in the interest of justice.

Accordingly, third party requester's petition under 37 CFR 1.183 is **granted**. This waiver makes requester's May 16, 2011 comments submission page-length compliant.

CONCLUSION

1. Third party requester's petition under 37 CFR 1.183 is **granted**. This waiver makes the May 16, 2011 third party requester comments submission page-length compliant.
2. Telephone inquiries related to the present decision should be directed to the Susy Tsang-Foster, Legal Advisor, at 571-272-7711.



Cynthia L. Nessler
Senior Legal Advisor
Office of Patent Legal Administration

7/13/11
Kenpet8/



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,235	11/18/2009	6266892	111989-003RE1	5223
62733	7590	05/13/2011	EXAMINER	
KEELY SCHNEITER PRESTON FRISCHKNECHT 399 NORTH MAIN SUITE 300 LOGAN, UT 84321			ART UNIT	PAPER NUMBER

DATE MAILED: 05/13/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Date: 5-13-11

Stephen C. Beuerle
PROCOPIO, CORY HARGRAVES & SAVITCH LLP
530 B Street, Suite 2100
San Diego, CA 92101

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001235
PATENT NO. : 6266892
TECHNOLOGY CENTER : 3999
ART UNIT : 3993

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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CENTRAL REEXAMINATION UNIT (For Patent Owner)

Keely Schneider
Preston Frischknecht
399 North Main
Suite 300
Logan, UT 84321

Procopio, Cory, Hargreaves & Savitch LLP (For Third Party Requester)
525 B Street
Suite 2200
San Diego, CA 92101

In re Haynie	:	
<i>Inter partes</i> Reexamination Proceeding	:	DECISION
Control No: 95/001,235	:	DISMISSING
Filing Date: November 18, 2009	:	PETITIONS
For: U.S. Patent No.: 6,266,892	:	

This decision addresses the following petitions and opposition papers:

- The January 3, 2011 patent owner petition, entitled "Petition To Suspend Reexam Under 37 C.F.R. 1.182" (the January 3, 2011 patent owner petition to suspend);
- The January 31, 2011 requester opposition paper, entitled "Response/Opposition by Third Party Requester to Patent Owner's Petition To Suspend Reexamination Under 37 C.F.R. 1.182" (the January 31, 2011 requester opposition); and
- The January 3, 2011 patent owner petition, entitled "Petition for OPLA to Take Jurisdiction Under 37 C.F.R. 1.182" (the January 3, 2011 patent owner petition to transfer jurisdiction).

The January 3, 2011 patent owner petitions to suspend and to transfer jurisdiction, the January 31, 2011 requester opposition, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

SUMMARY

The January 3, 2011 patent owner petition to suspend, and the January 3, 2011 patent owner petition to transfer jurisdiction, are **dismissed**, in each instance, for failure to pay the \$400 petition fee pursuant to 37 CFR 1.17(f).

The January 31, 2011 requester opposition will be retained in the file, and will be addressed if the patent owner files a renewed petition to suspend under 37 CFR 1.182, accompanied by the appropriate petition fee, and if the requester files, within 15 days of the date of service of patent owner's renewed petition under 37 CFR 1.182, a paper ratifying that the filing of the January 31, 2011 opposition paper is in response to patent owner's renewed petition.

DECISION

37 CFR 1.182 provides, in pertinent part:

Any petition seeking a decision under this section must be accompanied by the petition fee set forth in § 1.17(f).

A careful review of all of the papers filed on January 3, 2011, fails to reveal that the petition fees, totalling \$800, have been received from the patent owner for the petition under 37 CFR 1.182 to suspend, and for the petition under 37 CFR 1.182 to transfer jurisdiction. Furthermore, Office records fail to reveal that, to date, any general authorization by the patent owner to charge a deposit account for any fees due has been received by the Office.

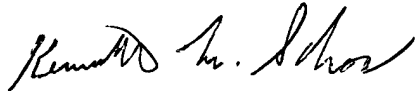
Accordingly, the January 3, 2011 patent owner petition under 37 CFR 1.182 to suspend the present reexamination proceeding, and the January 3, 2011 patent owner petition to transfer jurisdiction to OPLA, are **dismissed**, in each instance, for failure to pay the \$400 petition fee pursuant to 37 CFR 1.17(f).

The January 31, 2011 requester opposition will be retained in the file, and will be addressed if the patent owner files a renewed petition to suspend under 37 CFR 1.182, accompanied by the appropriate petition fee, and if the requester files, within 15 days of the date of service of patent owner's renewed petition under 37 CFR 1.182, a paper ratifying that the filing of the January 31, 2011 opposition paper is in response to patent owner's renewed petition.

CONCLUSION

- The patent owner petition under 37 CFR 1.182 to suspend the present reexamination proceeding, and the January 3, 2011 patent owner petition to transfer jurisdiction to OPLA, are **dismissed**.
- The present *inter partes* reexamination proceeding will continue, and **will not be suspended**.
- The January 31, 2011 requester opposition will be retained in the file, and will be addressed if the patent owner files a renewed petition under 37 CFR 1.182 accompanied by the appropriate petition fee, and if the requester files, within 15 days of the date of service of patent owner's renewed petition under 37 CFR 1.182, a paper ratifying that the filing of the January 31, 2011 opposition paper is in response to patent owner's renewed petition.

- Telephone inquiries related to this decision should be directed to Cynthia L. Nessler, Senior Legal Advisor, at (571) 272-7724, or in her absence, to the undersigned at (571) 272-7710.



Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

5-11-11
Kenpet8/IP/suspend



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,235	11/18/2009	6266892	111989-003RE1	5223
62733	7590	07/01/2011	EXAMINER	
KEELY SCHNEITER PRESTON FRISCHKNECHT 399 NORTH MAIN SUITE 300 LOGAN, UT 84321			ART UNIT	PAPER NUMBER

DATE MAILED: 07/01/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Stephen C. Beuerle
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530 B Street, Suite 2100
San Diego, CA 92101

Date:

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JUL 01 2011

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001235
PATENT NO. : 6266892
TECHNOLOGY CENTER : 3999
ART UNIT : 3993

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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(For Patent Owner)

Procopio, Cory, Hargreaves & Savitch LLP
525 B Street
Suite 2200
San Diego, CA 92101

(For Third Party Requester)

MAILED

JUL 01 2011

In re Haynie
Inter partes Reexamination Proceeding
Control No: 95/001,235
Filing Date: November 18, 2009
For: U.S. Patent No.: 6,266,892

DECISION CENTRAL REEXAMINATION UNIT
DISMISSING
PETITIONS

This decision addresses the following petitions and opposition papers:

- The May 17, 2011 patent owner petition, entitled "Renewed Petition To Suspend Reexam under 37 C.F.R. 1.182" (the May 17, 2011 renewed petition to suspend);
- The May 17, 2011 patent owner petition, entitled "Renewed Petition for OPLA to Take Jurisdiction under 37 C.F.R. 1.182" (May 17, 2011 renewed petition to transfer jurisdiction);
- The January 31, 2011 requester opposition paper, entitled "Response/Opposition by Third Party Requester to Patent Owner's Petition To Suspend Reexamination under 37 C.F.R. 1.182" (the January 31, 2011 requester opposition); and
- The May 31, 2011 requester opposition paper, entitled "Response/Opposition by Third Party Requester to Patent Owner's Renewed Petition to Suspend Reexamination under 37 C.F.R. 1.182" (the May 31, 2011 requester opposition).

The May 17, 2011 patent owner renewed petitions to suspend and to transfer jurisdiction, the January 31, 2011 and May 31, 2011 requester opposition papers, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

SUMMARY

The May 17, 2011 renewed petition to suspend is **dismissed**.

The May 17, 2011 renewed petition to transfer jurisdiction is **dismissed as moot**.

DECISION

The May 17, 2011 Renewed Petition to Suspend the Inter Parties Reexamination Proceeding

The patent owner requests the Office to suspend the present *inter partes* reexamination proceeding.

MPEP 2686.04 provides, in pertinent part (emphasis added):

[35 U.S.C. 314(c)]¹ thus authorizes the Director of the USPTO **to suspend (stay) reexamination proceedings, where there is good cause to do so**, pending the conclusion of litigation based on a potential for termination of a reexamination prosecution under 35 U.S.C. 317(b). Thus, a District Court decision that is pending appeal on the validity of the same claims considered in an *inter partes* reexamination proceeding may provide the requisite statutory “good cause” for suspension, due to the real possibility that the 35 U.S.C. 317(b) estoppel may attach in the near future to bar/terminate the reexamination proceeding.

Factors to be considered in determining whether it is appropriate to suspend action in the reexamination are:

- A. Whether the third party requester is a party to the litigation;
- B. Whether the claims in suit are identical to the claims under reexamination;
- C. Whether the issue(s) raised in the reexamination proceeding are the same issue(s) that were raised or could have been raised by the requester in the litigation;
- D. Whether the litigation has advanced to a late enough stage that there is a sufficient probability that a final decision will be adverse to the requester; and
- E. Whether there is a concurrent *ex parte* reexamination proceeding for the patent.

The patent owner effectively argues that good cause exists to suspend the present proceeding because the requester, Mytee Products, Inc., is a party² to the copending litigation, *Mytee Products, Inc. v. Harris Research, Inc.* Civil Action No. 06-CV-1854 (S.D. Cal.). The Office has confirmed that the requester, Mytee Products, Inc., is a party to the copending litigation, which satisfies item A.³

¹ 35 U.S.C. 314(c) provides, in pertinent part (emphasis added):

Unless otherwise provided by the Director for good cause, all *inter partes* reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, shall be conducted with special dispatch within the Office.

² The requester, in this instance, is the plaintiff in the civil action, and the patent owner, Harris Research, Inc., is a co-defendant.

³ The patent owner is reminded that the patent owner has the burden of providing a sufficient showing of the above-listed factors, including whether the requester is a co-defendant to the litigation. Merely stating that the requester is a

The patent owner further asserts that the claims at issue in the reexamination are identical to those in the litigation. However, as argued by the requester in its January 31, 2011 opposition, the patent owner has provided evidence that only claims 1, 9, and 17 of the patent under reexamination are the subject of the copending litigation. In the present reexamination proceeding, claims 1-4, 8, 9, 12-14 and 16-20 are subject to reexamination. The patent owner further argues that any “non-litigated claims that do exist in this reexamination . . . have been found patentable in this proceeding pursuant to the recent Action Closing Prosecution”. The issue in determining whether it is appropriate to suspend action in the reexamination, however, is not whether any non-litigated claims have been found by the Office to be patentable, but whether the claims in suit are identical to the claims under reexamination. “Good cause” for suspension pending the conclusion of litigation is based on a potential for the termination of reexamination prosecution under 35 U.S.C. 317(b). See MPEP 2686.04, quoted above. If a claim under reexamination is not the subject of the copending litigation, then the estoppel provisions of 35 U.S.C. 317(b) would not apply to the final outcome of the copending litigation as to that patent claim, because there would be no “final decision that the party has not sustained its burden of proving the invalidity” of the patent claim. Thus, there is no “potential for termination” of this reexamination proceeding as to the non-litigated claims. Furthermore, while prosecution has closed pursuant to the November 2, 2010 action closing prosecution (ACP), the present proceeding has not concluded. In any reexamination proceeding, claims that are found to be patentable in an ACP may yet be found to be unpatentable, for example, on appeal to the Board of Patent Appeals and Interferences (Board). A suspension of the present reexamination proceeding would unfairly deprive the requester of its statutory right to have the patentability issue of the claims that are not the subject of the litigation, and thus not potentially subject to the estoppel provisions of 35 U.S.C. 317, resolved *with special dispatch* pursuant to 35 U.S.C. 314(c), by ultimately appealing the claims found patentable in the ACP and obtaining a decision on the appeal. In any event, non-litigated claims 8 and 16 were rejected in the ACP. For these reasons, the patent owner has not shown that the claims at issue in the litigation are identical to the claims in reexamination. In fact, the patent owner appears to admit that the claims are not identical. Thus, item B has not been shown to have been satisfied.

The patent owner further argues that the proceedings in the district court have reached an advanced stage. The patent owner has presented evidence that the district court has entered a judgment on the jury verdict.⁴ The patent owner further states that a notice of appeal before the Federal Circuit has been filed, but that the appeal was dismissed on October 29, 2010. However, the requester, in its May 31, 2011 opposition, has provided evidence that the appeal has been reinstated, in the form of a copy of an order by the United States Court of Appeals for the Federal Circuit (Federal Circuit), in which the Federal Circuit vacates its previous dismissal order and states that “the case is reinstated”. The patent owner argues that the appeal has been fully briefed. However, the patent owner has not provided evidence, such as a copy of the court’s docket, showing that the appeal to the Federal Circuit has been fully briefed.⁵ For this reason, the patent owner has not provided sufficient evidence to permit the Office to render a

co-defendant in the litigation is insufficient. In the present case, the Office was able to verify patent owner’s statement after brief review of the file of the reexamination proceeding. However, if more than a brief review is required to determine the above factors, then the showing of the patent owner will be determined to be insufficient.

⁴ See exhibit A which accompanies the present petition, and which is a court document entitled “Final Judgment”.

⁵ See footnote 3.

determination as to item D, i.e., whether the copending litigation has advanced to a late enough stage that there is a sufficient probability that a final decision will be adverse to the requester. Thus, item D has not been shown to have been satisfied.

Office records do not reveal the existence of a co-pending *ex parte* reexamination proceeding for the '892 patent, which satisfies item E.

Finally, regarding item C, the patent owner argues that the requester "could have raised", in the earlier-filed copending litigation, issues that were raised in the present reexamination proceeding. On the other hand, the requester, in its opposition, argues that these issues, including at least some of the prior art cited in the reexamination proceeding, could not have been raised in the earlier-filed copending litigation. Because the patent owner has not provided a showing that the claims in the copending litigation are identical to the claims under reexamination, the Office need not resolve this issue in the present decision.

See also *Sony Computer Entertainment America, Inc. v. Dudas*, 85 USPQ2d 1594 (E.D. Va. 2006), where the court upheld the Office's determination of "good cause" to suspend two related *inter partes* reexamination proceedings. The facts of the present case are clearly distinguishable from *Sony*. Reexamination in *Sony* was limited to the claims that were being litigated. In the present case, however, the claims under reexamination differ from those in the copending litigation. Furthermore, in *Sony*, no action on the merits had been issued, while in the present case, prosecution has advanced to an action closing prosecution, after which responsive papers by both parties have already been filed. In other words, the patent owner has not shown that a final decision *as to all claims under reexamination* is expected in the near future, and the present proceeding has progressed significantly on the merits.

Without a final decision adverse to requester as to all claims under reexamination, no estoppel can attach as to all claims, to mandate termination of the present ordered reexamination proceeding. The fact that estoppel could possibly attach as to some of the claims at some uncertain point in the future, as argued by patent owner, does not provide the requisite showing of good cause for suspension.

In summary, the patent owner has not provided a showing of good cause to suspend prosecution of the present reexamination proceeding.

Accordingly, the May 17, 2011 patent owner petition to suspend the present *inter partes* reexamination proceeding is **dismissed**. Pursuant to MPEP 2686.04, the present *inter partes* reexamination proceeding **will continue**, and **will not be suspended**.

If a renewed petition to suspend the present *inter partes* reexamination proceeding is later contemplated, **the factors explained in this decision must be addressed** in order to provide a complete renewed petition.

The May 17, 2011 Renewed Petition to Transfer Jurisdiction


The patent owner requests that jurisdiction of the present reexamination proceeding be transferred from the Central Reexamination Unit (CRU) to the Office of Patent Legal Administration (OPLA) until a decision on the renewed petition to suspend, also filed on May 17, 2011, has been decided.

Patent owner's request, i.e., that OPLA take jurisdiction until a decision on the petition to suspend has been issued, is moot because a decision on the renewed petition to suspend has now been rendered.

For the foregoing reason, the May 17, 2011 petition to transfer jurisdiction is **dismissed as moot**.

CONCLUSION

- The May 17, 2011 renewed petition to suspend is **dismissed**.
- The present *inter partes* reexamination proceeding will continue, and **will not be suspended**.
- The May 17, 2011 renewed petition to transfer jurisdiction is **dismissed as moot**.
- Telephone inquiries related to this decision should be directed to Cynthia L. Nessler, Senior Legal Advisor, at (571) 272-7724, or in her absence, to the undersigned at (571) 272-7710.



Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

6-30-11
Kenpet8/IP/suspend



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,238	09/28/2009	6847822	40756-503RE2	6689
30623	7590	04/04/2011	EXAMINER	
MINTZ, LEVIN, COHN, FERRIS, GLOVSKY AND POPEO, P.C ONE FINANCIAL CENTER BOSTON, MA 02111			ART UNIT	PAPER NUMBER

DATE MAILED: 04/04/2011

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Inter Parte Reexamination Communication Transmittal Form



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

MORRISON & FOERSTER, LLP

555 WEST FIFTH STREET

SUITE 3500

LOS ANGELES, CA 90013-1024

Date: **MAILED**

APR 04 2011

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001238

PATENT NO. : 6847822

TECHNOLOGY CENTER : 3999

ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

PTOL-2070(Rev.07-04)



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MINTZ, LEVIN, COHN, FERRIS, GLOVSKY AND POPEO, P.C. (for Patent Owner)
ONE FINANCIAL CENTER
BOSTON, MA 02111

MAILED

MORRISON & FOERSTER LLP
555 West Fifth Street, Suite 3500
Los Angeles, CA 90013

(for Requester) APR 04 2011
CENTRAL REEXAMINATION UNIT

In re Dennison et alia

Patent No. 6847822

Issue Date: January 25, 2005

Control No.: 95/001,238

Filed: September 28, 2009

For: **CELLULAR TELEPHONE SYSTEM THAT USES:
POSITION OF A MOBILE UNIT TO MAKE
CALL MANAGEMENT DECISIONS**

**DECISION GRANTING
PETITION
37 CFR 1.324**

This is a decision on the petition filed January 18, 2011 to correct inventorship under 37 CFR 1.324.

The petition is granted.

The patented file is not being forwarded to Certificate of Corrections Branch for issuance of a certificate naming only the actual inventor or inventors because the reexamination certificate that will ultimately issue will contain the appropriate change of inventorship information.

Eric Keasel
Supervisory Patent Examiner
Art Unit 3992



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,240	10/02/2009	6891811	2187.019REX0	5316
93344	7590	09/15/2010	EXAMINER	
FLACHSBART & GREENSPOON, LLC 333 N. MICHIGAN AVE. 27TH FLOOR CHICAGO, IL 60601			ART UNIT	PAPER NUMBER

DATE MAILED: 09/15/2010

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Date:

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SEP 15 2010

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001240

PATENT NO. : 6891811

TECHNOLOGY CENTER : 3999

ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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FLACHSBART & GREENSPOON, LLC
333 N. MICHIGAN AVE.
27TH FLOOR
CHICAGO IL 60601

(For Patent Owner)

MAILED

SEP 15 2010

STERNE, KESSLER, GOLDSTEIN & FOX, PLLC
1100 NEW YORK AVENUE, NW
WASHINGTON, DC 20005

CENTRAL REEXAMINATION UNIT
(For Third Party Requester)

In re Smith et al.
Inter Partes Reexamination Proceeding
Control No.: 95/001,240
Filing Date: October 2, 2009
For: U.S. Patent No. 6,891,811

: **DECISION ON PETITION**
: **TO CONTINUE**
: **INTER PARTES**
: **REEXAMINATION**
: **PROCEEDING**

This is a decision on the July 21, 2010 patent owner petition entitled "REQUEST FOR CONTINUED REEXAMINATION UNDER 37 CFR § 1.182."

The petition is before the Office of Patent Legal Administration.

For the reasons set forth below, the petition is dismissed.

BACKGROUND

- On October 2, 2009, a request for *inter partes* reexamination was filed by the third party requester, and the resulting reexamination proceeding was assigned control number 95/001,240 ("the '1240 proceeding").
- Prosecution progressed until, on June 21, 2010, an Action Closing Prosecution (ACP) was issued.
- On July 21, 2010, patent owner filed the instant petition entitled "REQUEST FOR CONTINUED REEXAMINATION UNDER 37 CFR § 1.182."
- Concurrently with its July 21, 2010 petition under 37 CFR 1.182, patent owner filed the following papers: (1) a response to the ACP, along with a claim listing canceling claim 27, (2) a petition entitled "PETITION UNDER 37 CFR § 1.181 TO WITHDRAW ACTION CLOSING PROSECUTION AS PREMATURE," and (3) a petition entitled "PETITION UNDER 37 CFR § 1.181 TO REOPEN PROSECUTION."

RELEVANT REGULATIONS

37 CFR 1.182 provides:

All **situations not specifically provided** for in the regulations of this part will be decided in **accordance with the merits** of each situation by or under the authority of the Director, subject to such other requirements as may be imposed, and such decision will be communicated to the interested parties in writing. Any petition seeking a decision under this section must be accompanied by the petition fee set forth in § 1.17(f). (emphasis added)

37 CFR 1.951(a) provides:

After an Office action closing prosecution in an *inter partes* reexamination, the patent owner may once file comments limited to the issues raised in the Office action closing prosecution. The comments can include a proposed amendment to the claims, which amendment will be subject to the criteria of § 1.116 as to whether or not it shall be admitted. The comments must be filed within the time set for response in the Office action closing prosecution.

DECISION

In March 2005, the Office issued a Notice titled "Notice of Changes in Requirement for a Substantial New Question of Patentability for a Second or Subsequent Request for Reexamination While an Earlier Filed Reexamination is Pending."¹ Notice was provided therein that a patent owner could file a petition under 37 CFR 1.182 requesting continued prosecution on the merits in the reexamination proceeding to seek entry of an amendment and/or evidence that was denied entry after an action closing prosecution in an *inter partes* reexamination proceeding.

By filing such a petition, the patent owner could obtain continued prosecution on the merits in the reexamination proceeding, including entry of the amendment and/or evidence that was denied entry after an action closing prosecution in an *inter partes* reexamination proceeding. Accordingly, relief in the form of a continuation of the reexamination prosecution (after a final Office action) was made available by the Office via a 37 CFR 1.182 petition, in appropriate circumstances.

37 CFR 1.182 addresses only those situations not otherwise provided for in the regulations. Where a situation exists such that relief is specifically provided for elsewhere in the regulations, 37 CFR 1.182 is not, according to the terms of that regulation, the appropriate mechanism for relief. In this instance, 37 CFR 1.951(a) provides a vehicle for requesting the entry of comments

¹ 1292 Off. Gaz. Pat. Office 20, March 1, 2005.

and amendment after an ACP during the time period set for response in the ACP, subject to the criteria of 37 CFR 1.116.

The July 21, 2010 patent owner petition is filed under 37 CFR 1.182 requesting continued reexamination in order to provide patent owner "with a first opportunity to respond to newly raised arguments and citations with the assurance that the response will be entered and considered" in response to the ACP;² the present petition under 37 CFR 1.182 does not request entry of the concurrently submitted amendment cancelling claim 27 in response to the ACP. As of the time of filing the petition under 37 CFR 1.182, the Office had not yet rendered a decision on the entry of the submissions under 37 CFR 1.951(a), or under any other applicable section. Since the Office has not denied entry of the amendment filed in response to the ACP, the request for continuation of prosecution fails "to seek entry of an amendment and/or evidence that was denied entry . . . after an action closing prosecution," as required for the procedure set forth in the March 2005 Notice.

Furthermore, the comments and amendment submitted on July 21, 2010 by patent owner were filed within the time period set forth for response in the ACP. During this period, 37 CFR 1.951(a) specifically provides for the consideration of the comments and amendments, the latter being subject to the criteria of 37 CFR 1.116.³ Since patent owner's submissions may be addressed through 37 CFR 1.951, consideration of the present petition under 37 CFR 1.182 is premature.

To accommodate the need for statutory special dispatch in reexamination, jurisdiction is being forwarded to the Central Reexamination Unit to process the July 21, 2010 patent owner amendment, and comments (filed with the present petition) as submissions under 37 CFR 1.951(a), and for the examiner to treat them as such.

Accordingly, the petition is dismissed as being premature.

CONCLUSION

1. The petition under 37 CFR 1.182 is dismissed.
2. Prosecution is not being reopened by this decision.
3. Jurisdiction over the reexamination proceeding is being forwarded to the Central Reexamination Unit to process the July 21, 2010 patent owner amendment, and comments (filed with the petition) as submissions under 37 CFR 1.951(a), and for the examiner to treat them as such.

² Petition under 37 CFR 1.182 at page 2.

³ It is noted that 37 CFR 1.116(b)(1) permits cancellation of claims in an amendment after ACP. Furthermore, contrary to patent owner's assertion at page 2 of the instant petition under 37 CFR 1.182 that the grant of the present request for continued reexamination "would provide Patentee with a first opportunity to respond to newly raised arguments and citations with the assurance that the response will be entered and considered," 37 CFR 1.951(a) specifically provides for the consideration of patent owner's comments in response to the ACP.

4. All correspondence relating to this *inter partes* reexamination proceeding should be directed:

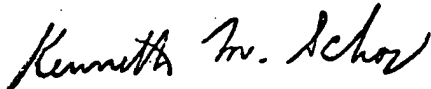
By EFS: Registered users may submit the response via the electronic filing system EFS-Web, at: <https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html>.

By Mail to: Mail Stop *Inter Partes* Reexam
Attn: Central Reexamination Unit
Commissioner for Patents
United States Patent & Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

By hand: Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

For EFS-Web transmissions, 37 CFR 1.8(a)(1)(i) (C) and (ii) states that correspondence (except for a request for reexamination and a corrected or replacement request for reexamination) will be considered timely filed if (a) it is transmitted via the Office's electronic filing system in accordance with 37 CFR 1.6(a)(4), and (b) includes a certificate of transmission for each piece of correspondence stating the date of transmission, which is prior to the expiration of the set period of time in the Office action.

5. Telephone inquiries related to this decision should be directed to Susy Tsang-Foster, Legal Advisor, at (571) 272-7711.



Kenneth M. Schor,
Senior Legal Advisor
Office of Patent Legal Administration

Kenpet7
9-15-2010



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,240	10/02/2009	6891811	2187.019REX0	5316
93344	7590	04/08/2011	EXAMINER	
FLACHSBART & GREENSPOON, LLC 333 N. MICHIGAN AVE. 27TH FLOOR CHICAGO, IL 60601			ART UNIT	PAPER NUMBER

DATE MAILED: 04/08/2011

Please find below and/or attached an Office communication concerning this application or proceeding.



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
STERNE, KESSLER, GOLDSTEIN & FOX, PLLC
1100 NEW YORK AVENUE, NW
WASHINGTON, DC 20005

Date:

MAILED

JAN 6 2011

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001240
PATENT NO. : 6891811
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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(For Patent Owner)

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333 N. MICHIGAN AVE.
27TH FLOOR
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(For Requester) CENTRAL REEXAMINATION UNIT

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.
1100 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

In re: Smith et alia
Reexamination Proceeding
Control No. 95/001,240
Request Deposited: October 2, 2009
For: U.S. Patent No. 6,891,811

DECISION
DISMISSING
PETITIONS

The *inter partes* reexamination is before the Central Reexamination Unit to address the following papers:

- 1) The Patent Owner (PO) paper filed July 21, 2010 entitled "PETITION UNDER 37 CFR §1.181 TO WITHDRAW ACTION CLOSING PROSECUTION AS PREMATURE".
- 2) The PO paper filed July 21, 2010 entitled "PETITION UNDER 37 CFR §1.181 TO REOPEN PROSECUTION".

FINDINGS and DECISION

As these petitions address common issues, they are addressed together.

Regarding the anticipation rejection over Nokia I for the "translation module" limitation, the non-final office action cites page 14, lines 1-13, while the ACP cites page 14, lines 1-13 and 27-34). Petitioner argues that the additional lines cited in the ACP refer to a different embodiment. To the extent that such an argument goes to the merits of whether a single embodiment

Art Unit: 3992

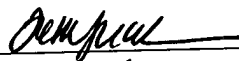
anticipates the claims, this decision does not address the merits of the rejection because the merits of a rejection is subject to appeal to the Board of Patent Appeals and Interferences. To the extent that petitioner argues that this is essentially a new grounds of rejection, the Office disagrees. Lines 1-13 of page 14 do not refer to only an "indirect short message" embodiment while lines 27-34 refer only to a "direct short message" embodiment.

Petitioner argues that the Chen provisional application is newly cited and "[t]he [e]xaminer chose not to cite the Chen provisional application or provide any indication that the Chen patent was fully supported by the Chen provisional application." The Office disagrees. Since Chen would not be prior art if the provisional application did not provide support for the applied teachings, it is apparent in the record that the examiner considered the provisional application to fully support the teachings in both the non-final rejection and the ACP.

Petitioner further argues that essentially any additional comment supporting a rejection is a new ground of rejection without pointing to any specific language in the office actions. There is no new ground of rejection when the basic thrust of the rejection remains the same such that a patent owner has been given a fair opportunity to react to the rejection. Petitioner has not pointed to any language that they allege changes the basic thrust of the rejection (other than the misinterpretation of Nokia I discussed above).

CONCLUSION

1. The Patent Owner petitions listed above are dismissed.
2. Inquiries regarding this decision may be directed to Eric Keasel, Supervisory Patent Examiner, at (571) 272-4929.
3. This decision is not a final agency decision and is without prejudice to request reconsideration or higher-level review.



Irem Yucel
Director, Central Reexamination Unit



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,240	10/02/2009	6891811	2187.019REX0	5316

93344 7590 08/18/2011

FLACHSBART & GREENSPOON, LLC
333 N. MICHIGAN AVE.
27TH FLOOR
CHICAGO, IL 60601

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 08/18/2011

Please find below and/or attached an Office communication concerning this application or proceeding.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

Inter partes
Sybase 365, Inc.
v.
TeleCommunication Systems, Inc.

Inter Partes Reexamination Control No. 95/001,240
Patent 6,891,811
Technology Center 3900

DECISION ON PETITION

This is a decision on “Patentee’s Petition under 37 C.F.R. § 1.183 to Waive Application of 37 C.F.R. § 1.943(c), to Allow Submission of an Oversized Appeal Brief,” filed July 12, 2011 (“Present Petition”). In the Present Petition, patent owner requests extension of the 14,000 word limit of 37 C.F.R. §1.943(c), to permit entry of the accompanying appellant brief of 75 pages and about 20,258 words. The petition fee of \$400 in accordance with 37 C.F.R. § 1.17(f) was charged to petitioner’s credit card on July 13, 2011, as well as the fee for the appeal brief.

Inter Partes Reexamination Control No. 95/001,240
Patent No. 6,891,811

See 75 Fed. Reg. 50,750-51 (Aug. 17, 2010) for authority of the Chief Administrative Patent Judge.

FINDINGS

1. Third party requester filed a request for *inter partes* reexamination of U.S. Patent No. 6,891,811 B1 on October 2, 2009, which was assigned control no. 95/001,240.
2. On November 13, 2009, reexamination was ordered and a non-final Office action was mailed, rejecting claims 1-3, 5-12, 14-20 and 22-27.
3. Patent owner filed a response to the non-final Office action on January 12, 2010, within the 50 page limit pursuant to 37 C.F.R. § 1.943(b).
4. Requester filed comments on February 4, 2010, accompanied by a petition to exceed the page limit.
5. Patent owner filed an opposition to the requester's petition on February 15, 2010. On the same date, patent owner also filed a petition requesting entry of a supplemental response in view of a new court decision.
6. The requester's petition was dismissed in a decision mailed May 11, 2010, therefore the comments of February 4, 2010, were not entered.
7. Patent owner's petition for entry of a supplemental response was granted in a decision mailed May 11, 2010; and the petition decision set forth that the requester had 30 days from the mailing date of the petition decision to file comments in reply to patent owner's supplemental response pursuant to 37 C.F.R. § 1.947.
8. On June 21, 2010, an Action Closing Prosecution (ACP) was mailed rejecting claims 1-3, 5-12, 14-20 and 22-27.
9. Patent owner filed a response to the ACP on July 21, 2010, within the 50 page limit pursuant to 37 C.F.R. § 1.943(b).

Inter Partes Reexamination Control No. 95/001,240
Patent No. 6,891,811

10. On April 1, 2011, a Right of Appeal Notice (RAN) was mailed rejecting claims 1-3, 5-12, 14-20 and 22-26.
11. Patent owner filed a Notice of Appeal on April 29, 2011, appealing the rejections of claims 1-3, 5-12, 14-20 and 22-26.
12. Patent owner filed an appellant brief on July 12, 2011, accompanied by the Present Petition.

DISCUSSION

In the Present Petition, patent owner requests waiver of the limits of 37 C.F.R. § 1.943(c), which limits patent owner's appellant brief to thirty pages or 14,000 words in length. The patent owner's appellant brief of July 12, 2011, is stated to be 75 pages and about 20,258 words.

Patent owner requests extension of the limits for the following reasons:

1. The RAN incorporates by reference 94 pages of rejections from the ACP;
2. The RAN includes 3 anticipation rejections, and 23 obviousness rejections, including 7 prior art references;
3. A range of difficult issues is presented, e.g., claim interpretation in view of prior court interpretations, means-plus-function treatment, prior art compliance with enablement requirements, prior art entitlement to provisional application effective prior art dates;
4. Reducing the size of the appellant brief to 14,000 words would require omitting meaningful appeal arguments, and would prejudice the patentee's important property rights, as well as deprive the Board of a full context for understanding the various claimed inventions.

RELEVANT AUTHORITY

37 CFR § 1.183 provides:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, sua sponte, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 CFR § 1.943(c) provides:

Appellant's briefs filed by the patent owner and the third party requester shall not exceed thirty pages or 14,000 words in length, excluding appendices of claims and reference materials such as prior art references. All other briefs filed by any party shall not exceed fifteen pages in length or 7,000 words. If the page limit for any brief is exceeded, a certificate is required stating the number of words contained in the brief.

MPEP § 2667 I.A.2 (Response filed by Patent Owner that is too long) provides:

With respect to the length of the papers, the following additional information is to be noted. Similar to the Federal Rules of Appellate Procedure, the provisions of 37 CFR 1.943(c) are waived to the extent that the table of contents pages, the table of case law pages, and the pages of the claims (but not claim charts applying the art to the claims) are excluded from the thirty (30) page limit required by 37 CFR 1.943(c).

Any affidavit or declaration (or a clearly defined portion thereof) that contains opinion(s) of the affiant/declarant, or argument(s) that the art either does or does not anticipate or render obvious the claims, or specific claim elements, of the patent under reexamination, is considered to be part of the comments submitted by the patent owner, or by the third party requester, and is subject to the page limit requirements of 37 CFR 1.943. Affidavits or declarations that are excluded from the page limit requirements include, for example, declarations

attempting to swear behind (antedate) the filing date of a reference, or to establish the date of a printed publication, or declarations that provide comparative test data and an analysis of same. However, if the patent owner's affidavit or declaration includes any argument as to how an outstanding/proposed rejection is overcome, then the page(s) of the affidavit or declaration upon which the argument appears would be included against the page limit count. Likewise, if a third party requester affidavit or declaration includes any argument as to how a rejection is supported, then the page(s) of the affidavit or declaration upon which the argument appears would be included against the page limit count. Similarly, attached exhibits presenting data or drawings are not included against the page limit count, unless an exhibit or drawing includes argument as to how the outstanding rejection is overcome. Any page(s) of the exhibit or sheet(s) of drawings that include such argument would be included against the page limit count.

MPEP § 2667 I.B.2 (Response filed by Third Party Requester that is too long) provides:

For additional information with respect to the length of papers, see Subsection I.A.2 above.

ANALYSIS

Patent owner's Present Petition has been considered fully. The USPTO has the discretion to waive the applicable rules under 37 C.F.R. § 1.183 in an extraordinary situation when justice requires waiver. Upon review of the prosecution history of this proceeding, it is noted that the patent owner responses prior to appeal have been well within the page limit requirements. However, the appellant brief filed subsequent to appeal is significantly longer, whereas the rules require that the appellant brief be more limited than pre-appeal responses. Patent owner's appellant brief filed on July 12, 2011, is stated to be 75 pages and about 20,000 words, which far exceeds the limit of 30 pages and 14,000 words.

Inter Partes Reexamination Control No. 95/001,240
Patent No. 6,891,811

Petitioner's reasons provided in support of waiving the page/word limits focus on the RAN incorporating the ACP by reference, the multitude of rejections appealed, the numerous references applied, and the complexity of the issues on appeal. A review of the record reveals that the RAN contains 3 rejections under 35 U.S.C. § 102, and 23 rejections under 35 U.S.C. § 103 of 23 claims over 7 references. The RAN refers to the prior art rejections set forth in detail in the ACP. All of patent owner's responses have been entered, whereas none of requester's comments have been entered. The patent owner was permitted to file a supplemental response to the non-final Office action, and requester was provided with an opportunity to file comments, but did not timely do so.

Prior to appeal, the Examiner included the rejections in the non-final Office action and the Action Closing Prosecution. These rejections were addressed in significantly fewer pages, i.e., 49 pages in patent owner's response of January 21, 2010, and 26 pages in patent owner's response of July 12, 2010, than in the appellant brief (75 pages). Since requester's comments were not entered, prosecution was simplified because patent owner only needed to address the examiner's rejections. Patent owner's appellant brief contains arguments from page 12 through page 75. It is not evident how appellant has attempted to consolidate their arguments so as to comply with the page and word limit. In fact, petitioner states that appellant considered reducing the size of the brief, but decided not to because it would require omitting meaningful appeal arguments, and would prejudice the patentee's important property rights, as well as deprive the Board of a full context for understanding the various claimed inventions to comply with the page/word limits.

Inter Partes Reexamination Control No. 95/001,240
Patent No. 6,891,811

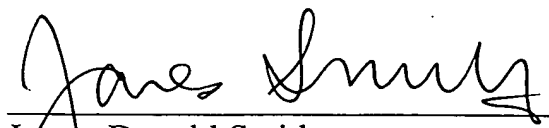
While these are all true, the Present Petition does not explain why these are extraordinary circumstances. The page/word limits are intentionally designed to focus the issues and require a concise presentation of arguments. In this specific case, a persuasive showing has not been made that this situation is extraordinary and that justice requires that more pages/words be allotted to the appellant brief. The present petition is **denied**, and the appellant brief of July 12, 2011, is not entered.

DECISION

Appellant is given one opportunity to file a corrected appellant brief in compliance with 37 C.F.R. § 1.943(c), within a non-extendable time period of 1 month from the mailing date of this decision. If a corrected appellant brief is not timely submitted, the appellant's appeal will be dismissed.

If a corrected appellant brief is timely received, then third party requester's respondent brief will be due pursuant to 37 C.F.R. § 41.66.

In view of the foregoing, the present petition is **DENIED**.



James Donald Smith
Chief Administrative Patent Judge

Inter Partes Reexamination Control No. 95/001,240
Patent No. 6,891,811

Counsel for Patent Owner:

Flachsbart & Greenspoon, LLC
333 N. Michigan Ave., 27th Floor
Chicago, IL 60601

Counsel for Third Party Requester

Sterne, Kessler, Goldstein & Fox, PLLC
1100 New York Ave, N.W.
Washington, D.C. 20005



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STEVEN M. EVANS
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CHICAGO IL 60601

: (For Patent Owner)

MAILED

OCT 07 2010

STERNE KESSLER GOLDSTEIN & FOX
1100 NEW YORK AVE, NW
WASHINGTON, DC 20005

: (For Third Party Requester)

CENTRAL REEXAMINATION UNIT

In re Smith et al.
Inter Partes Reexamination Proceeding
Control No. 95/001,241
Filed: October 2, 2009
For: U.S. Patent No. 7,355,990 B2

:
: **DECISION**
: **DISMISSING PETITION**
: **UNDER 37 C.F.R. § 1.182**
:

This is a decision on the July 19, 2010 patent owner petition entitled "REQUEST FOR CONTINUED REEXAMINATION UNDER 37 CFR § 1.182."

The petition is before the Office of Patent Legal Administration.

For the reasons set forth below, the petition is dismissed.

BACKGROUND

- On October 2, 2009, a request for *inter partes* reexamination of all of the claims of U.S. Patent Number 7,355,990 B2, having 28 claims, was filed by the third party requester. This request met the filing requirements of 37 C.F.R. § 1.915, and the resulting reexamination proceeding was assigned control number 95/001,241 ("the '1241 proceeding").
- Prosecution progressed until, on June 19, 2010, an Action Closing Prosecution (ACP) was issued.
- On July 19, 2010 patent owner filed the following papers:
 - A paper entitled "RESPONSE TO ACTION CLOSING PROSECUTION," which includes proposed new claims 36-41 and amendments to claims 29-32. All of the original patent claims, claims 1-28, remain unamended.

- The instant petition entitled “REQUEST FOR CONTINUED REEXAMINATION UNDER 37 CFR § 1.182,” requesting entry of the amendment and remarks filed on the same date.
- A petition entitled “PETITION UNDER 37 C.F.R. § 1.181 TO REOPEN PROSECUTION,” and
- A petition entitled “PETITION UNDER 37 C.F.R. § 1.181 TO WITHDRAW ACTION CLOSING PROSECUTION AS PREMATURE.”

RELEVANT STATUTES, REGULATIONS, AND EXAMINING PROCEDURE

37 CFR 1.182 provides:

All situations not specifically provided for in the regulations of this part will be decided in **accordance with the merits** of each situation by or under the authority of the Director, subject to such other requirements as may be imposed, and such decision will be communicated to the interested parties in writing. Any petition seeking a decision under this section must be accompanied by the petition fee set forth in § 1.17(f). (emphasis added)

37 CFR 1.181 provides, in pertinent part:

- (a) Petition may be taken to the Director:
- (1) From any action or requirement of any examiner in the ex parte prosecution of an application, or in ex parte or inter partes prosecution of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court

37 CFR 1.951(a) provides:

After an Office action closing prosecution in an inter partes reexamination, the patent owner may once file comments limited to the issues raised in the Office action closing prosecution. The comments can include a proposed amendment to the claims, which amendment will be subject to the criteria of § 1.116 as to whether or not it shall be admitted. The comments must be filed within the time set for response in the Office action closing prosecution.

DECISION

In March of 2005, the Office issued a Notice titled “Notice of Changes in Requirement for a Substantial New Question of Patentability for a Second or Subsequent Request for Reexamination While an Earlier Filed Reexamination is Pending.”¹ Notice was provided therein that a patent owner could file a petition under 37 C.F.R. § 1.182 requesting continued

¹ 1292 *Off. Gaz. Pat. Office* 20, March 1, 2005.

prosecution on the merits in the reexamination proceeding to seek entry of an amendment and/or evidence that was denied entry after a final rejection in an *ex parte* reexamination proceeding, or after an action closing prosecution in an *inter partes* reexamination proceeding.

By filing such a petition, the patent owner could obtain continued prosecution on the merits in the reexamination proceeding, including entry of the amendment and/or evidence that was denied entry after a final rejection in an *ex parte* reexamination proceeding, or after an action closing prosecution in an *inter partes* reexamination proceeding. Accordingly, relief in the form of a continuation of the reexamination prosecution (after a final Office action) was made available by the Office via a 37 C.F.R. § 1.182 petition, in appropriate circumstances.

37 C.F.R. § 1.182 addresses only those situations not otherwise provided for in the regulations. Where a situation exists such that relief is specifically provided for elsewhere in the regulations, 37 C.F.R. § 1.182 is not, according to the terms of the regulation, the appropriate mechanism for relief. 37 C.F.R. § 1.951(a) provides for the entry of comments and amendment after an ACP during the 1 month time period set for response in the ACP, subject to the criteria of 37 C.F.R. § 1.116.

The July 19, 2010, patent owner petition is filed under 37 C.F.R. § 1.182 requesting entry of amendments and remarks submitted on the same date therewith. As of the time of filing the petition under 37 C.F.R. § 1.182, the Office had not yet rendered a decision on the entry of the submission under 37 C.F.R. § 1.951(a), under 37 C.F.R. § 1.181, or under any other applicable section. Since the Office has not denied entry of the submission, the request for continuation of prosecution fails “to seek entry of an amendment and/or evidence that was denied entry . . . after an action closing prosecution,” as required for the procedure set forth in the March 2005 Notice.

Furthermore, although it was filed under 37 C.F.R. § 1.182 to request entry of the July 19, 2010 amendment,, the July 19, 2010 patent owner petition has been filed within the time period set forth for response in the ACP. During this period, 37 C.F.R. § 1.951(a) specifically provides for the consideration of the comments and amendment, subject to the criteria of 37 C.F.R. § 1.116. Since patent owner’s submission may be addressed through 37 C.F.R. § 1.951, i.e., relief is still possible under one of the rules of practice, consideration of the present petition under 37 C.F.R. § 1.182 is premature.

For the instant petition to be proper for consideration and not premature, the instant petition must be filed (1) after the time for response under 37 C.F.R. § 1.951, (2) after entry of the amendment has been denied by the examiner in an action, and (3)(a) without a petition under 37 C.F.R. § 1.181 that could moot the petition under 37 C.F.R. § 1.182, or (3)(b) after within two months after such a petition is dismissed or denied, and the 37 C.F.R. § 1.181 is not further pursued (e.g., no request for reconsideration of the Office decision).

Even were all of these events to have occurred in the present instance, patent owner’s petition does not does not present reasons why the Office should act to delay the proceeding in spite of its statutory mandate to handle reexamination proceedings with special dispatch. Patent owner’s arguments, in the instant petition, are that the ACP included new arguments and citations for the first time, that these arguments cause the rejection to be improperly applied, and that the patent owner desires the opportunity to respond to these new arguments. The former argument is

addressable by a petition under § 1.181; the latter two arguments are addressed through the appeal process. None of these arguments addresses a “situation not provided for” as required by the plain language of § 1.182.²

Accordingly, the petition is **dismissed**.

CONCLUSION

1. The petition under 37 C.F.R. § 1.182 is dismissed.
2. Prosecution is not being reopened by this decision.
3. Telephone inquiries related to this decision should be directed to the undersigned at (571) 272-7700.

/Michael Cygan/

Michael Cygan
Legal Advisor
Office of Patent Legal Administration

October 6, 2010
Kenpet8

² A situation which is covered by § 1.181 does not become “not provided for” merely because the § 1.181 petition is dismissed or denied by the Office.



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FLACHSBART & GREENSPOON, LLC
333 N. MICHIGAN AVE.
27TH FLOOR
CHICAGO IL 60601

(For Patent Owner) **MAILED**

APR 08 2011

CENTRAL REEXAMINATION UNIT

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.
1100 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

(For Requester)

In re: Smith et alia
Reexamination Proceeding
Control No. 95/001,241
Request Deposited: October 2, 2009
For: U.S. Patent No. 7,355,990

:
: **DECISION**
: **DISMISSING**
: **PETITIONS**
:

The *inter partes* reexamination is before the Central Reexamination Unit to address the following papers:

- 1) The Patent Owner (PO) paper filed July 19, 2010 entitled "PETITION UNDER 37 CFR §1.181 TO WITHDRAW ACTION CLOSING PROSECUTION AS PREMATURE".
- 2) The PO paper filed July 19, 2010 entitled "PETITION UNDER 37 CFR §1.181 TO REOPEN PROSECUTION".

FINDINGS and DECISION

As these petitions address common issues, they are addressed together.

Regarding the anticipation rejection over Nokia I for the "translation module" limitation, the non-final office action cites page 14, lines 1-13, while the ACP cites page 14, lines 1-13 and 27-34). Petitioner argues that the additional lines cited in the ACP refer to a different embodiment. To the extent that such an argument goes to the merits of whether a single embodiment

Art Unit: 3992

anticipates the claims, this decision does not address the merits of the rejection because the merits of a rejection is subject to appeal to the Board of Patent Appeals and Interferences. To the extent that petitioner argues that this is essentially a new grounds of rejection, the Office disagrees. Lines 1-13 of page 14 do not refer to only an "indirect short message" embodiment while lines 27-34 refer only to a "direct short message" embodiment.

Petitioner argues that the Chen provisional application is newly cited and "[t]he [e]xaminer chose not to cite the Chen provisional application or provide any indication that the Chen patent was fully supported by the Chen provisional application." The Office disagrees. Since Chen would not be prior art if the provisional application did not provide support for the applied teachings, it is apparent in the record that the examiner considered the provisional application to fully support the teachings in both the non-final rejection and the ACP.

Petitioner further argues that essentially any additional comment supporting a rejection is a new ground of rejection without pointing to any specific language in the office actions. There is no new ground of rejection when the basic thrust of the rejection remains the same such that a patent owner has been given a fair opportunity to react to the rejection. Petitioner has not pointed to any language that they allege changes the basic thrust of the rejection (other than the misinterpretation of Nokia I discussed above).

CONCLUSION

1. The Patent Owner petitions listed above are dismissed.
2. Inquiries regarding this decision may be directed to Eric Keasel, Supervisory Patent Examiner, at (571) 272-4929.
3. This decision is not a final agency decision and is without prejudice to request reconsideration or higher-level review.



Irem Yucel
Director, Central Reexamination Unit



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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95/001,241

10/02/2009

7,355,990

2187.020REX0

5321

93344

7590

08/18/2011

EXAMINER

FLACHSBART & GREENSPOON, LLC

333 N. MICHIGAN AVE.

27TH FLOOR

CHICAGO, IL 60601

ART UNIT

PAPER NUMBER

DATE MAILED: 08/18/2011

Please find below and/or attached an Office communication concerning this application or proceeding.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

Inter partes
Sybase 365, Inc.
v.
TeleCommunication Systems, Inc.

Inter Partes Reexamination Control No. 95/001,241
Patent 7,355,990
Technology Center 3900

DECISION ON PETITION

This is a decision on “Patentee’s Petition under 37 C.F.R. § 1.183 to Waive Application of 37 C.F.R. § 1.943(c), to Allow Submission of an Oversized Appeal Brief,” filed July 12, 2011 (“Present Petition”). In the Present Petition, patent owner requests extension of the 14,000 word limit of 37 C.F.R. § 1.943(c), to permit entry of the accompanying appellant brief of 73 pages and about 20,013 words. The petition fee of \$400 in accordance with 37 C.F.R. § 1.17(f) was charged to petitioner’s credit card on July 13, 2011, as well as the fee for the appeal brief.

Inter Partes Reexamination Control No. 95/001,241
Patent No. 7,355,990

See 75 Fed. Reg. 50,750-51 (Aug. 17, 2010) for authority of the Chief Administrative Patent Judge.

FINDINGS

1. Third party requester filed a request for *inter partes* reexamination of U.S. Patent No. 7,355,990, on October 2, 2009, which was assigned control no. 95/001,241.
2. On November 10, 2009, reexamination was ordered and a non-final Office action was mailed, rejecting claims 1-28.
3. Patent owner filed a response to the non-final Office action on January 11, 2010, within the 50 page limit pursuant to 37 C.F.R. § 1.943(b), adding new claims 29-35.
4. Requester filed comments on February 4, 2010, accompanied by a petition to exceed the page limit.
5. Patent owner filed an opposition to the requester's petition on February 15, 2010. On the same date, patent owner also filed a petition requesting entry of a supplemental response in view of a new court decision.
6. The requester's petition was dismissed in a decision mailed May 7, 2010, therefore the comments of February 4, 2010, were not entered.
7. Patent owner's petition for entry of a supplemental response was granted in a decision mailed May 7, 2010; and the petition decision set forth that requester had 30 days from the mailing date of the petition decision to file comments in reply to patent owner's supplemental response pursuant to 37 C.F.R. § 1.947.
8. On June 19, 2010, an Action Closing Prosecution (ACP) was mailed, rejecting claims 1-3, 5-12, 14-21 and 23-35.

Inter Partes Reexamination Control No. 95/001,241
Patent No. 7,355,990

9. Patent owner filed a response to the ACP on July 19, 2010, within the 50 page limit pursuant to 37 C.F.R. § 1.943(b).
10. On April 1, 2011, a Right of Appeal Notice (RAN) was mailed, rejecting claims 1-3, 5-12, 14-21 and 23-35.
11. Patent owner filed a Notice of Appeal on April 29, 2011, appealing the rejections of claims 1-3, 5-12, 14-21 and 23-35.
12. Patent owner filed an appellant brief on July 12, 2011, accompanied by the Present Petition.

DISCUSSION

In the Present Petition, patent owner requests waiver of the limits of 37 C.F.R. § 1.943(c), which limits patent owner's appellant brief to thirty pages or 14,000 words in length. The patent owner's appellant brief of July 12, 2011, is stated to be 73 pages and about 20,013 words.

Patent owner requests extension of the limits for the following reasons:

1. The RAN incorporates by reference 93 pages of rejections from the ACP;
2. The RAN includes 3 anticipation rejections, and 24 obviousness rejections, including 7 prior art references;
3. A range of difficult issues is presented, e.g., claim interpretation in view of prior court interpretations, means-plus-function treatment, prior art compliance with enablement requirements, prior art entitlement to provisional application effective prior art dates;
4. Reducing the size of the appellant brief to 14,000 words would require omitting meaningful appeal arguments, and would prejudice the patentee's important property rights, as well as deprive the Board of a full context for understanding the various claimed inventions.

RELEVANT AUTHORITY

37 CFR § 1.183 provides:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, sua sponte, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 CFR § 1.943(c) provides:

Appellant's briefs filed by the patent owner and the third party requester shall not exceed thirty pages or 14,000 words in length, excluding appendices of claims and reference materials such as prior art references. All other briefs filed by any party shall not exceed fifteen pages in length or 7,000 words. If the page limit for any brief is exceeded, a certificate is required stating the number of words contained in the brief.

MPEP § 2667 I.A.2 (Response filed by Patent Owner that is too long) provides:

With respect to the length of the papers, the following additional information is to be noted. Similar to the Federal Rules of Appellate Procedure, the provisions of 37 CFR 1.943(c) are waived to the extent that the table of contents pages, the table of case law pages, and the pages of the claims (but not claim charts applying the art to the claims) are excluded from the thirty (30) page limit required by 37 CFR 1.943(c).

Any affidavit or declaration (or a clearly defined portion thereof) that contains opinion(s) of the affiant/declarant, or argument(s) that the art either does or does not anticipate or render obvious the claims, or specific claim elements, of the patent under reexamination, is considered to be part of the comments submitted by the patent owner, or by the third party requester, and is subject to the page limit requirements of 37 CFR 1.943. Affidavits or declarations that are excluded from the page limit requirements include, for example, declarations

attempting to swear behind (antedate) the filing date of a reference, or to establish the date of a printed publication, or declarations that provide comparative test data and an analysis of same. However, if the patent owner's affidavit or declaration includes any argument as to how an outstanding/proposed rejection is overcome, then the page(s) of the affidavit or declaration upon which the argument appears would be included against the page limit count. Likewise, if a third party requester affidavit or declaration includes any argument as to how a rejection is supported, then the page(s) of the affidavit or declaration upon which the argument appears would be included against the page limit count. Similarly, attached exhibits presenting data or drawings are not included against the page limit count, unless an exhibit or drawing includes argument as to how the outstanding rejection is overcome. Any page(s) of the exhibit or sheet(s) of drawings that include such argument would be included against the page limit count.

MPEP § 2667 I.B.2 (Response filed by Third Party Requester that is too long) provides:

For additional information with respect to the length of papers, see Subsection I.A.2 above.

ANALYSIS

Patent owner's Present Petition has been considered fully. The USPTO has the discretion to waive the applicable rules under 37 C.F.R. § 1.183 in an extraordinary situation when justice requires waiver. Upon review of the prosecution history of this proceeding, it is noted that the patent owner responses prior to appeal have been well within the page limit requirements. However, the appellant brief filed subsequent to appeal is significantly longer, whereas the rules require that the appellant brief be more limited than pre-appeal responses. Patent owner's appellant brief filed on July 12, 2011, is stated to be 73 pages and about 20,013 words, which far exceeds the limit of 30 pages and 14,000 words.

Inter Partes Reexamination Control No. 95/001,241
Patent No. 7,355,990

Petitioner's reasons provided in support of waiving the page/word limits focus on the RAN incorporating the ACP by reference, the multitude of rejections appealed, the numerous references applied, and the complexity of the issues on appeal. A review of the record reveals that the RAN contains 3 rejections under 35 U.S.C. § 102, and 24 rejections under 35 U.S.C. § 103 of 42 claims, over 7 references. The RAN refers to the prior art rejections set forth in detail in the ACP. All of patent owner's responses have been entered, whereas none of requester's comments have been entered. The patent owner was permitted to file a supplemental response to the non-final Office action, and requester was provided with an opportunity to file comments, but did not timely do so. The prosecution history reveals that the patent owner chose to present an additional 6 claims in their amendment in response to the non-final Office action, without canceling any of the original 28 patent claims. It is not surprising that Patent Owner is now challenged by the page and word limit, given that the number of claims being examined has increased from 28 to 35. The Patent Owner caused this challenge itself.

Prior to appeal, the Examiner included the rejections in the non-final Office action and the Action Closing Prosecution. These rejections were addressed in significantly fewer pages, i.e., 47 pages in patent owner's response of January 11, 2010, and 29 pages in patent owner's response of July 19, 2010, than in the appellant brief (73 pages). Since requester's comments were not entered, prosecution was simplified, because patent owner only needed to address the examiner's rejections. Patent owners' appellant brief contains arguments from page 9 through page 78. It is not evident how appellant has attempted to consolidate their arguments so as to comply with the page and word limit. In fact, petitioner states that appellant

Inter Partes Reexamination Control No. 95/001,241
Patent No. 7,355,990

considered reducing the size of the brief, but decided not to because it would require omitting meaningful appeal arguments, and would prejudice the patentee's important property rights, as well as deprive the Board of a full context for understanding the various claimed inventions to comply with the page/word limits.

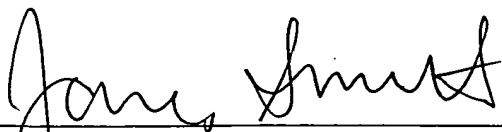
While these are all true, the Present Petition does not explain why these are extraordinary circumstances. The page/word limits are intentionally designed to focus the issues and require a concise presentation of arguments. In this specific case, a persuasive showing has not been made that this situation is extraordinary and that justice requires that more pages/words be allotted to appellant's brief. The present petition is **denied**, and the appellant brief of July 12, 2011, is not entered.

DECISION

Appellant is given one opportunity to file a corrected appellant brief in compliance with 37 C.F.R. § 1.943(c), within a non-extendable time period of 1 month from the mailing date of this decision. If a corrected appellant brief is not timely submitted, the appellant's appeal will be dismissed.

If a corrected appellant brief is timely received, then third party requester's respondent brief will be due pursuant to 37 C.F.R. § 41.66.

In view of the foregoing, the present petition is **DENIED**.



James Donald Smith
Chief Administrative Patent Judge

Inter Partes Reexamination Control No. 95/001,241
Patent No. 7,355,990

Counsel for Patent Owner:

Flachsbart & Greenspoon, LLC
333 N. Michigan Ave., 27th Floor
Chicago, IL 60601

Counsel for Third Party Requester

Sterne, Kessler, Goldstein & Fox, PLLC
1100 New York Ave, N.W.
Washington, D.C. 20005



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,245	10/13/2009	7148211	03851.000600.36	5540
5514	7590	04/13/2011	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 1290 Avenue of the Americas NEW YORK, NY 10104-3800			ART UNIT	PAPER NUMBER

DATE MAILED: 04/13/2011

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Inter Partes COBREK PHARMACEUTICALS, INC.

v.

GENZYME CORPORATION

Reexamination Control No. 95/001,245

Patent No. 7,148,211

Technology Center 3900

DECISION ON PETITION

This is a decision on the patent owner “Petition under 37 C.F.R. §1.182 to Strike Third Party Requester’s Response as Untimely Filed” of March 11, 2011 (“present petition”). Petitioner requests that the Board of Patent Appeals and Interferences strike the “Third Party Requester’s Response to Patent Owner’s Brief on Appeal . . .” filed on January 26, 2011, as untimely filed. The petition fee of \$400 pursuant to 37 C.F.R. §1.17(f) has been charged to petitioner’s credit card on March 11, 2011.

RELEVANT AUTHORITY

37 C.F.R. § 41.66 states:

(a) An appellant's brief must be filed no later than two months from the latest filing date of the last-filed notice of appeal or cross appeal or, if any party to the proceeding is entitled to file an appeal or cross appeal but fails to timely do so, no later than two months from the expiration of the time for filing (by the last party entitled to do so) such notice of appeal or cross appeal. The time for filing an appellant's brief or an amended appellant's brief may not be extended.

(b) Once an appellant's brief has been properly filed, any brief must be filed by respondent within one month from the date of service of the appellant's brief. The time for filing a respondent's brief or an amended respondent's brief may not be extended.

(c) The examiner will consider both the appellant's and respondent's briefs and may prepare an examiner's answer under § 41.69.

(d) Any appellant may file a rebuttal brief under § 41.71 within one month of the date of the examiner's answer. The time for filing a rebuttal brief or an amended rebuttal brief may not be extended.

(e) No further submission will be considered and any such submission will be treated in accordance with § 1.939 of this title.

ANALYSIS

A review of the record reveals that an appellant brief was filed using the Office's Electronic Filing System (eFS) on December 23, 2010, which included a certificate of service indicating that it was "served by Certified First Class Mail this 23rd day of December, 2010 to:

Robert S. Silver
CAESAR, RIVISE, BERNSTEIN, COHEN & POKOTILOW, LTD.
1635 Market Street, 11th Floor
Philadelphia, PA 19103"

Pursuant to 37 C.F.R. § 41.66(b), a respondent brief was due within one month of December 23, 2010. Since January 23, 2011, was a Sunday, the respondent brief was due by the next business day, i.e., Monday, January 24, 2011.


Inter Partes Reexamination Control No. 95/000,471
Patent No. 7,209,997

A review of the record reveals that the respondent brief was filed using the eFS on January 26, 2011. Therefore, the respondent brief was received two days late.

Accordingly, the present petition is **granted**. The respondent brief is not entered. Consequently, the request for oral hearing of requester of April 8, 2011, is denied, as a timely respondent brief was not received.

CONCLUSION

The present petition is GRANTED.



James T. Moore
Acting Chief Administrative Judge

COUNSEL FOR PATENT OWNER:

FITZPATRICK CELLA HARPER & SCINTO
1290 Avenue of the Americas
New York, NY 10104-3800

COUNSEL FOR THIRD PARTY REQUESTER:

Robert S. Silver
CAESAR, RIVISE, BERNSTEIN, COHEN & POKOTILOW, LTD.
1635 Market Street, 11th Floor
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,245	10/13/2009	7148211	03851.000600.36	5540
5514	7590	04/22/2011	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 1290 Avenue of the Americas NEW YORK, NY 10104-3800				
			ART UNIT	PAPER NUMBER

DATE MAILED: 04/22/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Date: 4-22-11

Robert S. Silver

CAESAR, RIVISE, BERSTEIN, COHEN & POKOLTILOW, LTD.

1635 Market Street, 11th Floor

Philadelphia, PA 19103-2212

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001245

PATENT NO. : 7148211

TECHNOLOGY CENTER : 3999

ART UNIT : 3991

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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APR 22 2011

CENTRAL REEXAMINATION UNIT

FITZPATRICK CELLA HARPER & SCINTO
1290 Avenue of the Americas
New York, NY 10104-3800

(For Patent Owner)

Robert S. Silver
CAESAR, RIVISE, BERNSTEIN, COHEN
& POKOTILOW, LTD.
1635 Market Street, 1 lth Floor
Philadelphia, PA 19103

(For Third Party Requester)

In re Mazess et al.
Reexamination Proceeding
Control No. : 95/001,245
Filed: October 13, 2009
Patent No. 7,148,211

: **DECISION**
: **DISMISSING**
: **PATENT OWNER'S**
: **PETITION**
: **UNDER 37 CFR 1.181**

The above reexamination proceeding is before the Director of Technology Center 1600, who oversees the Central Reexamination Unit, after receipt of a March 11, 2011 patent owner petition, entitled "Petition under 37 C.F.R. § 1.181 for a Fully Responsive Examiner's Answer." The petition is requesting that the Examiner's Answer of February 11, 2011 be withdrawn and a new Examiner's Answer be issued in the proceeding record.

The patent owner's petition is dismissed as moot for the reasons expressed below.

STATEMENT OF FACTS RELEVANT TO THE DECISION

1. Patent No. 7,148,211 (the '211 patent) issued on December 12, 2006.
2. A request for reexamination, assigned Control No. 95/001,245 (the '245 proceeding), was filed by a third party Requester on October 13, 2009.
3. Reexamination was ordered in the '245 reexamination proceeding on November 25, 2009. On the same day, an Office action on the merits was mailed.
4. Prosecution advanced and on October 12, 2010, the patent owner filed a notice of appeal.
5. On December 23, 2010, the patent owner filed their appellant brief.
6. On January 26, 2011, the third party requester filed their respondent brief.
7. On February 11, 2011, the Office mailed an Examiner's Answer.
8. On March 11, 2011, the patent owner filed the instant petition under 37 CFR 1.181, and a petition under 37 CFR 1.182 to expunge the third party requester's respondent brief as untimely filed.
9. On April 13, 2011, the Board of Patent Appeals and Interferences (BPAI) mailed a decision granting patent owner's petition under 37 CFR 1.182 and expunging the third party requester's respondent brief from the proceeding record.

DECISION

As pointed out, the patent owner filed a March 11, 2011 petition under 37 CFR 1.181 requesting withdrawal of the February 11, 2011 Examiner's Answer and issuance of a new Examiner's Answer in the proceeding record. Patent owner alleges that the February 11, 2011 Examiner's Answer was not complete because it failed to particularly address new issues raised by the patent owner in their appellant brief.

The February 11, 2011 Examiner's Answer utilized form PTOL-2291, in accordance with policy set forth in a memorandum entitled "Streamline Procedure for Appeal Brief Review and Examiner's Answer in *Inter Partes* Reexamination Proceedings," dated August 17, 2010 (available at http://www.uspto.gov/patents/law/exam/appealbrief_ip_reexam_17aug2010.pdf). This memorandum requires examiners to use form PTOL-2291 for the Examiner's Answer when at least two adverse parties filed appeal briefs in an *inter partes* reexamination proceeding.

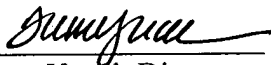
On April 13, 2011, BPAI mailed a decision granting patent owner's petition under 37 CFR 1.182. This decision expunged the third party requester's respondent brief from the proceeding record because the respondent brief was determined to be untimely filed. As a result of the expungement of the third party requester's respondent brief, the appeal no longer has at least two

adverse parties. Therefore, use of form PTOL-2291 for an Examiner's Answer is not required or permitted. Accordingly, for this reason, the Examiner's Answer of February 11, 2011 is hereby vacated.

Therefore, the relief requested by the March 11, 2011 petition is given as a result of the April 13, 2011 BPAI decision. Thus, the patent owner's March 11, 2011 petition is moot, and hereby, dismissed.

CONCLUSION

1. The March 11, 2011 patent owner's petition is dismissed as moot.
2. The Examiner's Answer of February 11, 2011 is hereby vacated as a result of the April 13, 2011 BPAI decision that expunged the third party requester's respondent brief.
3. The proceeding will be forwarded to the examiner for appropriate action in due course.
4. Telephone inquiries related to this decision should be directed Deborah Jones, Supervisory Patent Examiner, at (571) 272-1535.


Irem Yucel, Director
Technology Center 1600



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,245	10/13/2009	7148211	03851.000600.36	5540
5514	7590	04/28/2011	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 1290 Avenue of the Americas NEW YORK, NY 10104-3800			ART UNIT	PAPER NUMBER

DATE MAILED: 04/28/2011

Please find below and/or attached an Office communication concerning this application or proceeding.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Inter Partes COBREK PHARMACEUTICALS, INC.

v.

GENZYME CORPORATION

Reexamination Control No. 95/001,245

Patent No. 7,148,211

Technology Center 3900

DECISION ON PETITION

This is a decision on the requester's "Petition under 37 C.F.R. § 1.182 to Consider Third Party Requester's Respondent Brief . . ." of April 19, 2011 ("present petition"). Petitioner requests that the Board of Patent Appeals and Interferences consider the requester's respondent brief filed on January 26, 2011, and the request for oral hearing of April 8, 2011. The petition fee of \$400 pursuant to 37 C.F.R. §1.17(f) has been charged to petitioner's deposit account on April 19, 2011.

FINDINGS

1. U.S. Patent No. 7,148,211 issued on December 12, 2006.
2. A request for *inter partes* reexamination of the '211 patent was filed by a third party requester on October 13, 2009, and was assigned Control No. 95/001,245.
3. On November 25, 2009, reexamination was ordered and a non-final Office action was mailed.
4. Prosecution was conducted and on September 10, 2010, a Right of Appeal Notice (RAN) was mailed.
5. Patent owner filed a Notice of Appeal on October 12, 2010, and an appellant brief on December 23, 2010.
6. Requester filed a respondent brief on January 26, 2011.
7. On February 11, 2011, an Examiner's Answer was mailed.
8. On March 11, 2011, the patent owner filed a petition under 37 C.F.R. § 1.181 requesting a fully responsive examiner's answer, and a petition under 37 C.F.R. § 1.182 to expunge the third party requester's respondent brief as untimely filed.
9. On April 13, 2011, the Board of Patent Appeals and Interferences (BPAI) mailed a decision granting patent owner's petition under 37 C.F.R. § 1.182.
10. Requester filed the present petition on April 19, 2011.
11. On April 22, 2011, the Central Reexamination Unit (CRU) mailed a decision dismissing the patent owner's petition under 37 C.F.R. § 1.181, but granting the relief requested of a fully responsive examiner's answer.

RELEVANT AUTHORITY

35 U.S.C. 314(b)(2) provides that:

Each time that the patent owner files a response to an action on the merits from the Patent and Trademark Office, the third-party requester shall have one opportunity to file written comments addressing issues raised by the action of the Office or the patent owner's response thereto, if those written comments are received by the Office within 30 days after the date of service of the patent owner's response.

37 C.F.R. § 1.947 states in pertinent part that:

Each time the patent owner files a response to an Office action on the merits pursuant to § 1.945, a third party requester may once file written comments within a period of 30 days from the date of service of the patent owner's response. These comments shall be limited to issues raised by the Office action or the patent owner's response. The time for submitting comments by the third party requester may not be extended. (Emphasis added)

37 C.F.R. § 1.957(a) states:

If the third party requester files an untimely or inappropriate comment, notice of appeal or brief in an inter partes reexamination, the paper will be refused consideration.

37 C.F.R. § 41.66(b) states:

(b) Once an appellant's brief has been properly filed, any brief must be filed by respondent within one month from the date of service of the appellant's brief. The time for filing a respondent's brief or an amended respondent's brief may not be extended.

37 C.F.R. § 41.68(a)(1) states:

Respondent(s) in an appeal may once, within the time limit for filing set forth in § 41.66, file a respondent brief and serve the brief on all parties in accordance with § 1.903 of this title.

ANALYSIS

A review of the record reveals that an appellant's brief was filed on December 23, 2010, and included a certificate of service indicating that it was "served by Certified First Class Mail this 23rd day of December, 2010 to:

Inter Partes Reexamination Control No. 95/001,245
Patent No. 7,148,211

Robert S. Silver
CAESAR, RIVISE, BERNSTEIN, COHEN & POKOTILOW, LTD.
1635 Market Street, 11th Floor
Philadelphia, PA 19103”

Pursuant to both 35 U.S.C. 314(b)(2) and 37 C.F.R. § 41.66(b), a respondent’s brief was due within one month of December 23, 2010. Since January 23, 2011, was a Sunday, the respondent’s brief was due by the next business day, *i.e.*, Monday, January 24, 2011. A review of the record reveals that the respondent brief was filed on January 26, 2011. Therefore, the respondent brief was received two days after the statutory deadline.

Petitioner states that the respondent brief was unintentionally filed late due to a docketing error, and that the due date for the respondent brief was docketed as January 28, 2011, as shown on the docketing report attached as Exhibit A. While these facts are accepted as true, petitioner’s arguments cannot overcome the statutory deadline. Moreover, the time for filing a respondent’s brief may not be extended per 37 C.F.R. § 41.66(b). Pursuant to 37 C.F.R. § 1.957(a), if a requester files an untimely brief, it will be refused consideration.

Petitioner asserts that the respondent brief has already been considered by the Office in the Examiner’s Answer of February 11, 2011, therefore there is no prejudice to the Patent Office to consider the respondent brief. Petitioner also contends that there is no prejudice to the Patent Owner for the Patent Office to consider the respondent brief as patent owner has been afforded the opportunity to respond to all the issues raised in the Right of Appeal Notice, the respondent brief and the examiner’s answer in its rebuttal brief. None of these contentions can overcome the statutory requirement that the brief be filed within 30 days.

Petitioner further alleges that the Director has the authority to extend the time for requester comments as set forth in MPEP 2666.06. Therefore, petitioner

purports that granting this petition would not require suspension of the rules under 37 C.F.R. § 1.183, since the Director already has the authority to extend the time for requester to submit comments. As noted above, the timeliness requirements are clearly set forth in the statute, which cannot be waived by a regulation. Petitioner relies on MPEP 2666.06, but the MPEP cannot overcome a statutory requirement.

Accordingly, the present petition is **denied**. The respondent brief remains not entered. Consequently, the request for oral hearing of requester of April 8, 2011, remains denied, as a timely respondent brief was not received.

CONCLUSION

The present petition is DENIED.



James T. Moore
Acting Chief Administrative Judge

COUNSEL FOR PATENT OWNER:

FITZPATRICK CELLA HARPER & SCINTO
1290 Avenue of the Americas
New York, NY 10104-3800

COUNSEL FOR THIRD PARTY REQUESTER:

Robert S. Silver
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,245	10/13/2009	7148211	03851.000600.36	5540
5514 7590 05/31/2011 FITZPATRICK CELLA HARPER & SCINTO 1290 Avenue of the Americas NEW YORK, NY 10104-3800			EXAMINER HUANG, EVELYN MEI	
			ART UNIT 3991	PAPER NUMBER
			MAIL DATE 05/31/2011	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Inter Partes COBREK PHARMACEUTICALS, INC.

v.

GENZYME CORPORATION

Reexamination Control No. 95/001,245

Patent No. 7,148,211

Technology Center 3900

DECISION ON PETITION

This is a decision on the requester's "Request for Reconsideration of the Decision on the Petition under 37 C.F.R. § 1.182 to Consider Third Party Requester's Respondent Brief . . ." of May 13, 2011 ("Petition #1"). Petitioner requests reconsideration of the Decision on Petition of April 28, 2011. Petitioner seeks entry and consideration of the requester's respondent brief filed on January 26, 2011, and the request for oral hearing of April 8, 2011. The petition fee of \$400 pursuant to 37 C.F.R. § 1.17(f) has been charged to petitioner's deposit account on May 13, 2011.

This is also a decision on the requester's "Petition under 37 C.F.R. § 1.183 to Set Aside Rule 41.66(b) and Consider Third Party Requester's Respondent Brief . . ." of May 13, 2011 ("Petition #2"). Petitioner requests waiver of 37 C.F.R. § 41.66(b) in order to consider the requester's respondent brief filed on January 26, 2011, and the request for oral hearing of April 8, 2011. The petition fee of \$400 pursuant to 37 C.F.R. § 1.17(f) has been charged to petitioner's deposit account on May 13, 2011.

FINDINGS

1. U.S. Patent No. 7,148,211 issued on December 12, 2006.
2. A request for *inter partes* reexamination of the '211 patent was filed by a third party requester on October 13, 2009, and was assigned Control No. 95/001,245.
3. On November 25, 2009, reexamination was ordered and a non-final Office action was mailed.
4. Prosecution was conducted and on September 10, 2010, a Right of Appeal Notice (RAN) was mailed.
5. Patent owner filed a Notice of Appeal on October 12, 2010, and an appellant brief on December 23, 2010.
6. Requester filed a respondent brief on January 26, 2011.
7. On February 11, 2011, an Examiner's Answer was mailed.
8. On March 11, 2011, the patent owner filed a petition under 37 C.F.R. § 1.181 requesting a fully responsive examiner's answer, and a petition under 37 C.F.R. § 1.182 to expunge the third party requester's respondent brief as untimely filed.

9. On April 13, 2011, the Board of Patent Appeals and Interferences (BPAI) mailed a decision granting patent owner's petition under 37 C.F.R. § 1.182.

10. Requester filed a petition under 37 C.F.R. § 1.182 requesting consideration of the respondent brief of January 26, 2011, on April 19, 2011.

11. On April 22, 2011, the Central Reexamination Unit (CRU) mailed a decision dismissing the patent owner's petition under 37 C.F.R. § 1.181, but granting the relief requested of a fully responsive examiner's answer.

12. On April 28, 2011, a decision denying the petition under 37 C.F.R. § 1.182 requesting consideration of the respondent brief was mailed.

13. Petition #1 and Petition #2 were filed on May 13, 2011.

RELEVANT AUTHORITY

35 U.S.C. 314(b)(2) provides that:

Each time that the patent owner files a response to an action on the merits from the Patent and Trademark Office, the third-party requester shall have one opportunity to file written comments addressing issues raised by the action of the Office or the patent owner's response thereto, if those written comments are received by the Office within 30 days after the date of service of the patent owner's response.

37 C.F.R. § 1.182 states:

All situations not specifically provided for in the regulations of this part will be decided in accordance with the merits of each situation by or under the authority of the Director, subject to such other requirements as may be imposed, and such decision will be communicated to the interested parties in writing. Any petition seeking a decision under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 C.F.R. § 1.183 states:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 C.F.R. § 1.947 states in pertinent part that:

Each time the patent owner files a response to an Office action on the merits pursuant to § 1.945, a third party requester may once file written comments within a period of 30 days from the date of service of the patent owner's response. These comments shall be limited to issues raised by the Office action or the patent owner's response. The time for submitting comments by the third party requester may not be extended. (Emphasis added)

37 C.F.R. § 1.957(a) states:

If the third party requester files an untimely or inappropriate comment, notice of appeal or brief in an inter partes reexamination, the paper will be refused consideration.

37 C.F.R. § 41.66(b) states:

(b) Once an appellant's brief has been properly filed, any brief must be filed by respondent within one month from the date of service of the appellant's brief. The time for filing a respondent's brief or an amended respondent's brief may not be extended.

37 C.F.R. § 41.68(a)(1) states:

Respondent(s) in an appeal may once, within the time limit for filing set forth in § 41.66, file a respondent brief and serve the brief on all parties in accordance with § 1.903 of this title.

ANALYSIS

A review of the record reveals that an appellant's brief was filed on December 23, 2010, and included a certificate of service on the same date. Pursuant to 37 C.F.R. § 41.66(b), a respondent brief was due within one month of December 23, 2010. The respondent brief was filed on January 26, 2011, two days after the deadline. Pursuant to 37 C.F.R. § 1.957(a), the respondent brief has been refused consideration.

In Petition #1, petitioner requests reconsideration of the decision denying the petition of April 28, 2011. Petitioner seeks entry and consideration of the requester's respondent brief filed on January 26, 2011, and the request for oral hearing of April 8, 2011. Petitioner states that the respondent brief was unintentionally filed late due to a docketing error, and that the delay in filing the

brief was inadvertent. Petitioner contends that the deadline is a non-statutory deadline, and that the USPTO has the discretion to extend it.

Petitioner's arguments have been considered fully. Upon reconsideration, it is agreed that the deadline for filing a respondent brief is set by the regulations, and not 35 U.S.C. 314(b)(2). The USPTO has the discretion to waive the applicable rules under 37 C.F.R. § 1.183 in an extraordinary situation when justice requires waiver. However, pursuant to 37 C.F.R. § 1.957(a) and § 41.66(b), if a requester's respondent brief is filed more than one month after the date of filing of patent owner's appellant brief, the untimely filed respondent brief "will be refused consideration." Because the instant situation is provided for expressly in the regulations, relief under 37 C.F.R. § 1.182 is inapplicable. Therefore, petition #1 is **granted** to the extent that the petition decision of April 28, 2011, has been reconsidered, but **denied** as to the requested relief of entry and consideration of the requester's respondent brief and the request for oral hearing.

In Petition #2, petitioner requests the waiver of 37 C.F.R. § 41.66(b) under 37 C.F.R. § 1.183, in order to consider the respondent brief of January 26, 2011, and to grant the request for oral hearing of April 8, 2011. Petitioner argues that this is an extraordinary situation and justice requires suspension of the rules, because the respondent brief was filed late due to a docketing error. Petitioner asserts that counsel was justified in relying on the docketing system because the docketing system is highly reliable. Petitioner contends that the unavoidable delay should not attenuate requester's right to participate in the *inter partes* reexamination. Petitioner points out that the Office already had considered the respondent brief and that there would be no prejudice to patent owner.

It should be noted that the examiner's answer was vacated in a petition decision mailed by the Central Reexamination Unit (CRU) on April 22, 2011.

Petitioner's support for establishing that an extraordinary situation exists is based upon docketing records that show that requester's law firm has a docketing system that is not reliable for *inter partes* reexamination proceedings. A review of the evidence presented in the petition reveals that the docketing system utilized does not provide auto-triggering of deadlines for *inter partes* reexamination proceedings, and instead requires manual insertion of the deadlines. The evidence shows that a mistake in either calculating and/or entering the due date for the requester's respondent brief is the cause of the docketing error. The evidence is silent as to whether or not there are any safety procedures in place for double-checking the due dates to make sure that a deadline is calculated correctly and correctly entered.

Accurate calculation is critical to filing timely responses. Utilizing a docketing system that fails to calculate the correct due date may not be prudent, and may not demonstrate that due care is being taken, but it is not an "extraordinary situation." The docketing error caused the untimely filing of a respondent brief. It is unfortunate that the consequence of such docketing error is that it adversely impacts requester's ability to further participate in the *inter partes* reexamination. To purport that a docketing system that can calculate incorrect due dates (and did so here) for *inter partes* reexamination is "highly reliable" is not well-founded.

Petitioner has provided no showing of an extraordinary situation when justice requires waiver of 37 C.F.R. § 41.66(b).

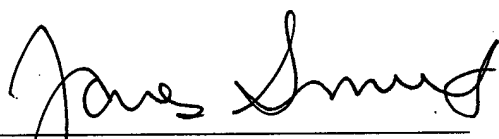
Petition #1 is **denied**.

Petition #2 is **denied**.

The respondent brief remains not entered. Consequently, the request for oral hearing of requester of April 8, 2011, remains denied, as a timely respondent brief was not received.

CONCLUSION

Petition #1 and Petition #2 are DENIED.



James Donald Smith
Chief Administrative Judge

COUNSEL FOR PATENT OWNER:

FITZPATRICK CELLA HARPER & SCINTO
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COUNSEL FOR THIRD PARTY REQUESTER:

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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5514	7590	07/13/2011	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 1290 Avenue of the Americas NEW YORK, NY 10104-3800			ART UNIT	PAPER NUMBER

DATE MAILED: 07/13/2011

Please find below and/or attached an Office communication concerning this application or proceeding.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Inter Partes COBREK PHARMACEUTICALS, INC.

v.

GENZYME CORPORATION

Reexamination Control No. 95/001,245

Patent No. 7,148,211

Technology Center 3900

DECISION ON PETITION

This is a decision on the requester's "Petition to the Director under 37 C.F.R. § 1.181 in *Inter Partes* Reexamination of U.S. Patent No. 7,148,211" of June 10, 2011 ("present petition"). Petitioner requests reconsideration of the decision of May 31, 2011, that denied requester's petition under 37 C.F.R. § 1.183 of May 13, 2011. Petitioner requests entry and consideration of the requester's respondent brief filed on January 26, 2011, and the request for oral hearing of

See 75 Fed. Reg. 50,750-51 (Aug. 17, 2010) for authority of the Chief Administrative Patent Judge.

Inter Partes Reexamination Control No. 95/001,245
Patent No. 7,148,211

April 8, 2011. The petition fee of \$400 pursuant to 37 C.F.R. §1.17(f) has been charged to petitioner's deposit account on June 10, 2011.

FINDINGS

1. U.S. Patent No. 7,148,211 issued on December 12, 2006.
2. A request for *inter partes* reexamination of the '211 patent was filed by a third party requester on October 13, 2009, and was assigned Control No. 95/001,245.
3. On November 25, 2009, reexamination was ordered and a non-final Office action was mailed.
4. Prosecution was conducted and on September 10, 2010, a Right of Appeal Notice (RAN) was mailed.
5. Patent owner filed a Notice of Appeal on October 12, 2010, and an appellant brief on December 23, 2010.
6. Requester filed a respondent brief on January 26, 2011.
7. On February 11, 2011, an Examiner's Answer was mailed.
8. On March 11, 2011, the patent owner filed a rebuttal brief.
9. On the same date, the patent owner filed a petition under 37 C.F.R. § 1.181 requesting a fully responsive examiner's answer, and a petition under 37 C.F.R. § 1.182 to expunge the third party requester's respondent brief as untimely filed.
10. On April 13, 2011, the Board of Patent Appeals and Interferences (BPAI) mailed a decision granting patent owner's petition under 37 C.F.R. § 1.182.

11. Requester filed a petition under 37 C.F.R. § 1.182 on April 19, 2011, requesting entry and consideration of the untimely third party requester's respondent brief.

12. On April 22, 2011, the Central Reexamination Unit (CRU) mailed a decision dismissing the patent owner's petition under 37 C.F.R. § 1.181 of March 11, 2011, but granting the relief requested of a fully responsive examiner's answer.

13. On April 28, 2011, a decision denying the petition under 37 C.F.R. § 1.182 requesting consideration of the respondent brief was mailed.

14. Two petitions were filed by requester on May 13, 2011, under 37 C.F.R. § 1.182 and § 1.183, both requesting the relief of entry and consideration of the untimely respondent brief.

15. On May 31, 2011, a decision denying both of the petitions of May 13, 2011, was mailed.

16. The present petition was filed on June 10, 2011.

RELEVANT AUTHORITY

37 C.F.R. § 1.181 states:

(a) Petition may be taken to the Director:

(1) From any action or requirement of any examiner in the *ex parte* prosecution of an application, or in *ex parte* or *inter partes* prosecution of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court;

(2) In cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Director; and

(3) To invoke the supervisory authority of the Director in appropriate circumstances. For petitions involving action of the Board of Patent Appeals and Interferences, see § 41.3 of this title.

(b) Any such petition must contain a statement of the facts involved and the point or points to be reviewed and the action requested. Briefs or memoranda, if any, in support thereof should accompany or

be embodied in the petition; and where facts are to be proven, the proof in the form of affidavits or declarations (and exhibits, if any) must accompany the petition.

(c) When a petition is taken from an action or requirement of an examiner in the ex parte prosecution of an application, or in the ex parte or inter partes prosecution of a reexamination proceeding, it may be required that there have been a proper request for reconsideration (§ 1.111) and a repeated action by the examiner. The examiner may be directed by the Director to furnish a written statement, within a specified time, setting forth the reasons for his or her decision upon the matters averred in the petition, supplying a copy to the petitioner.

(d) Where a fee is required for a petition to the Director the appropriate section of this part will so indicate. If any required fee does not accompany the petition, the petition will be dismissed.

(e) Oral hearing will not be granted except when considered necessary by the Director.

(f) The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings. Any petition under this part not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided. This two-month period is not extendable.

(g) The Director may delegate to appropriate Patent and Trademark Office officials the determination of petitions.

37 C.F.R. § 1.957(a) states:

If the third party requester files an untimely or inappropriate comment, notice of appeal or brief in an inter partes reexamination, the paper will be refused consideration.

37 C.F.R. § 41.66(b) states:

(b) Once an appellant's brief has been properly filed, any brief must be filed by respondent within one month from the date of service of the appellant's brief. The time for filing a respondent's brief or an amended respondent's brief may not be extended.

37 C.F.R. § 41.68(a)(1) states:

Respondent(s) in an appeal may once, within the time limit for filing set forth in § 41.66, file a respondent brief and serve the brief on all parties in accordance with § 1.903 of this title.

ANALYSIS

A review of the record reveals that an appellant's brief was filed on December 23, 2010, and included a certificate of service on the same date. Pursuant to 37 C.F.R. § 41.66(b), a respondent brief was due within one month of December 23, 2010. The respondent brief was filed on January 26, 2011, two days after the deadline. Pursuant to 37 C.F.R. § 1.957(a), the respondent brief has been refused consideration.

In the present petition, petitioner requests reconsideration of the decision denying the petition under 37 C.F.R. § 1.183 of May 13, 2011. Petitioner again seeks entry and consideration of the requester's respondent brief filed on January 26, 2011, and the request for oral hearing of April 8, 2011. Petitioner asserts that the § 1.183 petition of May 13, 2011, established extraordinary circumstances, and that justice requires granting the petition. Petitioner states that this situation is extraordinary because, while the respondent brief was filed late due to a docketing error, this mere two-day delay has been interpreted by the Office as attenuating requester's ability to participate in this *inter partes* reexamination. Petitioner purports that it was shown in the previous petition that counsel was justified in relying on the docketing system because the docketing system is highly reliable and thus the error is itself extraordinary. Petitioner urges that this extraordinary, unavoidable delay should not serve as the basis for attenuating requester's right to participate.

Petitioner's arguments have been considered fully. The USPTO has the discretion to waive the applicable rules under 37 C.F.R. § 1.183 in an extraordinary situation when justice requires waiver. However, pursuant to 37 C.F.R. § 1.957(a) and § 41.66(b), if a requester's respondent brief is filed more than one month after

the date of filing of patent owner's appellant brief, the untimely filed respondent brief "will be refused consideration." Therefore, the refusal to enter the untimely respondent brief is an expected result of an untimely filing that is set forth clearly in the regulations.

Petitioner purports that the declaration by the docket manager provided with the previous petition established that the entire delay in filing the respondent brief from the due date for the brief until January 26, 2011, was unavoidable and extraordinary. Petitioner asserts that further evidence was provided of the reliability of the docketing system, which demonstrated it was reliable for other *inter partes* reexaminations. This contention actually is not supported, because as the declaration states, the docketing system is reliable for applications where due dates are auto-triggered by the system. A review of the evidence presented in the previous petition reveals that the docketing system utilized does not provide auto-triggering of deadlines for *inter partes* reexamination proceedings, and instead requires manual insertion of the deadlines. Petitioner's support for establishing unavoidable delay and that an extraordinary situation exists is based upon docketing records that show that requester's law firm has a docketing system that is not reliable for *inter partes* reexamination proceedings, as explained in the decision denying the previous petition. The evidence shows that a mistake in either calculating and/or entering the due date for the requester's respondent brief is the cause of the docketing error.

Petitioner indicates that there are safety procedures in place, *i.e.*, the attorneys at Caesar Rivise are responsible for double-checking the docketing dates. Petitioner explains that in the instant *inter partes* reexamination, these safety measures failed because the attorney did not realize that an incorrect triggering date was used. Such explanation implies that the failure of the safety measures

may be due to the attorney either not knowing or not understanding what he/she is supposed to be checking for with regard to docketing dates. The petition is silent as to what procedures have been put into place to avoid any reoccurrence of such a docketing system failure, and safety measure failure, with regard to *inter partes* reexamination proceedings.

It is emphasized, again, that accurate calculation is critical to filing timely responses. Utilizing a docketing system that fails to calculate the correct due date may not be prudent, and may not demonstrate that due care is being taken, but it is not an "extraordinary situation." The docketing error caused the untimely filing of a respondent brief. To purport that a docketing system that can calculate incorrect due dates (and did so here) for *inter partes* reexamination is "highly reliable" is not well-founded.

Petitioner contends that the unavoidable delay should not attenuate requester's right to participate in the *inter partes* reexamination. Petitioner asserts that there is no prejudice to patent owner because, among other things, the respondent brief basically only reiterated what respondent explained several times previously as to why the claims of this patent were invalid. While it is unfortunate that the consequence of such docketing error is that it adversely impacts requester's ability to further participate in the *inter partes* reexamination, petitioner admits that the arguments presented in the respondent brief are already of record in the *inter partes* reexamination.

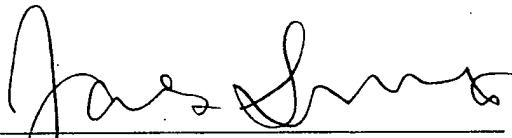
Petitioner urges that the Patent Office should find that justice requires consideration of requester's respondent brief because "[t]here is a significant public policy interest in removing invalid patents from the public arena." It is noted that the claims stand rejected. Petitioner indicates that the public policy interest here is that doxercalciferol injection is a drug used only to treat dialysis patients, and the patent owner is currently the only seller of doxercalciferol

injection. While these facts are accepted as true, petitioner has provided no showing of an extraordinary situation when justice requires waiver of 37 C.F.R. § 41.66(b), and in any event, the respondent itself has convincingly shown that the brief sought to be entered merely is duplicative.

Accordingly, the present petition is **denied**. The respondent brief remains not entered. Consequently, the request for oral hearing of requester of April 8, 2011, remains denied, as a timely respondent brief was not received.

CONCLUSION

The present petition is DENIED.



James Donald Smith
Chief Administrative Judge

COUNSEL FOR PATENT OWNER:

FITZPATRICK CELLA HARPER & SCINTO
1290 Avenue of the Americas
New York, NY 10104-3800

COUNSEL FOR THIRD PARTY REQUESTER:

Robert S. Silver
CAESAR, RIVISE, BERNSTEIN, COHEN & POKOTILOW, LTD.
1635 Market Street, 11th Floor
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,246	10/13/2009	7416848	105575-0006-501	6125
45821	7590	12/17/2010	EXAMINER	
JONES DAY 222 EAST 41ST ST NEW YORK, NY 10017			ART UNIT	PAPER NUMBER

DATE MAILED: 12/17/2010

Please find below and/or attached an Office communication concerning this application or proceeding.



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,246	10/13/2009	7416848	105575-0006-501	6125
45821	7590	12/17/2010	EXAMINER	
LUNDBECK RESEARCH USA, INC. ATTENTION: STEPHEN G. KALINCHAK, LEGAL 215 COLLEGE ROAD PARAMUS, NJ 07652			ART UNIT	PAPER NUMBER

DATE MAILED: 12/17/2010

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

James F. Haley, Jr.
ROPES & GRAY LLP, PATENT DOCKETING 39/361
1211 Avenue of the Americas
New York, NY 10036-8704

Date:

MAILED

DEC 17 2010

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001246
PATENT NO. : 7416848
TECHNOLOGY CENTER : 3999
ART UNIT : 3991

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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LUNDBECK RESEARCH USA, INC.
ATTN: STEPHEN G. KALINCHAK, LEGAL
215 COLLEGE ROAD
PARAMUS, NJ 07652

(For Patent Owner)

MAILED

DEC 17 2010

CENTRAL REEXAMINATION UNIT

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222 EAST 41 ST
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(Courtesy Copy)

James F. Haley, Jr.
ROPES & GRAY LLP
PATENT DOCKETING 39/361
1211 AVENUE OF THE AMERICAS
NEW YORK, NY 10036-8704

(For Third Party Requester)

In re Bonini et al.
Reexamination Proceeding
Control No.: 95/001,246
Filing Date: October 13, 2009
For: U.S. Patent No.: 7,416,848

:
: DECISION
: DISMISSING
: PETITION
:

The above reexamination proceeding is before the Director of Technology Center 1600, who oversees the Central Reexamination Unit, after receipt of a June 7, 2010 patent owner petition, entitled "Petition under 35 C.F.R. § 1.182" requesting expungement of the April 7, 2010 comments. The petition is treated as a petition under 37 CFR 1.181. This decision also addresses the third party requester's June 16, 2010 opposition to the June 7, 2010 petition

The patent owner's petition and the third party requester's opposition are dismissed as moot.

BACKGROUND

1. U.S. Patent No. 7,416,848 [hereinafter “the ‘848 patent”] was granted to *Bonini et al.* on August 26, 2008.
2. On October 13, 2009, a request for *inter partes* reexamination of the ‘848 patent was filed by a third party requester. The resulting reexamination proceeding was assigned control number 95/001,246 (the ‘1246 proceeding).
3. On January 8, 2010, the Office issued an order granting *inter partes* reexamination in the ‘1246 proceeding, with an accompanying Office action on the merits.
4. On March 8, 2010, a revocation of the power of attorney with an appointment of a new power of attorney and a response to the Office action were filed in the ‘1246 proceeding.
5. On April 7, 2010, the third party requester filed comments.
6. On June 7, 2010, the patent owner filed a paper entitled “Petition under 37 C.F.R. § 1.182” requesting expungement of the April 7, 2010 comments. This petition is being treated as a petition under 37 CFR 1.181 invoking supervisory review.
7. On June 16, 2010, the third party requester filed a paper entitled “Third-Party Requester Opposition to Patent Owner Petition under 37 C.F.R. § 1.182.”
8. On June 24, 2010, the Office mailed a decision *sua sponte* returning third party comments dated April 7, 2010. On the same day, the Office mailed notices entitled “NOTICE REGARDING CHANGE OF POWER OF ATTORNEY” and “NOTICE OF ACCEPTANCE OF POWER OF ATTORNEY.”
9. On July 14, 2010, the third party requester filed replacement comments in response to the June 24, 2010 decision.

DECISION

As pointed out, the patent owner filed a June 7, 2010 petition, which is a petition requesting expungement of the April 7, 2010 comments. On June 16, 2010, the third party requester filed an opposition to the June 7, 2010 petition. However, on June 24, 2010, the Office mailed a *sua sponte* decision returning the April 7, 2010 third party comments. Therefore, the relief requested by the June 7, 2010 petition has already been given by the June 24, 2010 decision. Thus, the patent owner’s June 7, 2010 petition is moot and hereby dismissed. On July 14, 2010, the requester submitted comments to replace the April 7, 2010 comments. Accordingly, third party requester’s opposition is also moot and hereby dismissed.


POWER OF ATTORNEY & CORRESPONDENCE ADDRESS ISSUES

The power of attorney and change of correspondence address filed March 8, 2010 is ineffective because the March 8, 2010 communications were not filed in the file for the '848 patent. See the Sua Sponte Decision to Vacate the June 24, 2010 Notices, mailed contemporaneously with this decision. **The current power of attorney and correspondence address in this reexamination proceeding remains to be LUNDBECK RESEARCH USA, INC., ATTN: STEPHEN G. KALINCHAK, LEGAL, 215 COLLEGE ROAD, PARAMUS, NJ 07652.** All future Office correspondence will be mailed to the above-mentioned address. As a one time courtesy, a copy is also being mailed to the Jones Day law firm at the address listed in the March 8, 2010 communication.

Patent owner is called upon to file any change of power of attorney and correspondence address in the patent file (Application No. 10/278,437) in order to properly effectuate a change in this reexamination proceeding.

CONCLUSION

1. The June 7, 2010 patent owner's petition and the June 16, 2010 third party requester's opposition are dismissed as moot.
2. Telephone inquiries related to this decision should be directed Deborah Jones, Supervisory Patent Examiner, at (571) 272-1535.


Irem Yucel, Director
Technology Center 1600



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,247	10/27/2009	7582058	03190.005600.36	7728
30328	7590	12/10/2010	EXAMINER	
NuVasive c/o CPA Global P.O. Box 52050 Minneapolis, MN 55402			ART UNIT	PAPER NUMBER

DATE MAILED: 12/10/2010

Please find below and/or attached an Office communication concerning this application or proceeding.



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FITZPATRICK, CELLA, HARPER & SCINTO
1290 AVENUE OF THE AMERICAS
NEW YORK, NY 10104-3800

Date:

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DEC 10 2010

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001247
PATENT NO. : 7582058
TECHNOLOGY CENTER : 3999
ART UNIT : 3993

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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NuVasive
c/o CPA Global
P.O. Box 52050
Minneapolis MN 55402

(For Patent Owner)

MAILED

DEC 10 2010

Justin J. Oliver
FITZPATRICK, CELLA HARPER & SCINTO
1290 Avenue of the Americas
New York, NY 10104-3800

(For *Inter Partes* Reexamination Unit)

Inter Partes Reexamination Proceeding
Control No. 95/001,247
Filed: October 27, 2009
For: U.S. Patent No. 7,582,058

**DECISION
DISMISSING
PETITION**

This is a decision on third party requester's October 18, 2010 petition entitled "PETITION UNDER 37 C.F.R. § 1.183" requesting waiver of the page limit requirement of 37 CFR 1.943(b).

The petition is before the Office of Patent Legal Administration for consideration.

The petition is dismissed.

FEES

The petition fee of \$400 for third party requester's petition under 37 CFR 1.183 pursuant to 37 CFR 1.17(f) was charged to Deposit Account No. 50-3939 on October 19, 2010.

REVIEW OF THE RELEVANT FACTS

1. On September 1, 2009, the Office issued United States Patent Number 7,582,058 (the '058 patent) to Miles *et al.*
2. On October 27, 2009, a request for *inter partes* reexamination of claims 1-2 and 4-8 of the '058 patent, assigned Reexamination Control No. 95/001,247 (the '1247 proceeding), was filed by a third party requester.

3. On December 17, 2009, the Office issued an order granting *inter partes* reexamination in the '1247 proceeding and concurrently issued an Office action on the merits.
4. On February 18, 2010, patent owner timely filed an "AMENDMENT IN REPLY TO THE ACTION OF AUGUST 17, 2009," which amended original claim 6, added new claims 10-65 (56 new claims) and retained original claims 1- 9.¹
5. On March 19, 2010, third party requester filed a "RESPONSE TO PATENT OWNER'S AMENDMENT," which included a 33 page remarks section, a four page affidavit and 82 pages of claim charts.
6. Concurrently, on March 19, 2010, third party requester filed a petition entitled "PETITION UNDER 37 C.F.R. § 1.183" requesting waiver of the page limit requirement of 37 CFR 1.943(b).
7. On June 3, 2010, the Office issue a decision granting third party requester's March 19, 2010 petition, giving requester 61 additional pages due to patent owner's February 18, 2010 amendment that added 56 new claims.
8. On October 1, 2010, the Office issued a Notice of Informal or Non-Responsive Amendment, indicating that requester's March 19, 2010 comments submission was not compliant with the requirements for presenting additional Substantial New Questions of patentability (SNQs) during a reexamination proceeding.
9. On October 18, 2010, third party requester filed a "CORRECTED RESPONSE TO PATENT OWNER'S AMENDMENT," consisting of a 36 page replacement remarks section.
10. Concurrently, on October 18, 2010, third party requester filed a petition entitled "PETITION UNDER 37 C.F.R. § 1.183" requesting waiver of the page limit requirement of 37 CFR 1.943(b).

DECISION

Relevant Statutes, Regulations and Procedures

37 CFR 1.183 provides:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, sua sponte, or on petition of the interested party, subject to such other requirements as may

¹ The submission was timely as the February 18, 2010 submission was a refiling of a timely submission filed on February 17, 2010. The February 18, 2010 refiling was requested by the CRU to correct formal matters with regard to the bracketing and underlining of amendments to some of the claims.

be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 CFR 1.943(b) provides:

Responses by the patent owner and written comments by the third party requester shall not exceed 50 pages in length, excluding amendments, appendices of claims, and reference materials such as prior art references.

MPEP 2667(I)(B)(2) provides (in-part):

Where the length of the third party requester submission exceeds that permitted by 37 CFR 1.943, the submission is improper. Accordingly, a Notice will be issued by the examiner and mailed to the third party requester permitting the third party requester to exercise one of the following two options:

(A) Submit a re-drafted response that does not exceed the page limit set by 37 CFR 1.943; or

(B) File a copy of the supplemental response with pages redacted to satisfy the 37 CFR 1.943 page limit requirement.

The Notice will set a period of 15 days from the date of the notice to respond. If no response is received, the improper third party requester submission will not be considered.

For additional information with respect to the length of the papers, see subsection I.A.2. above.

Third Party Requester's Petition under 37 CFR 1.183

Third party requester's petition under 37 CFR 1.183, requests second waiver of the 50-page limit of 37 CFR 1.943(b) for the currently filed corrected comments, in response to the October 1, 2010, the Office issued a Notice of Informal or Non-Responsive Amendment (NINA). In the October 1, 2010 NINA the Office noted that requester filed to satisfy the statutory requirements of 35 U.S.C. 311 of how the art is being applied to newly raised SNQs, a statutory requirement. Requester was previously granted a waiver of 37 CFR 1.943(b) to include 61-pages beyond the 50-page regulatory requirement on the equitable basis of patent owner including fifty-six new claims in the patent owner response.

Now requester has come forward requesting three additional pages to accommodate satisfaction of a statutory requirement. As the requirement is statutory, requester was on full notice of the

requirements existence. Requester positively states on the record that no further efforts were taken to further economize the comments submission to satisfy the statutory requirement.²

The waiver of the rules under 37 CFR 1.183 may be suspended in an *extraordinary situation when justice requires*. Requester's petition is devoid of any equitable explanation as to why requester could not satisfy a statutory requirement in its previous comments submission. Further, as pointed out, requester actually states on the record that no efforts were taken to further economize the response to stay within the already excepted response length of 111 pages, e.g. subsections IV.B-E are redundant summations of the rejections in the claim charts which are listed on the first page of each claim chart set, as well as the summary of proposed rejections. The failure of patent owner to comply with the statute, rules and MPEP guidance, in the form of submitting a compliant 37 CFR 1.947 comments submission, does not present an *extraordinary situation* under 37 CFR 1.183 to justifying suspension of the rules. There is nothing "extraordinary" in this instance to justify a second additional waiver for the same comments submission. Therefore, justice does not require suspension of 37 CFR 1.948(b). Accordingly, the present petition is DISMISSED.

ADDITIONAL DISCUSSION/GUIDANCE

Requester's October 18, 2010 submission is improper and subject to return. See MPEP 2667, Part I.A.2. The copy of the October 18, 2010 submission however, was scanned into the electronic Image File Wrapper (IFW) of the proceeding, before discovery of the impropriety. Therefore, the IFW copy of the submission is being expunged, by closing it in the IFW file of the present proceeding and marking it "not public." It will not constitute part of the record of the present reexamination proceeding.

For the reasons given above, the October 18, 2010 submission by patent owner exceeded the 50-page limit established by 37 CFR 1.943(b). However, from the record it is apparent that requester's submission was a *bona fide* attempt to respond and advance prosecution. Accordingly, requester may, within 15 days from the date of this notice, exercise one of the following two options:

1. Submit re-drafted remarks that do not exceed the 50 page limit; or,
2. File a copy of the original remarks with pages redacted to satisfy the page limit requirement.

This 15-day period for reply is not extendable.

Requester is reminded that, under the requirements of 37 CFR 1.903, any paper submitted pursuant to this Notice must be served on the patent owner.


² Petition at page 3, "The Corrected Response submitted herewith includes the original subject matter already approved by OPLA, along with an additional 3 pages of text."

If a timely responsive comments submission is not received from requester, the present reexamination proceeding will be forwarded to the examiner for appropriate action, without written comments from requester.

Requester is advised that submissions should be of sufficient size, 12 point font, 1.5 line spaced and conform to the margin requirements of 37 CFR 1.52(a)(1)(ii) and have sufficient clarity and contrast to permit direct reproduction, and electronic capture by digital imaging and optical character recognition. See 37 CFR 1.52.

CONCLUSION

1. Third party requester's petition under 37 CFR 1.183 is dismissed.
2. Requester's October 18, 2010 comments submission is an improper paper and will not be considered. The comments submission is being expunged by being closed in the '1247 proceeding's Image File Wrapper (IFW) and marking it "non-public." The October 18, 2010 comments submission will not constitute part of the record of the present reexamination proceeding.
3. A copy of this decision will be made of public record.
4. Any questions concerning this communication should be directed to Joseph F. Weiss, Jr., Legal Advisor, at (571) 272-7759.



Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examining Policy

12-9-10
kenpet8/IP/length/not grant



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,247	10/27/2009	7582058	03190.005600.36	7728
26191	7590	10/06/2011	EXAMINER	
FISH & RICHARDSON P.C. (TC) PO BOX 1022 MINNEAPOLIS, MN 55440-1022			ART UNIT	PAPER NUMBER

DATE MAILED: 10/06/2011

Please find below and/or attached an Office communication concerning this application or proceeding.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

NUVASIVE, INC.
Patent Owner

v.

MEDTRONIC, INC.
Third Party Requester

Inter partes Reexamination Control 95/001,247
Patent 7,582,058 B1
Technology Center 3900

DECISION ON PETITION

This is a decision on a petition filed September 6, 2011, by third party requester, Medtronic, Inc. (“Medtronic”), entitled Petition Under 37 C.F.R. § 1.183 (“Petition for Waiver of September 6, 2011”). Medtronic requests that 37 C.F.R. § 1.943(c) be waived so that it may submit additional pages in its Brief on Appeal.

FINDINGS

1. Patent 7,582,058 B1 (hereinafter “the ‘058 patent”) issued on September 1, 2009, with 9 claims. The ‘058 patent is assigned to NuVasive, Inc. (“NuVasive”).

2. Medtronic, Inc. (“Medtronic”) filed a request for *inter partes* reexamination of claims 1, 2, and 4-8.

3. The Office assigned Reexamination Control No. 95/001,247 to this request and an Order Granting *Inter Partes* Reexamination of claims 1, 2, and 4-8 of the ‘531 patent was issued.

4. On December 17, 2009, the Examiner issued an Office Action in *Inter Partes* Reexamination, rejecting claims 1, 2, and 4-8.

5. On February 18, 2010, NuVasive filed an Amendment in Reply to Action of December 17, 2009 (“Patent Owner Response”), retaining original claims 1-9, amending claim 6, and adding new claims 10-65.

6. On March 19, 2010, Medtronic filed comments responsive to Patent Owner’s Amendment (“Requester Comments”), which included 33 pages of remarks, a four page affidavit, and 82 pages of claim charts. The Requester Comments proposed rejections of new claims 10-65 under 35 U.S.C. § 103, as well as §§ 314 and 112.

7. On March 19, 2010, Medtronic filed a petition requesting waiver of the 50-page limit imposed under 37 C.F.R. § 1.943(b) on its Requester Comments in response to Patent Owner's Amendment.

8. On June 3, 2010, the Office of Patent Legal Administration granted Medtronic's petition of March 19, 2010, allowing Medtronic to submit 61 pages of supplemental claim chart appendices in light of the fact that NuVasive added 56 new claims to the reexamination.

9. On December 27, 2010, Medtronic filed a Corrected Requester Comments to Patent Owner's Amendment¹, including the proposed rejections of new claims 10-65.

10. On February 16, 2011, the Office entered an Action Closing Prosecution, indicating that Medtronic's Response of December 27, 2010, had been made of record and had been considered. In the Action Closing Prosecution, the Examiner withdrew the grounds of rejection previously set forth, thus claims 1, 2, 4, 5, 7, and 8 were confirmed, and found claims 6 and 10-65 to be patentable.

11. On June 6, 2011, the Office entered a Right of Appeal Notice, again confirming claims 1, 2, 4, 5, 7, and 8 and finding claims 6 and 10-65 to be patentable.

¹ Subsequent to the grant of Medtronic's petition of March 19, 2010, the Office issued a communication indicating that Medtronic's Response to Patent Owner's Amendment was defective because it did not establish new question of patentability in regard to the references cited in the newly proposed grounds of rejection. Though Medtronic petitioned to be allowed to file three additional pages so that its Response would be complete, the Office of Patent Legal Administration dismissed the petition, concluding that there was no "extraordinary situation" to justify a second additional waiver and that Medtronic failed to show that any further effort had been made to comply with the page limits already set.

12. On July 6, 2011, Medtronic filed a Notice of Appeal.
13. On September 6, 2011, Medtronic filed a Brief on Appeal, which includes 48 pages of argument and citations to declarations (*see, e.g.,* Brief on Appeal 17).
14. On September 6, 2011, Medtronic filed the current petition for waiver of 37 C.F.R. § 1.943(c) to file a Brief on Appeal of more than 30 pages.
15. A Notice of Defective Appeal Brief was mailed on September 29, 2011.

RELEVANT AUTHORITY

Page and word limits for briefs in reexamination appeals are provided for in 37 C.F.R. § 1.943(c), as follows:

Appellant's briefs filed by the patent owner and the third party requester shall not exceed thirty pages or 14,000 words in length, excluding appendices of claims and reference materials such as prior art references. All other briefs filed by any party shall not exceed fifteen pages in length or 7,000 words. If the page limit for any brief is exceeded, a certificate is required stating the number of words contained in the brief.

This and other rules of the Office may be suspended pursuant to 37 C.F.R. § 1.183:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

ANALYSIS

Medtronic requests that the page limits imposed by 37 C.F.R. § 1.943(b) on its Brief on Appeal be waived so that it can enter the brief submitted on September 6, 2011. (Petition for Waiver of September 6, 2011, at 1.) According to Medtronic, 21 different combinations of prior art have been applied against the independent claims, creating a large number of issues. (*Id.* at 5.) Medtronic argues further that the Examiner did not fully discuss all of the issues raised by the prior art, but merely cited to pages of NuVasive's Amendment for reasons of patentability. (*Id.* at 3-4.) Medtronic argues that the Examiner failed to address the rejections proposed for the claims NuVasive added in its Amendment, again only citing to NuVasive's Response of February 18, 2010. (*Id.* at 3.) Medtronic asserts that given the number and complexity of the issues on appeal and the lack of adequate comments from the Examiner on which to narrow these issues, additional pages are required to sufficiently set forth its contentions. (*Id.* at 4.)

The Action Closing Prosecution discusses NuVasive's claim 6 and new claims 10 and 30, but refers only to pages of NuVasive's Amendment of February 18, 2010, to complete the discussion of why claims 1, 6, 10, and 30 are patentable. The Examiner's action does not appear to address the arguments in Medtronic's Requester Comments of March 19, 2010. (Action Closing Prosecution, 6-7.) Furthermore, though the Examiner states that the references cited by Medtronic in its Requester Comments of March 19, 2010, raise substantial new questions of patentability (*id.* at 7-9), none of these proposed new grounds of rejection are adopted (*id.* at 9). The only

explanation the Examiner provides is reference to pages of NuVasive's Amendment of February 18, 2010 (*id.*), which notably was filed *before* Medtronic's Requester Comments. The Examiner's action refuses to adopt the rejections proposed by Medtronic for the new claims, but is silent as to the specific reasons why the proposed rejections are not adopted.

Even though Medtronic asserts that it has attempted to be concise in its Brief on Appeal (Petition for Waiver of September 6, 2011, at 4), it is still presented with the extraordinary situation of appealing rejections that the Examiner has not adopted, without sufficient reasoning.

Accordingly, given the specific facts and circumstances of this particular case, Medtronic has provided a persuasive showing that an extraordinary situation exists where justice requires waiver of 37 C.F.R. § 1.943(c).

The Petition for Waiver of September 6, 2011, is **granted**.

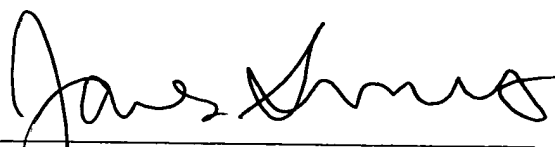
The Notice of Non-compliant Appeal Brief of September 29, 2011, is **vacated**.

The Brief on Appeal filed by Medtronic on September 6, 2011, is **entered**.

Respondent's brief is due pursuant to 37 C.F.R. § 41.66(b).

DECISION

In view of the foregoing, Medtronic's Petition for Waiver of September 6, 2011, is **GRANTED**.



James Donald Smith
Chief Administrative Patent Judge

Inter partes Reexamination Control No. 95/001,247
Patent 7,582,058 B1

Counsel for Patent Owner NuVasive:

Stephen R. Schaefer
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,247	10/27/2009	7582058	03190.005600.36	7728
26191	7590	11/08/2011	EXAMINER	
FISH & RICHARDSON P.C. (TC) PO BOX 1022 MINNEAPOLIS, MN 55440-1022			ART UNIT	PAPER NUMBER

DATE MAILED: 11/08/2011

Please find below and/or attached an Office communication concerning this application or proceeding.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

NUVASIVE, INC.
Patent Owner

v.

MEDTRONIC, INC.
Third Party Requester

Inter partes Reexamination Control 95/001,247
Patent 7,582,058 B1
Technology Center 3900

DECISION ON PETITION

This is a decision on a petition filed October 20, 2011, by Patent Owner NuVasive, Inc. (“NuVasive”), entitled Petition Under 37 C.F.R. § 1.183 to Waive the 50-Page¹ Limit Set Forth in 37 C.F.R. § 1.943 (“NuVasive’s Petition for Waiver”). NuVasive requests that 37 C.F.R. § 1.943(c) be waived so that patent owner may submit additional pages in its Respondent’s Brief.

FINDINGS

1. U.S. Patent 7,582,058 B1 (hereinafter “the ‘058 patent”) issued on September 1, 2009, with 9 claims. The ‘058 patent is assigned to NuVasive.

2. Medtronic, Inc. (“Medtronic”) filed a request for *inter partes* reexamination of claims 1, 2, and 4-8. The Office assigned control no. 95/001,247 to this request and on December 17, 2009, an Order Granting *Inter Partes* Reexamination of claims 1, 2, and 4-8 of the ‘058 patent was mailed.

3. On December 17, 2009, the Examiner mailed an Office Action in *Inter Partes* Reexamination, rejecting claims 1, 2, and 4-8.

4. On February 18, 2010, NuVasive filed an Amendment in Reply to Action of December 17, 2009, retaining original claims 1-5 and 7- 9, amending claim 6, and adding new claims 10-65.

5. On March 19, 2010, Medtronic filed comments responsive to Patent Owner’s Amendment, which included 33 pages of remarks, a four page affidavit, and 82 pages of claim charts. The Requester Comments

¹ Although the title of NuVasive’s Petition for Waiver indicates a 50-page brief is allowed under the Rule, a Respondent Brief is limited to 15 pages under 37 C.F.R. § 1.943(c).

proposed rejections of new claims 10-65 under 35 U.S.C. § 103, as well as under §§ 314 and 112.

6. On March 19, 2010, Medtronic filed a petition requesting waiver of the 50-page limit imposed under 37 C.F.R. § 1.943(b) on its Requester Comments in response to Patent Owner's Amendment.

7. On June 3, 2010, the Office of Patent Legal Administration granted Medtronic's petition of March 19, 2010, allowing Medtronic to submit 61 pages of supplemental claim chart appendices in light of the fact that NuVasive added 56 new claims to the reexamination.

8. On December 27, 2010, Medtronic filed a Corrected Requester Comments to Patent Owner's Amendment², including proposed rejections of new claims 10-65.

9. On February 16, 2011, the Office entered an Action Closing Prosecution, indicating that Medtronic's Response of December 27, 2010, had been made of record and had been considered. In the Action Closing Prosecution, the Examiner withdrew the grounds of rejection previously set forth, thus confirming claims 1, 2, 4, 5, 7, and 8, and finding claims 6 and 10-65 to be patentable.

² Subsequent to the grant of Medtronic's petition of March 19, 2010, the Office issued a communication indicating that Medtronic's Response to Patent Owner's Amendment was defective because it did not establish substantial new question of patentability in regard to the references cited in the newly proposed grounds of rejection. Though Medtronic petitioned to be allowed to file three additional pages so that its Response would be complete, the Office of Patent Legal Administration dismissed the petition, concluding that there was no "extraordinary situation" to justify a second additional waiver and that Medtronic failed to show that any further effort had been made to comply with the page limits already set. *See* Petition Decision of December 10, 2010.

10. On June 6, 2011, the Office entered a Right of Appeal Notice, again confirming claims 1, 2, 4, 5, 7, and 8 and finding claims 6 and 10-65 to be patentable.

11. On July 6, 2011, Medtronic filed a Notice of Appeal.

12. On September 6, 2011, Medtronic filed a Brief on Appeal, including 48 pages of argument and citations to declarations.

13. Also on September 6, 2011, Medtronic filed a petition for waiver of 37 C.F.R. § 1.943(c) to file a Brief on Appeal of more than 30 pages.

14. A Notice of Defective Appeal Brief was mailed on September 29, 2011.

15. On October 6, 2011, the Office mailed a Decision on Petition granting Medtronic's request for waiver, vacating the Notice of Defective Appeal Brief, and entering Medtronic's Brief on Appeal.

16. On October 20, 2011, NuVasive filed the current petition, along with a Respondent's Brief of Patent Owner.

RELEVANT AUTHORITY

Page and word limits for briefs in reexamination appeals are provided for in 37 C.F.R. § 1.943(c), as follows:

Appellant's briefs filed by the patent owner and the third party requester shall not exceed thirty pages or 14,000 words in length, excluding appendices of claims and reference materials such as prior art references. All other briefs filed by any party shall not exceed fifteen pages in length or 7,000 words. If the page limit for any brief is exceeded, a certificate is required stating the number of words contained in the brief.

This and other rules of the Office may be suspended pursuant to 37 C.F.R.

§ 1.183:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

ANALYSIS

NuVasive requests waiver of the limit of 15 pages imposed by 37 C.F.R. § 1.943(c) to permit entry of its Respondent Brief of Patent Owner, which it maintains is 46 pages long (*see* NuVasive's Petition for Waiver 2). NuVasive argues that extra pages are necessary to provide a Summary of the Claimed Subject Matter section, to address the "numerous grounds, references and claims at issue," and because Medtronic was granted an extension of the page limits. (*Id.* at 1.)

NuVasive argues that Medtronic's Brief on Appeal does not include a proper summary of the claimed subject matter at issue. (*Id.* at 5.) According to NuVasive, it must fulfill the requirements of 37 C.F.R. § 41.67(c)(1)(v) because the Brief on Appeal lacks a proper summary. (*Id.*) As Respondent, NuVasive is not required to comply with 37 C.F.R. § 41.67(b)(1)(v). Respondent's summary of claimed subject matter is governed by 37 C.F.R. § 41.68(b)(1)(v) and by what the respondent chooses to accept or dispute in Medtronic's summary. Accordingly, the Notice of Non-compliant Appeal Brief of September 29, 2011, and Decision on Petition of October 6, 2011,

do not *require* NuVasive to include any pages of text and do not create an extraordinary situation.

NuVasive also argues that the rule imposing page limits must be waived because it asserts that Medtronic's Brief on Appeal raises 30 different grounds for proposed rejections, which NuVasive considers to be "unusually large." (NuVasive's Petition for Waiver at 4.) According to NuVasive, Medtronic made no attempt to reduce the number of issues on appeal. (*See id.* at 5.) Medtronic asserted that it attempted to be concise, for example by focusing on independent claims and not appealing every proposed rejection of the independent claims. (*See* Petition for Waiver of September 6, 2011, at 4.) Given that NuVasive added 56 claims to be considered in this proceeding, thus increasing the number of claims being reexamined from 7 claims to 63 claims, NuVasive has not provided a sufficient showing that the number of issues creates an extraordinary situation wherein justice requires waiver of 37 C.F.R. § 1.943(c).

Under the specific facts and circumstances of this particular case, Medtronic's petition of September 6, 2011, resulted in the Office permitting additional pages for the appellant brief. Balancing the equities in this case, it is appropriate to provide NuVasive with a proportional number of additional pages to respond to Medtronic's Brief on Appeal. In light of the length of Medtronic's Brief on Appeal, NuVasive is given a single opportunity to file an amended Respondent Brief of not more than 24 pages or 11,200 words in length, instead of the 15 pages or 7,000 words permitted by 37 C.F.R. § 1.943(c).

Reexamination Control No. 95/001,247
Patent 7,582,058 B1

NuVasive's Petition for Waiver, filed October 20, 2011, is **denied**.

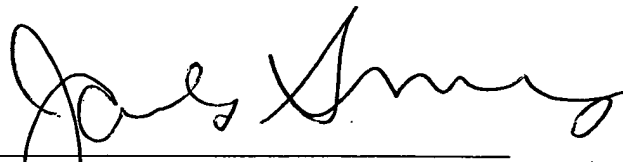
Respondent Brief of Patent Owner filed October 20, 2011, is **not entered**.

DECISION

In view of the foregoing, NuVasive's Petition for Waiver of October 20, 2011, is DENIED.

NuVasive is given ONE MONTH from the mailing date hereof to submit an amended Respondent Brief of not more than 24 pages or 11,200 words.

If respondent does not file an amended Respondent Brief within the set time period, or files an amended Respondent Brief that does not comply with these page and word limits, the Respondent Brief and any amended Respondent Brief filed by that respondent will not be considered. *See* 37 C.F.R. 41.68(c).



James Donald Smith
Chief Administrative Patent Judge

Counsel for Patent Owner NuVasive:

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Reexamination Control No. 95/001,247
Patent 7,582,058 B1

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,247	10/27/2009	7582058	03190.005600.36	7728
26191	7590	04/04/2012	EXAMINER	
FISH & RICHARDSON P.C. (TC) PO BOX 1022 MINNEAPOLIS, MN 55440-1022			ART UNIT	PAPER NUMBER

DATE MAILED: 04/04/2012

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

NUVASIVE, INC.
Patent Owner

v.

MEDTRONIC, INC.
Third Party Requester

Inter partes Reexamination Control 95/001,247
Patent 7,582,058
Technology Center 3900

DECISION ON PETITION

This is a decision on Third Party Requester's "Petition Under 37 C.F.R. § 1.183," filed February 27, 2012. ("Petition"). The Petition "petitions the Director to waive 37 C.F.R. 1.943(c) to permit additional pages in the Petitioner-Appellant's "Rebuttal Brief," which is being submitted herewith." Petition, p. 1.

FINDINGS

1. On September 1, 2009, U.S. Patent 7,582,058 (hereinafter "the '058 patent") issued with 9 claims. The '058 patent is assigned to NuVasive, Inc. ("NuVasive").

Inter partes Reexamination Control 95/001,247
Patent 7,582,058

2. On October 27, 2009, Medtronic, Inc. ("Medtronic") filed a Corrected Request for *Inter Partes* Reexamination of claims 1, 2, and 4-8 of the '058 patent.

3. On November 2, 2009, the Office assigned Reexamination Control No. 95/001,247 to Medtronic's request.

4. On December 17, 2009, the Office issued an Order Granting Request for *Inter Partes* Reexamination of claims 1, 2, and 4-8 of the '058 patent.

5. Also on December 17, 2009, the Examiner issued an Office Action in *Inter Partes* Reexamination, rejecting claims 1, 2, and 4-8.

6. On February 18, 2010, NuVasive filed a Corrected Amendment in Reply to Action of December 17, 2009, retaining original claims 1-5, and 7-9, amending claim 6, and adding new claims 10-65.

7. On March 19, 2010, Medtronic filed a Response to Patent Owner's Amendment, which included 33 pages of remarks, a four page affidavit, and 82 pages of claim charts. The Requester Comments proposed rejections of new claims 10-65 under 35 U.S.C. § 103, as well as under 35 U.S.C. §§ 314 and 112.

8. Also on March 19, 2010, Medtronic filed a petition requesting waiver of the 50-page limit imposed under 37 C.F.R. § 1.943(b) on its Requester Comments in response to Patent Owner's Amendment.

9. On June 3, 2010, the Office of Patent Legal Administration granted Medtronic's petition of March 19, 2010, allowing Medtronic to submit 61 pages of supplemental claim chart appendices in light of the fact that NuVasive added 56 new claims to the reexamination.

Inter partes Reexamination Control 95/001,247
Patent 7,582,058

10. On December 27, 2010, Medtronic filed a Corrected Response to Patent Owner's Amendment¹, including proposed rejections of new claims 10-65.

11. On February 16, 2011, the Office entered an Action Closing Prosecution, indicating that Medtronic's Response of December 27, 2010, had been made of record and had been considered. In the Action Closing Prosecution, the Examiner withdrew the grounds of rejection previously set forth (thus confirming claims 1, 2, 4, 5, 7, and 8) and found claims 6 and 10-65 to be patentable.

12. On June 6, 2011, the Office entered a Right of Appeal Notice, again confirming claims 1, 2, 4, 5, 7, and 8 and finding claims 6 and 10-65 to be patentable.

13. On July 6, 2011, Medtronic filed a Notice of Appeal.

14. On September 6, 2011, Medtronic filed a Brief on Appeal, including 48 pages of argument and citations to declarations (*see, e.g.*, Requester's App. Br. 17).

¹ Subsequent to the grant of Medtronic's petition of March 19, 2010, the Office issued a communication indicating that Medtronic's Response to Patent Owner's Amendment was defective because it did not establish a substantial new question of patentability in regard to the references cited in the newly proposed grounds of rejection. Though Medtronic petitioned to be allowed to file three additional pages so that its Response would be complete, the Office of Patent Legal Administration dismissed the petition, concluding that there was no "extraordinary situation" to justify a second additional waiver and that Medtronic failed to show that any further effort had been made to comply with the page limits already set. *See* Petition Decision of Dec. 10, 2010.

Inter partes Reexamination Control 95/001,247
Patent 7,582,058

15. Also on September 6, 2011, Medtronic filed a petition for waiver of 37 C.F.R. § 1.943(c) to file a Brief on Appeal of more than 30 pages.

16. On September 29, 2011, the Office issued a Notice of Defective Appeal Brief.

17. On October 6, 2011, the Office entered a Decision on Petition granting Medtronic's request for waiver, vacating the Notice of Defective Appeal Brief, and entering Medtronic's Brief on Appeal.

18. On October 20, 2011, NuVasive filed a Respondent Brief of Patent Owner.

19. Also on October 20, 2011, NuVasive filed a petition for waiver of 37 C.F.R. § 1.943(c) to file a Respondent Brief of more than 15 pages.

20. On November 8, 2011, the Office entered a Decision on Petition denying NuVasive's request for waiver, but granting NuVasive a period of one month to file a Respondent Brief of not more than 24 pages or 11,200 words.

21. On December 8, 2011, NuVasive filed a Corrected Respondent Brief.

22. On January 25, 2012, the Examiner entered an Examiner's Answer.

23. On February 27, 2012, Medtronic filed the present Petition and a Rebuttal Brief having 21 countable pages and an unknown number of words.

RELEVANT AUTHORITY

Page and word limits for briefs in *inter partes* reexamination appeals are provided for in 37 C.F.R. § 1.943(c), as follows:

Appellant's briefs filed by the patent owner and the third party requester shall not exceed thirty pages or 14,000 words in length, excluding appendices of claims and reference materials such as prior art references. All other briefs filed by any party shall not exceed fifteen pages in length or 7,000 words. If the page limit for any brief is exceeded, a certificate is required stating the number of words contained in the brief.

This and other rules of the Office may be suspended pursuant to 37 C.F.R. § 1.183:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

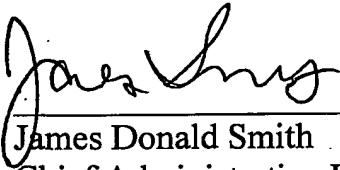
ANALYSIS

As indicated, previously in this appeal, Medtronic was granted permission to file a 48 page Appellant Brief and NuVasive was granted permission to file a 24 page Respondent Brief. Thus, as a matter of consistency and modeled after the relative length of briefs as specified in Rule 1.943(c), Medtronic should be permitted to submit a Rebuttal Brief not to exceed 24 pages in length.

Inter partes Reexamination Control 95/001,247
Patent 7,582,058

DECISION

In view of the foregoing, the Petition is GRANTED. Medtronic's
Rebuttal Brief of 21 pages is acceptable and has been entered.



James Donald Smith
Chief Administrative Patent Judge

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,249	10/23/2009	7374670	1209-0007	1078
50010	7590	11/22/2011	EXAMINER	
LAW OFFICE OF MICHAEL A. BLAKE, LLC 95 HIGH STREET SUITE 5 MILFORD, CT 06460			ART UNIT	PAPER NUMBER

DATE MAILED: 11/22/2011

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MICHAUD-DUFFY GROUP LLP
306 INDUSTRIAL PARK ROAD
SUITE 206
MIDDLETOWN, CT 06457

Date: **MAILED**
NOV 22 2011
CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001249
PATENT NO. : 7374670
TECHNOLOGY CENTER : 3999
ART UNIT : 3991

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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LAW OFFICE OF MICHAEL A. BLAKE, LLC
95 HIGH STREET
SUITE 5
MILFORD CT 06460

(For Patent Owner)

MAILED

NOV 22 2011

CENTRAL REEXAMINATION UNIT

MICHAUD-KINEY GROUP, LLP
306 INDUSTRIAL PARK ROAD
SUITE 206
MIDDLETOWN, CT 06460

(For Third Party Requester)

Inter Partes Reexamination Proceeding
Control No.: 95/001,249
Filed: October 23, 2009
For: U.S. Patent No. 7,374,670

:
: **DECISION DISMISSING**
: **PETITION FOR WAIVER**
: **OF 37 CFR 1.955 FOR**
: **ONE-TIME INTERVIEW**
:

This is a decision on patent owner's "PETITION UNDER 37 C.F.R. § 1.183 SEEKING WAIVER OF 37 C.F.R. § 1.955," filed on August 10, 2011.

The patent owner petition is before the Office of Patent Legal Administration.

The petition is dismissed.

BACKGROUND

1. U.S. Patent No. 7,374,670 ("the '670 patent") issued to Potts on May 20, 2008.
2. On October 23, 2009, a request for *inter partes* reexamination was filed by a third party requester, which was assigned control no. 95/001,249 ("the '1249 proceeding").
3. On January 15, 2010, the Office ordered reexamination in the '1249 proceeding and concurrently issued a non-final first action on the merits.
4. On March 14, 2010, patent owner timely filed a response to the January 15, 2010 Office action on the merits in the '1249 proceeding.
5. On April 13, 2010, third party requester timely filed a response to patent owner's March 14, 2010 submission.
6. On August 10, 2010, patent owner filed the instant petition paper entitled, "PETITION UNDER 37 C.F.R. § 1.183 SEEKING WAIVER OF 37 C.F.R. § 1.955."

7. As of the mailing of this decision the Office has not received a third party requester notice of non-participation/litigation settlement in the '1249 proceeding.

DECISION

Relevant Statutes, Regulations and Practice

35 U.S.C. § 314 provides, in part:

(a) IN GENERAL.— Except as otherwise provided in this section, reexamination shall be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133. In any *inter partes* reexamination proceeding under this chapter, the patent owner shall be permitted to propose any amendment to the patent and a new claim or claims, except that no proposed amended or new claim enlarging the scope of the claims of the patent shall be permitted.

(c) SPECIAL DISPATCH.— Unless otherwise provided by the Director for good cause, all *inter partes* reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, shall be conducted with special dispatch within the Office.

37 CFR 1.955 provides:

There will be no interviews in an *inter partes* reexamination proceeding which discuss the merits of the proceeding.

Patent Owner's Petition under 37 CFR 1.183

In the instant petition, petitioner patent owner requests waiver of 37 CFR 1.955, which prohibits interviews in *inter partes* reexamination. In particular, petitioner requests that it be granted an examiner interview in the '1249 *inter partes* proceeding asserting that "there no longer exists a third party requester to participate in the reexamination and special dispatch would be promoted by the requested examiner interview on the merits."¹

37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party. The burden is on petitioner to set forth with specificity the facts that give rise to an extraordinary situation in which justice requires suspension of a rule. In support of its request for waiver of 37 CFR 1.955, petitioner asserts that: (1) third party requester no longer exists, and (2) the interview would advance prosecution of the '1249 proceeding by allowing the examiner and patent owner discuss the outstanding issues in the '1249 proceeding.²

¹ See August 10, 2011 petition under 37 CFR 1.183 at page 1.

² See *id.* at page 3.

A review of the *Notice of Final Rule Making, Rules to Implement Optional Inter Partes Reexamination Proceedings*, 65 FR 76755 (Dec. 7, 2000), 1242 *Off. Gaz. Pat. Office* 12 (Jan. 2, 2001) (final rule) reveals that the Notice of Proposed Rule Making had proposed implementation of a regulation that would have permitted interviews in *inter partes* reexamination proceedings. In the final rule, however, the Office decided to preclude both *ex parte* and *inter partes* interviews in an *inter partes* reexamination proceeding, and accordingly published 37 CFR 1.955 in its present form. The Office concluded that, for a variety of reasons, "[n]o matter what the structure of the interview, the presence of a third party requester (or a separate interview with the requester) will complicate the reexamination proceeding and significantly delay it." Thus, the key basis for the present 37 CFR 1.955 proscription of all and any interviews in an *inter partes* reexamination proceeding was that the presence of two (or more) parties in the proceeding would interfere with the Office's ability to conduct an *inter partes* reexamination proceeding with special dispatch as mandated by 35 U.S.C. § 314.

In this instance, third party requester has NOT stated on the record that it will no longer participate in the '1249 *inter partes* reexamination proceeding. Patent owner assert that requester has dissolved, providing a copy of computer printout from the Connecticut Secretary of State.³ Patent owner also provides a copy of an e-mail press release asserting that it reflects that patent owner and the requester have settled concurrent patent litigation. Patent owner has also asserted that third party requester has had limited participation in the proceeding.⁴ Patent owner has NOT provided any settlement agreement or court documents regarding the alleged litigation settlement or the dissolution of the third party requester. No trustee/receiver or court sourced documents are before the Office regarding the rights of the third party requester in the '1249 proceeding. Outside of patent owner's assertion of requester dissolution, supported only by a copy of a patent owner sourced e-mail press release and an uncertified copy of computer printout from the Connecticut Secretary of State, there is nothing of record in the present proceeding to support patent owner's assertion. There is no Official document bearing an authorized signature from the Connecticut Secretary of State's office (or other authorized agency) stating that the requester entity has been dissolved *with no successor-in-interest of the requester entity*. Finally, third party requester has fully participated in the proceeding to the extent permissible relative to the present disposition of the proceeding and in accordance with Office policy, practice, and procedure, i.e. responsive comments under 37 C.F.R. 1.947 and the submission of prior art under 37 C.F.R. 1.948 during an *inter partes* proceeding. In view of the above, the Office cannot disregard the substantive rights of the third party requester based upon such informal evidence and speculative conjecture from an interested party, i.e. the patent owner. Absent an official document as specified above and an appropriate statement of non-participation from third party requester, the third party requester's trustee/receiver or documentation from a court of competent jurisdiction reflecting non-participation, the Office cannot abrogate a third party requester's substantive rights in an adversarial proceeding and conduct *ex parte* communications with patent owner.

It is noted that the record reflects that the requester is represented by counsel. Therefore, third party requester's counsel is also called upon to inform the Office to render a submission regarding the requester's status and continued participation in the present proceeding.

³ See Exhibit B of the August 10, 2011 petition.

⁴ See the August 10, 2011 petition at page 2.

It is further noted that patent owner has not focused the matters at issue in the proceeding to be discussed at the interview. While patent owner asserts that such interview would allow the Office and patent owner to discuss a list of issues, the list consists of very broad, sweeping topics and does not focus the issues to be addressed at the interview in accordance with Office policy, practice and procedure.⁵ It merely indicates little more than a basic desire to discuss all issues that are commonly at play in any patent application or reexamination proceeding before the Office.

Should patent owner correct the matters identified immediately above, it may be found that permitting a single interview to be conducted at this point in the '1249 *inter partes* proceeding may well assist the Office in expeditiously resolving the proceeding.⁶ If patent owner chooses to present a petition to address the above-identified matter, patent owner is to immediately renew it, given the Office's statutory requirement (35 U.S.C. § 314(c)) to conduct reexaminations with special dispatch.

CONCLUSION

1. Patent owner's August 10, 2011 petition under 37 CFR 1.183 to waive the provisions of 37 CFR 1.955 is dismissed.
2. Any renewed petition must be filed within two (2) months of this decision, to assure that an Office action is not issued without the requested interview after first action.
3. Third party requester's counsel is given one (1) month to submit a response to clarify the status of the requester and inform the Office regarding the requester's continued participation in the proceeding.
4. Any questions concerning this communication should be directed to Joseph Weiss, Legal Advisor, Office of Patent Legal Administration, at (571) 272-7759.

/Kenneth M. Schor/

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

11-21-11

⁵ See MPEP 713 and 2281.

⁶ The '1249 proceeding is ready for examiner action following third party requester's April 13, 2010 response to patent owner's March 14, 2010 submission.



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,249	10/23/2009	7374670	1209-0007	1078
50010	7590	04/04/2012	EXAMINER	
LAW OFFICE OF MICHAEL A. BLAKE, LLC 95 HIGH STREET SUITE 5 MILFORD, CT 06460			ART UNIT	PAPER NUMBER

DATE MAILED: 04/04/2012

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
MICHAUD-DUFFY GROUP LLP
306 INDUSTRIAL PARK ROAD
SUITE 206
MIDDLETOWN, CT 06457

Date:

MAILED

APR 04 2012

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001249
PATENT NO. : 7374670
TECHNOLOGY CENTER : 3999
ART UNIT : 3991

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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LAW OFFICE OF MICHAEL A. BLAKE, LLC
95 HIGH STREET
SUITE 5
MILFORD CT 06460

(For Patent Owner)

MICHAUD-KINEY GROUP, LLP
306 INDUSTRIAL PARK ROAD
SUITE 206
MIDDLETOWN, CT 06460

(For Third Party Requester)

Inter Partes Reexamination Proceeding
Control No.: 95/001,249
Filed: October 23, 2009
For: U.S. Patent No. 7,374,670

DECISION
DISMISSING
PETITION

MAILED
APR 04 2012
CENTRAL REEXAMINATION UNIT

This is a decision on patent owner's "SUPPLEMENTED AND RENEWED PETITION UNDER 37 C.F.R. § 1.183 SEEKING WAIVER OF 37 C.F.R. § 1.955," filed on January 16, 2012.

The patent owner petition is before the Office of Patent Legal Administration.

The petition is dismissed.

BACKGROUND

1. U.S. Patent No. 7,374,670 ("the '670 patent") issued to Potts on May 20, 2008.
2. On October 23, 2009, a request for *inter partes* reexamination was filed by a third party requester, which was assigned control no. 95/001,249 ("the '1249 proceeding").
3. On January 15, 2010, the Office ordered reexamination in the '1249 proceeding and concurrently issued a non-final first action on the merits.
4. On March 14, 2010, patent owner timely filed a response to the January 15, 2010 Office action on the merits in the '1249 proceeding.
5. On April 13, 2010, third party requester timely filed a response to patent owner's March 14, 2010 submission.
6. On August 10, 2011, patent owner filed a petition paper entitled, "PETITION UNDER 37 C.F.R. § 1.183 SEEKING WAIVER OF 37 C.F.R. § 1.955."
7. On November 22, 2011, the Office issued a decision dismissing patent owner's August 10, 2011 petition under 37 CFR 1.183. The decision also called upon requester's counsel to state on the record the requester's status with regard to continued participation in the present proceeding.

8. On January 16, 2012, patent owner filed the instant petition paper entitled, "SUPPLEMENTED AND RENEWED PETITION UNDER 37 CFR § 1.183 SEEKING WAIVER OF 37 CFR § 1.955."
9. As of the mailing of this decision the Office has not received from the third party requester a notice of non-participation/litigation settlement in the '1249 proceeding.

DECISION

Rélevant Statutes, Regulations and Practice

35 U.S.C. § 314 provides, in part:

(a) IN GENERAL.— Except as otherwise provided in this section, reexamination shall be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133. In any *inter partes* reexamination proceeding under this chapter, the patent owner shall be permitted to propose any amendment to the patent and a new claim or claims, except that no proposed amended or new claim enlarging the scope of the claims of the patent shall be permitted.

(c) SPECIAL DISPATCH.— Unless otherwise provided by the Director for good cause, all *inter partes* reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, shall be conducted with special dispatch within the Office.

37 CFR 1.955 provides:

There will be no interviews in an *inter partes* reexamination proceeding which discuss the merits of the proceeding.

Patent Owner's renewed Petition under 37 CFR 1.183

In the January 16, 2012 renewed petition under 37 CFR 1.183, petitioner patent owner requests waiver of 37 CFR 1.955, which prohibits interviews in *inter partes* reexamination. In particular, petitioner requests that it be granted an examiner interview in the '1249 *inter partes* proceeding reasserting that a third party requester no longer exists to participate in the reexamination and that special dispatch would be promoted by the requested examiner interview on the merits.¹

37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party. The burden is on petitioner to set forth with specificity the facts that give rise to an extraordinary situation in which justice requires suspension of a rule. In support of its request for waiver of 37 CFR 1.955, petitioner provide: (1) certified copies of documentary proof

¹ See January 16, 2012 petition under 37 CFR 1.183 at page 2.

that third party requester no longer exists; (2) court documentation that related concurrent litigation was dismissed with prejudice against the third party requester; and (3) a short listing of broad issues to be addressed in the interview, that patent owner assumes will advance prosecution of the '1249 proceeding in support of special dispatch.² Further patent owner notes that despite being given an opportunity to clarify the record, the third party requester has failed to provide a notice on non-participation to the Office.³ The petition and its evidentiary showing have been fully considered.

Despite the November 22, 2011 decision specifically requesting the third party requester's registered counsel to comment about the requester's participation status, no response has been made of record to clarify whether the requester-client will further participate in the '1249 *inter partes* reexamination proceeding. Thus, requester counsel's silence coupled with patent owner's showing of both dissolution of requester and dismissal with prejudice against requester of concurrent litigation regarding the '670 patent, sufficiently establishes that requester would not be prejudiced by waiver of the rule.

The November 2, 2011 decision also required patent owner to provide a showing that the issues to be discussed in the interview would support the statutory mandate of special dispatch. Specifically the November 2, 2011 decision stated:

... patent owner has not focused the matters at issue in the proceeding to be discussed at the interview. While patent owner asserts that such interview would allow the Office and patent owner to discuss a list of issues, the list consists of very broad, sweeping topics and does not focus the issues to be addressed at the interview in accordance with Office policy, practice and procedure. It merely indicates little more than a basic desire to discuss all issues that are commonly at play in any patent application or reexamination proceeding before the Office. Decision at page 4, footnote omitted.

Patent owner, instead of focusing the issues with sufficient specificity and demonstrate how their discussion and resolution supports special dispatch, has instead provided a slightly different rewording of the same broad/open listing of topics to be discussed, with one of the listed topics supplemented by a listing of references with minimal fact citation coupled with legal assertions with respect to each listed reference. Patent owner provides no disclosure with regard to secondary considerations to be discussed but for a footnote listing two secondary consideration categories, and there is no citation to affidavits of record in the proceeding on secondary considerations. Patent owner provides no explication of the allegation that various uncited rejections of unknown combinations of references of record cannot be combined as proposed in the uncited rejections. Patent owner does not identify nor discuss any details of the technology to which the inventor is alleged to have contributed to the '670 patent's disclosure. Patent owner makes citation to the record, nor attempt to now lay out the support that allegedly exists in the as-filed application specification for the claims that were added during the proceeding, which is required by regulation and should already be of record.⁴ Accordingly, outside of the addition of

² See petition Exhibit A, E and F and petition at page 6.

³ Petition at page 3.

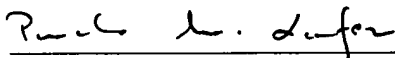
⁴ See 37 CFR 1.530(e) which states in pertinent part, "(e) *Status of claims and support for claim changes.* Whenever there is an amendment to the claims . . . and an explanation of the support in the disclosure of the patent

one footnote citing individual references, and making a conclusory statement regarding each reference, patent owner has merely resubmitted a slightly reworded but substantially the same very broad, sweeping topics for discussion topics in the desired interview. Thus, patent owner's allegation that the issues to be discussed in an interview will support special dispatch is not supported by a sufficient showing.

Although, based upon the present facts and circumstances, permitting a patent owner interview at this point in the '1249 *inter partes* proceeding does not appear to prejudice requester, patent owner has not provided a sufficient showing that the interview would promote the Office's ability to conduct the '1249 *inter partes* proceeding with special dispatch. Therefore, the facts and circumstances of record in the '1249 *inter partes* reexamination proceeding do not present an extraordinary situation justifying waiver of 37 CFR 1.955 to further the interests of the patent owner, members of the public who may be interested in the outcome of the proceedings, and the Office. Accordingly, patent owner's renewed petition under 37 CFR 1.183 is dismissed.

CONCLUSION

1. Patent owner's January 16, 2012 renewed petition under 37 CFR 1.183 to waive the provisions of 37 CFR 1.955 is dismissed.
2. Any questions concerning this communication should be directed to Joseph F. Weiss, Jr., Legal Advisor, at (571) 272-7759.



Pinchus M. Laufer
Senior Legal Advisor
Office of Patent Legal Administration

April 3, 2012



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,509	10/07/2009	6781231	092771-0021C	5895
38939	7590	12/28/2010	EXAMINER	
DYKEMA GOSSETT PLLC 10 S. WACKER DR., STE. 2300 CHICAGO, IL 60606			ART UNIT	PAPER NUMBER

DATE MAILED: 12/28/2010

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,251	11/24/2009	6,781,231	092771-0021D	6960
38939	7590	12/28/2010	EXAMINER	
DYKEMA GOSSETT PLLC 10 S. WACKER DR., STE. 2300 CHICAGO, IL 60606			ART UNIT	PAPER NUMBER

DATE MAILED: 12/28/2010

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,363	06/30/2010	6,781,231	092771-0035	7421
38939	7590	12/28/2010	EXAMINER	
DYKEMA GOSSETT PLLC 10 S. WACKER DR., STE. 2300 CHICAGO, IL 60606			ART UNIT	PAPER NUMBER

DATE MAILED: 12/28/2010

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Dykema Gossett PLLC
10 S. Wacker Dr.
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(For Patent Owner)

Sunstein Kann Murphy & Timbers LLP
125 Summer Street
Boston, MA 02110-1618

(For 95/000,509 Requester)

Wolf Greenfield & Sacks, P.C.
600 Atlantic Avenue
Boston, MA 02210-2206

(For 95/001,251 Requester)

Buchanan, Ingersoll & Rooney PC
Post Office Box 1404
Alexandria, VA 22313-1404

(For 95/001,363 Requester)

MAILED

DEC 28 2010

In re Anthony D. Minervini
Inter Partes Reexamination Proceeding
Control No.: 95/000,509
Filed: October 7, 2009
For: U.S. Patent No. 6,781,231

:
:
: **CENTRAL REEXAMINATION UNIT**
:
:

In re Anthony D. Minervini
Inter Partes Reexamination Proceeding
Control No.: 95/001,251
Filed: November 24, 2009
For: U.S. Patent No. 6,781,231

: **DECISION, *SUA SPONTE*,**
: **TO MERGE**
: **REEXAMINATION**
: **PROCEEDINGS**

In re Anthony D. Minervini
Inter Partes Reexamination Proceeding
Control No.: 95/001,363
Filed: June 30, 2010
For: US. Patent No. 6,781,231

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The above-captioned reexamination proceedings are before the Office of Patent Legal Administration for *sua sponte* consideration of whether the proceedings should be merged under 37 CFR 1.989.

BACKGROUND

1. U.S. Patent No. 6,781,231 (“the ‘231 patent”) issued to Anthony D. Minervini on August 24, 2004, with 22 claims.
2. A request for *inter partes* reexamination of claims 1-22 of the ‘231 patent was filed on October 7, 2009, by a third party requester, and was assigned control number 95/000,509 (“the ‘509 *inter partes* proceeding”). The real party in interest is Analog Devices, Inc.
3. On November 25, 2009, *inter partes* reexamination was ordered for claims 1-22 of the ‘231 patent based on the examiner’s determination that the October 7, 2009 request raised a substantial new question of patentability affecting these claims. The order was accompanied by an Office action rejecting Claims 1-4 and confirming the patentability of claims 5-22.
4. On January 28, 2010, patent owner submitted a response to the November 25, 2009 non-final rejection action. The January 28, 2010 patent owner response included the addition of new claims 23-26.
5. The ‘509 requester filed comments on February 24, 2010, on patent owner’s January 28, 2010 response.
6. A request for *inter partes* reexamination of claims 1-4 of the ‘231 patent was filed on November 24, 2009, by a third party requester, and was assigned control number 95/001,251 (“the ‘1251 *inter partes* proceeding”). The real party in interest is Wolfson Microelectronics, PLC.
7. On February 23, 2010, *inter partes* reexamination was ordered for claims 1-4 of the ‘231 patent based on the examiner’s determination that the November 24, 2009 request raised a substantial new question of patentability affecting these claims. The order was accompanied by a non-final an Office action rejecting Claims 1-4.
8. On April 26, 2010, patent owner submitted a response to the February 23, 2010 non-final rejection action. The April 26, 2010 patent owner response included the addition of new claims 23-26, which are identical to claims 23-26 added by patent owner in the January 28, 2010 response filed in the ‘509 *inter partes* proceeding.
9. The ‘1251 requester filed comments on May 21, 2010, on patent owner’s April 26, 2010 response.
10. A request for *inter partes* reexamination of claims 1-4 of the ‘231 patent was also filed on June 30, 2010, by a third party requester, and was assigned control number 95/001,363 (“the 1363 *inter partes* proceeding”). The real party in interest is BSE Co., Ltd.
11. On September 8, 2010, *inter partes* reexamination was ordered for claims 1-4 of the ‘231 patent based on the examiner’s determination that the June 30, 2010 request raised a substantial new question of patentability affecting these claims. No Office action has been issued in the ‘1363 proceeding.

DECISION

I. MERGER OF PROCEEDINGS

Reexamination has been ordered in three proceedings for overlapping claims of the same patent. All three proceedings are *inter partes* proceedings. All three proceedings are still pending, and have not been terminated. Therefore, consideration of merger pursuant to 37 CFR 1.989 is ripe at this point in time.

37 CFR 1.989 provides:

- (a) If any reexamination is ordered while a prior *inter partes* reexamination proceeding is pending for the same patent and prosecution in the prior *inter partes* reexamination proceeding has not been terminated, a decision may be made to merge the two proceedings or to suspend one of the two proceedings. Where merger is ordered, the merged examination will normally result in the issuance and publication of a single reexamination certificate under § 1.997.

In accordance with 37 CFR 1.989(a), the 95/000,509, 95/001,251 and 95/001,363 proceedings are merged. The merged proceeding will be conducted in accordance with the guidelines and requirements that follow.

II. THE SAME CLAIMS MUST BE MAINTAINED IN ALL THREE PROCEEDINGS

Patent owner is required to maintain the same claims (and specification) in all three files throughout the merged proceeding. Presently, the '509 and '1251 proceedings, but not the '1363 proceeding, include additional claims 23-26. Thus, the claims are not currently the same in all three files. An Office action requiring an amendment placing the claims in identical form is being issued concurrently with this decision. Patent owner must respond to the Office action in accordance with the procedures in 37 CFR 1.111. The third party requesters will then have an opportunity to comment on patent owner's response in accordance with the procedures in 37 CFR 1.947.

III. CONDUCT OF MERGED PROCEEDING

A. Governing regulations for the merged proceeding:

The present decision merges three *inter partes* reexamination proceedings. The merged proceeding is governed by 37 CFR 1.902 through 1.997. Pursuant to 37 CFR 1.989(a), the merged examination will normally result in the issuance and publication of a single reexamination certificate under 37 CFR 1.997.

It is noted that reexamination was ordered for claims 1-22 of the '231 patent in the '509 proceeding, for claims 1-4 of the '231 patent in the '1251 proceeding, and for claims 1-4 of the '231 patent in the '1363 proceeding. The examiner will conduct reexamination in the merged proceeding for claims 1-22 of the '231 patent and for the newly added claims 23-26.

B. Papers mailed/filed:

All papers mailed by the Office throughout the merged proceeding will take the form of a single action which applies to all three proceedings. All papers issued by the Office, or filed by the patent owner and the third party requester(s), will contain the identifying data for all three proceedings and will be entered in each reexamination file. All papers filed by the patent owner and the third party requester(s) must consist of a single paper, **filed in triplicate**, each bearing a signature and identifying data for all three proceedings, for entry into each file.

All papers filed by the patent owner and the third party requester(s) should be directed:

by Mail to: Attn: Mail Stop "Inter Partes Reexam"
Central Reexamination Unit
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

by FAX to: (571) 273-9900
Central Reexamination Unit

by Hand to: Customer Service Window
Attn: Central Reexamination Unit
Randolph Building, Lobby Level
401 Dulany Street
Alexandria, VA 22314

by EFS: Registered users may submit papers via the
electronic filing system EFS-Web, at:

<https://portal.uspto.gov/authenticate/authenticateuserlocalepf.html>

Patent owner and requester(s) are reminded that every paper filed in the merged proceeding subsequent to this decision must be served on the other parties, and every paper filed must reflect that such paper was served on the other parties, pursuant to 37 CFR 1.903. All papers are to be addressed to the Central Reexamination Unit as provided above.

C. Amendments:

The filing of any amendments to the specification, claims, or drawings must comply with 37 CFR 1.943, which incorporates the provisions of 37 CFR 1.530 and the guidelines of MPEP § 2666.01, which in turn references the guidelines of MPEP § 2250.

37 CFR 1.121 does not apply to amendments in reexamination. Accordingly, clean copies of the amended claims are not required and are not to be submitted; rather amendments are to be presented via markings pursuant to 37 CFR 1.530(f), except that a claim should be canceled by a statement canceling the claim, without presentation of the text of the claim.

Pursuant to 37 CFR 1.530(i), all amendments must be made relative to the patent specification, including the claims, and drawings, which are in effect as of the date of filing the request for reexamination. *Amendments are not to be made relative to previous amendments.* Thus, for all amendments, all words not appearing in the patent are always underlined, and only words being deleted from the patent appear in brackets.

D. Fees:

Where a paper is filed which requires payment of a fee (e.g., extension of time fee, excess claims fee, petition fee, appeal fee, brief fee, oral hearing fee), only a single fee need be paid. For example, only one fee need be paid for patent owner's appellant brief (or that of one of the *inter partes* reexamination requesters) which may be filed, even though the brief relates to merged multiple proceedings, and copies must be filed (as pointed out above) for each file in the merged proceeding.

E. Citation of Patents and Printed Publications:

Upon return of the present merged proceeding to the examiner, the examiner will review the files to ensure that each file contains identical citations of prior patents and printed publications, and will cite such documents as are necessary as part of the next action in order to place the files in that condition.

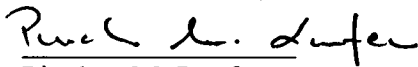
F. Appeal Procedure Reminders for *Inter Partes* Reexamination

The parties are reminded of the procedures for taking appeal in an *inter partes* reexamination as explained in MPEP 2674 and 2675. The appeal must only be taken from (1) the rejection(s) of the claims in the Right of Appeal Notice (RAN) that the *patent owner* proposes to contest, or (2) the finding(s) of patentability of claims in the RAN that the *third party requester* proposes to contest. Therefore, in the notice of appeal, the patent owner must identify each claim rejected by examiner that the patent owner intends to contest and the third party requester must identify each rejection *that was previously proposed by that third party requester* that the third party requester intends to contest. (37 CFR 41.61) The appellant's brief shall present a concise statement of each issue. Further, no new ground of rejection can be proposed by a third party requester appellant, unless such ground was withdrawn by the examiner during the prosecution of the proceeding, and the third party requester has not yet had an opportunity to propose it as a third party requester proposed ground of rejection. (37 CFR 41.67(c)(1)(vi))

CONCLUSION

1. *Inter partes* Reexamination Control No. 95/000,509, *inter partes* Reexamination No. 95/001,251 and *inter partes* Reexamination Control No. 95/001,363 are merged into a single proceeding, to be conducted in accordance with the procedure set forth above.

2. Any questions concerning this communication should be directed to Raul Tamayo in the Office of Patent Legal Administration, at (571) 272-7728.



Pinchus M. Laufer
Legal Advisor
Office of Patent Legal Administration

October 7, 2010



UNITED STATES PATENT AND TRADEMARK OFFICE

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95/001,251	11/24/2009	6,781,231	092771-0021D	6960
38939	7590	05/03/2011	EXAMINER	
DYKEMA GOSSETT PLLC 10 S. WACKER DR., STE. 2300 CHICAGO, IL 60606			ART UNIT	PAPER NUMBER

DATE MAILED: 05/03/2011

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95/001,363	06/30/2010	6,781,231	092771-0035	7421
38939	7590	05/03/2011	EXAMINER	
DYKEMA GOSSETT PLLC 10 S. WACKER DR., STE. 2300 CHICAGO, IL 60606			ART UNIT	PAPER NUMBER

DATE MAILED: 05/03/2011

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,509	10/07/2009	6781231	092771-0021C	5895
38939	7590	05/03/2011	EXAMINER	
DYKEMA GOSSETT PLLC 10 S. WACKER DR., STE. 2300 CHICAGO, IL 60606			ART UNIT	PAPER NUMBER

DATE MAILED: 05/03/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
LADAS & PARRY LLP
224 SOUTH MICHIGAN AVENUE
SUITE 1600
CHICAGO, IL 60604

Date: **MAILED**

MAY 03 2011

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001363
PATENT NO. : 6781231
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
SUNSTEIN KANN MURPHY & TIMBERS LLP
125 SUMMER STREET
BOSTON, MA 02110-1618

Date: MAILED
MAY 03 2017
CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000509
PATENT NO. : 6784231
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
WOLF GREENFIELD & SACKS, P.C.
600 ATLANTIC AVENUE
BOSTON, MA 02210-2206

Date: **MAILED**
MAY 03 2011

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001251
PATENT NO. : 6781231
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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DYKEMA GOSSETT PLLC
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CHICAGO, IL 60606

(For Patent Owner)

SUNSTEIN KANN MURPHY &
TIMBERS LLP
125 SUMMER STREET
BOSTON, MA 02110

(For 95/000,509 Requester)

MAILED
MAY 03 2011
CENTRAL REEXAMINATION UNIT

WOLF GREENFIELD & SACKS, P.C.
600 ATLANTIC AVE.
BOSTON, MA 02110

(For 95/001,251 Requester)

BUCHANAN, INGERSOLL &
ROONEY PC
POST OFFICE BOX 1404
ALEXANDRIA, VA 22313-1404

(For 95/001,363 Requester)

In re: Minervini
Inter Partes Reexamination Proceeding
Control No.: 95/000,509
Deposited: October 7, 2009
For: U.S. Patent No.: 6,781,231

DECISION ON PETITION

In re: Minervini
Inter Partes Reexamination Proceeding
Control No.: 95/001,251
Deposited: November 24, 2009
For: U.S. Patent No.: 6,781,231

In re: Minervini
Inter Partes Reexamination Proceeding
Control No.: 95/001,363
Deposited: June 30, 2010
For: U.S. Patent No.: 6,781,231

This is a decision on a petition filed by the patent owner on January 28, 2011, entitled "PETITION UNDER 37 C.F.R. § 1.182 TO STRIKE THIRD PARTY REQUESTER'S COMMENTS" [hereinafter "the petition"]. The petition is being treated as a petition under 37

C.F.R. § 1.181 as a request to the Director to exercise his discretion to review the allegedly improper entry of a paper into the record.

The petition is before the Director of the Central Reexamination Unit. The petition is dismissed.

REVIEW OF RELEVANT FACTS

- U.S. Patent No. 6,781,231 issued on August 24, 2004.
- A request for *inter partes* reexamination was filed October 7, 2009 and assigned control no. 95/000,509.
- A second request for *inter partes* reexamination met the requirements for receiving a filing date on November 24, 2009 and was assigned control no. 95/001,251.
- A third request for *inter partes* reexamination met the requirements for receiving a filing date on June 30, 2010 and was assigned control no. 95/001,363.
- *Inter partes* reexamination was ordered and prosecution progressed in each proceeding. The third party in the '1251 proceeding filed comments responsive to an Office action and patent owner response on May 21, 2010.
- The proceedings were merged in a decision mailed December 28, 2010.
- A Non-final Rejection was mailed on December 28, 2010 in the merged proceeding.
- On January 28, 2011, the instant petition was filed along with a response to the Office action

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

37 C.F.R. § 1.181 Petition to the Director

- (f) The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings. Any petition under this part not filed within two months of the mailing date of the action or notice from which relief is

requested may be dismissed as untimely, except as otherwise provided. This two-month period is not extendable.

37 C.F.R. § 1.182 Questions Not Specifically Provided For

All situations not specifically provided for in the regulations of this part will be decided in accordance with the merits of each situation by or under the authority of the Director, subject to such other requirements as may be imposed, and such decision will be communicated to the interested parties in writing. Any petition seeking a decision under this section must be accompanied by the petition fee set forth in § 1.17(f).

DECISION

Patent owner ["petitioner"] argues that the comments filed by the third party requester on May 21, 2010 are improper and should be stricken from the record as being longer than the permissible page limit, and also as being drawn beyond the permissible scope.

As a procedural matter, the petition was filed under 37 CFR § 1.182, which is reserved for questions that are not provided for in the regulations. The Office considers petitions to strike a paper as being properly filed under 37 CFR § 1.181, as this is considered the invocation of supervisory authority of the Director to review the allegedly improper entry of a paper into the record. Such a petition is therefore provided for elsewhere in the regulations and is not proper under 37 CFR § 1.182. The petition is treated as a petition under 37 CFR § 1.181.¹

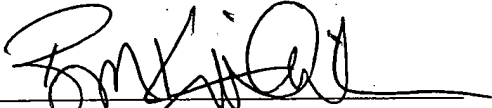
A paper such as a third party comments submission is entered into the record when it is filed. After the scanning period, the paper is available for viewing on public PAIR as a part of the reexamination record. Thus, the allegedly improper action, the entry of the paper into the record, took place on May 21, 2010, the filing date of the third party comments submission.

The petition was filed on January 28, 2011, nearly six months after the entry of the paper into the record. It was therefore not filed within two months of the act of entering the paper, from which relief is requested. The petition is therefore untimely under 37 CFR § 1.181(f), and is dismissed.

¹ Note that this does not change the result herein, as 1.182 petitions are also subject to the time limit discussed in this decision. "The 2-month period for filing timely petitions set forth in 37 CFR 1.181(f) applies to any petition under 37 CFR part 1, except as otherwise provided The 2-month time period in 37 CFR 1.181(f) applies to a petition under any section (e.g., 37 CFR 1.182 and 37 CFR 1.183) that does not specify the time period within which a petition must be filed." MPEP 1002.01.

CONCLUSION

1. The petition filed January 28, 2011 is dismissed as untimely.
2. Jurisdiction remains with the Central Reexamination Unit for consideration of the January 28, 2011 patent owner response and subsequent third party requester comments.
3. Telephone inquiries related to this decision should be directed to Mark Reinhart, Supervisory Patent Examiner, at (571) 272-1611 or in his absence to the undersigned at (571) 272-0700.

A handwritten signature in black ink, appearing to read 'B. Kisliuk', written over a horizontal line.

Bruce Kisliuk

Director, Central Reexamination Unit



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,251	11/24/2009	6,781,231	092771-0021D	6960
38939	7590	05/11/2011	EXAMINER	
DYKEMA GOSSETT PLLC 10 S. WACKER DR., STE. 2300 CHICAGO, IL 60606			ART UNIT	PAPER NUMBER

DATE MAILED: 05/11/2011

Please find below and/or attached an Office communication concerning this application or proceeding.



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,509	10/07/2009	6781231	092771-0021C	5895
38939	7590	05/11/2011	EXAMINER	
DYKEMA GOSSETT PLLC 10 S. WACKER DR., STE. 2300 CHICAGO, IL 60606			ART UNIT	PAPER NUMBER

DATE MAILED: 05/11/2011

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,363	06/30/2010	6,781,231	092771-0035	7421
38939	7590	05/11/2011	EXAMINER	
DYKEMA GOSSETT PLLC 10 S. WACKER DR., STE. 2300 CHICAGO, IL 60606			ART UNIT	PAPER NUMBER

DATE MAILED: 05/11/2011

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SUNSTEIN KANN MURPHY & TIMBERS LLP
125 SUMMER STREET
BOSTON, MA 02110-1618

Date:

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CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000509
PATENT NO. : 6784231
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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600 ATLANTIC AVENUE
BOSTON, MA 02210-2206

MAILED
Date: 10/11/2010
CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001251
PATENT NO. : 6781231
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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Date:

LADAS & PARRY LLP
224 SOUTH MICHIGAN AVENUE
SUITE 1600
CHICAGO, IL 60604

MAILED

MAY 11 2009

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester,
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001363

PATENT NO. : 6781231

TECHNOLOGY CENTER : 3999

ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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(For 95/001,251 Requester)

Ladas & Parry LLP
224 South Michigan Avenue
Suite 1600
Chicago, IL 60604

(For 95/001,363 Requester)

In re Minervini
Inter Partes Reexamination Proceeding
Control No. 95/000,509
Filed: October 7, 2009
For: U.S. Patent No. 6,781,231

In re Minervini
Inter Partes Reexamination Proceeding
Control No. 95/001,251
Filed: November 24, 2009
For: U.S. Patent No. 6,781,231

In re Minervini
Inter Partes Reexamination Proceeding
Control No. 95/001,363
Filed: June 30, 2010
For: U.S. Patent No. 6,781,231

: DECISION
: DISMISSING
: PETITION AND
: *SUA SPONTE* EXPUNGING
: IMPROPER PAPERS

This is a decision on the petition entitled “Petition under 37 CFR § 1.183 For Waiver of Page Limit”, filed on February 18, 2011, by the requester of *inter partes* reexamination proceeding control no. 95/001,251 (the February 18, 2011 requester petition).

The February 18, 2011 petition, and the record as a whole, are before the Office of Patent Legal Administration.

The petition fee of \$400.00 pursuant to 37 CFR 1.17(f) for the petition under 37 CFR 1.183 has been received.

SUMMARY

The February 18, 2011 petition, filed by the requester of *inter partes* reexamination proceeding control no. 95/001,251, is **dismissed**.

The May 21, 2010 and February 28, 2011 comments submissions, filed by the requester of *inter partes* reexamination proceeding control no. 95/001,251, ***facially*** fail to comply with Office regulations and procedures, are **improper**, and are being **sua sponte expunged** from the record due to their failure to comply, at a minimum, with MPEP 2617 and MPEP 2666.05. Because these papers have been scanned into the Office's electronic Image File Wrapper (IFW) system, they are being **expunged** from the record by marking the papers "closed" and "non-public," and will not constitute part of the record of the present reexamination proceeding.

DECISION

The February 18, 2011 Petition Under 37 CFR 1.183 to Waive the Page Length Requirements of 37 CFR 1.943(b)

In the instant petition, the requester requests that the Office waive the page length requirements of 37 CFR 1.943(b) for the comments submission filed on May 21, 2010 in *inter partes* reexamination control no. 95/001,251. The May 21, 2010 written comments submission is in excess of 50 pages.

37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party. The burden is on petitioner to set forth with specificity the facts that give rise to an extraordinary situation in which justice requires suspension of a rule. In the present case, however, the requester did not file its petition until nearly two months after a decision merging the '1251 proceeding with two other *inter partes* reexamination proceedings, control nos. 95/000,509 and 95/001,363, as well as a non-final Office action in the merged proceeding, had been mailed. Furthermore, the requester did not file its petition until ***nearly nine months after*** the filing of its comments submission, for which waiver of the rule is requested.

The requester argues that the present petition "is belated . . . because the Requester was unaware of the page limit at the time the Comments were filed". That the requester was unaware of the page limit requirements is not considered to reflect an extraordinary situation, such that justice requires waiver of the rule, particularly in view of requester's substantial delay in filing its petition.

Accordingly, the February 18, 2011 petition, filed by the requester of *inter partes* reexamination proceeding control no. 95/001,251, is **dismissed**.

Requester's May 21, 2010 and February 28, 2011 Comments Submissions Facially Fail to Comply with Office Regulations and Published Procedures

This decision addresses requester's comments submissions solely for the purpose of determining their compliance with the page length requirements of 37 CFR 1.943(b), and is not intended to provide a full analysis of requester's comments submissions for compliance with any other Office regulations or procedures. The Office, however, notes that requester's May 21, 2010 and February 28, 2011 comments submissions *facially* fail to comply with Office regulations and published procedures.

For example, requester's May 21, 2010 and February 28, 2011 comments submissions fail to comply with MPEP 2666.05 and MPEP 2617. See MPEP 2666.05 which provides, in pertinent part (emphasis added):

... where a newly proposed rejection is based on the newly presented prior patents and printed publications (art), **the third party requester must present the newly proposed rejection in compliance with the guidelines set forth in MPEP § 2617**, since any such new proposed rejection stands on the same footing as a proposed rejection presented with the request for reexamination, and is treated the same way as to future Office actions and any appeal. See MPEP § 2617 as to the required discussion of the pertinency of each reference to the patentability of at least one claim presented for the newly submitted prior art. An explanation pursuant to the requirements of 35 U.S.C. 311 of how the art is applied is no less important at this stage of the prosecution, than it is when filing the request.

Requester's comments submissions propose new grounds of rejection. The submissions, however, fail to provide a clear and complete explanation for every claim for which a rejection is proposed, due to the lumping together of the identification and explanation of multiple proposed rejections. See, for example, the rejections newly proposed on pages 47 and 14 of the May 21, 2010 and February 28, 2011 comments submissions, respectively, where the requester proposes a rejection over "the combination of **either** Torkkeli **or** Bamhauer with Sjursen".

Also, the requester's comments submissions do not clearly specify what new non-cumulative technological teaching, which forms the basis for a substantial new question (SNQ), is taught by at least one of the documents cited for *each* newly proposed ground of rejection. For at least one of the documents cited for each newly proposed ground of rejection, the requester must specify where, in the document, the new, non-cumulative technological teaching is provided within the document, preferably by column and line number (or by page number). If a ground of rejection citing only one document is newly proposed, the requester must specify where, in the document, the new, non-cumulative technological teaching is provided within the document, preferably by column and line number (or by page number).

Finally, the requester is reminded that a proper comments submission must specifically explain, for each newly proposed rejection, *how patent owner's amendment necessitated each newly proposed new ground of rejection*, and why each reference of any proposed combination is needed to address the amendment. **For each newly submitted document**, the requester must *specifically* explain a) how the presence of a teaching in the newly submitted document, if cited alone in a proposed rejection, **corresponds to at least one claim limitation newly added by**

patent owner's amendment, or b) if the newly submitted document is cited as one of the documents of a document combination, how the presence of a teaching in at least one of the documents of the document combination corresponds to at least one claim limitation newly added by patent owner's amendment. See MPEP 2666.05.

For the reasons given above, the May 21, 2010 and February 28, 2011 requester comments submissions *facially* fail to comply with Office regulations and procedures, are **improper**, and are being ***sua sponte expunged*** from the record due to their failure to comply, at a minimum, with MPEP 2617 and MPEP 2666.05. Because these papers have been scanned into the Office's electronic Image File Wrapper (IFW) system, they are being **expunged** from the record by marking the papers "closed" and "non-public," and will not constitute part of the record of the present reexamination proceeding.

This decision addresses requester's comments submissions solely for the purpose of determining their compliance with the page length requirements of 37 CFR 1.943(b), and is not intended to provide a full analysis of requester's comments submissions for compliance with any other Office regulations or procedures. The examiner should review all pending, and later-filed papers of record for compliance with Office regulations and published procedures.

Requester's Recourse

The requester is given **15 days to file a replacement comments submission**, which may include the content of both the May 21, 2010 and the February 28, 2010 comments submissions, including any appendices, **and any petition under 37 CFR 1.183 requesting waiver of the page length requirements of 37 CFR 1.943(b) for the replacement comments submission.** Any petition under 37 CFR 1.183 requesting waiver of the page length requirements is to be filed concurrently with the replacement comments submission for which waiver is requested.

This decision does **not** *sua sponte* waive the page length requirements of 37 CFR 1.943(b) with respect to any replacement comments submission that is filed in response to this decision, nor is this decision intended to imply a *sua sponte* waiver of any specific number of pages in excess of 50. The requester, in fact, should attempt to file a replacement comments submission within the regulatory 50-page limit.

In order to request waiver of the page length requirements pursuant to 37 CFR 1.183, if a waiver is needed, the requester is reminded that 37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party. **The burden is on the petitioner** to set forth with specificity the facts that give rise to an extraordinary situation in which justice requires suspension of a rule. A showing which petitioner can make in support of a request for waiver of the 50-page limit of 37 CFR 1.943(b) can be an attempt to draft a comments submission in compliance with the 50-page limit, and the filing of a resulting comments submission that is in excess of 50 pages concurrently with a petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b), requesting entry of the comments submission. Such a

submission can be evaluated for economizing, extraneous material,¹ and arrangement, without repetition of information already of record. In this way, petitioner can rely on the proposed submission: (1) for justification that more pages are needed to complete the submission, and (2) to set forth an accurate determination of exactly how many additional pages are needed to complete the submission.

The requester is also reminded that a document is deemed to be subject to the 50-page length requirement when the document includes legal argument, i.e., arguments of counsel such as, e.g., arguments that the claims are patentable or unpatentable, or that are directed to how an outstanding or proposed rejection is overcome, or, in the case of a document filed by the requester, how an outstanding or proposed rejection is supported. There are no *per se* rules for determining whether a document, such as an affidavit or declaration, contains a legal argument that will cause the document to be subject to the page count. Each determination of whether a document, such as an affidavit or declaration, contains information that will cause the document to be subject to the page count is made on a case-by-case basis. In determining whether a document such as an affidavit or declaration under 37 CFR 1.132, or any other document of a submission, includes legal argument, the Office analyzes whether the document is providing factual evidence, i.e., evidence of **technological** facts, or whether the document contains argument that is merely an extension of the arguments of counsel.² Factual evidence includes, for example, declarations that swear behind the filing date of a reference, that establish the date of a printed publication, that provide a technical explanation or technical definition of terms of art used by a reference, or that provide comparative test results and a scientific, or technological, analysis of the results (see, e.g., MPEP 716.02). If a document is limited to factual evidence, the document is not included in the page count. In addition, affidavits or declarations **limited to** establishing commercial success, long-felt need and failure of others, skepticism of experts, or copying, as per MPEP 716.03 -716.06, respectively, will not be included in the page count.

The requester is further reminded that, **in order to obtain a waiver of the 50-page length requirement of 37 CFR 1.943(b), any grantable petition under 37 CFR 1.183 must be accompanied by a requester comments submission that:**

- 1) is one-and-a-half or double-spaced;
- 2) is in a non-script type font (e.g., Arial, Times New Roman, or Courier);
- 3) has a font size no smaller than 12-point;
- 4) conforms to the margin requirements of 37 CFR 1.52(a)(1)(ii); and
- 5) has sufficient clarity and contrast to permit direct reproduction of readily legible copies in any number by use of photographic, electrostatic, photo-offset, and microfilming processes

¹ For example, a brief review of the May 21, 2010 comments submission reveals the presence of an entire section devoted to a legal analysis of the broadest reasonable interpretation standard, which may be considered to be extraneous material.

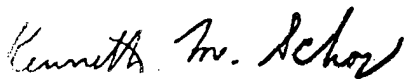
² For example, a brief review of the May 21, 2010 comments submission reveals the presence of a brief, submitted in the United States Court of Appeals for the Federal Circuit. The brief includes arguments regarding the invalidity of the patent under reexamination in this proceeding, and would, if later filed, be considered as replete with legal arguments that are an extension of the arguments of counsel, which would be counted toward the regulatory page limit.

and electronic capture by digital imaging and optical character recognition pursuant to 37 CFR § 1.52(a)(1)(v).

See, generally, 37 CFR 1.943(a) and 37 CFR 1.52.

CONCLUSION

- The February 18, 2011 petition under 37 CFR 1.183, filed by the requester of *inter partes* reexamination proceeding control no. 95/001,251, is **dismissed**.
- The May 21, 2010 and February 28, 2011 requester comments submissions *facially* fail to comply with Office regulations and procedures, are **improper**, and are being **sua sponte expunged** from the record due to their failure to comply, at a minimum, with MPEP 2617 and MPEP 2666.05. Because these papers have been scanned into the Office's electronic Image File Wrapper (IFW) system, they are being **expunged** from the record by marking the papers "closed" and "non-public," and will not constitute part of the record of the present reexamination proceeding.
- The requester of the '1251 *inter partes* reexamination proceeding is given **15 days to file a replacement comments submission** in this merged proceeding, pursuant to the guidance set forth in this decision, and to concurrently file **any petition under 37 CFR 1.183 requesting waiver of the page length requirements of 37 CFR 1.943(b) for the replacement comments submission**.
- If no response to this decision is timely filed by the requester of the '1251 *inter partes* reexamination proceeding, prosecution of this merged proceeding, including the mailing of an Office action, will proceed in due course, without consideration of the May 21, 2010 and February 28, 2010 comments submissions filed by the third party requester of the '1251 *inter partes* reexamination proceeding.
- Any inquiry concerning this communication should be directed to the undersigned at (571) 272-7724.



Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

5/10/11
Kenpet8



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,251	11/24/2009	6,781,231	092771-0021D	6960
38939	7590	06/27/2011	EXAMINER	
DYKEMA GOSSETT PLLC 10 S. WACKER DR., STE. 2300 CHICAGO, IL 60606			ART UNIT	PAPER NUMBER

DATE MAILED: 06/27/2011

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,509	10/07/2009	6781231	092771-0021C	5895
38939	7590	06/27/2011	EXAMINER	
DYKEMA GOSSETT PLLC 10 S. WACKER DR., STE. 2300 CHICAGO, IL 60606			ART UNIT	PAPER NUMBER

DATE MAILED: 06/27/2011

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,363	06/30/2010	6,781,231	092771-0035	7421
38939	7590	06/27/2011	EXAMINER	
DYKEMA GOSSETT PLLC 10 S. WACKER DR., STE. 2300 CHICAGO, IL 60606			ART UNIT	PAPER NUMBER

DATE MAILED: 06/27/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
SUNSTEIN KANN MURPHY & TIMBERS LLP
125 SUMMER STREET
BOSTON, MA 02110-1618

Date: **MAILED**
JUN 27 2011
CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000509
PATENT NO. : 6784231
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
WOLF GREENFIELD & SACKS, P.C.
600 ATLANTIC AVENUE
BOSTON, MA 02210-2206

Date:

MAILED

JUN 27 2011

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001251
PATENT NO. : 6781231
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

LADAS & PARRY LLP

224 SOUTH MICHIGAN AVENUE

SUITE 1600

CHICAGO, IL 60604

Date: **MAILED**

JUN 27 2011

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001363

PATENT NO. : 6781231

TECHNOLOGY CENTER : 3999

ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party. The burden is on petitioner to set forth with specificity the facts that give rise to an extraordinary situation in which justice requires suspension of a rule. A showing which petitioner can make in support of a request for waiver of the 50-page limit of 37 CFR 1.943(b) can be an attempt to draft a patent owner's response in compliance with the 50-page limit, and submission of a resulting response that is in excess of 50 pages concurrently with a petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b), requesting entry of the submitted response. Such a response can be evaluated for economizing, extraneous material, and arrangement, without repetition of information already of record. In this way, petitioner can rely on the proposed response: (1) for justification that more pages are needed to complete the response, and (2) to set forth an accurate determination of exactly how many additional pages are needed to complete the response.

In the instant petition under 37 CFR 1.183, the requester requests that the Office waive the page length requirements of 37 CFR 1.943(b). Specifically, the requester argues that the requester must present proposed rejections of newly added claims 23-27 (including independent claim 24), a detailed discussion of the newly added claims, and must also satisfy the applicable requirements of 37 CFR 1.948 and MPEP 2666.05.

A document is deemed to be subject to the 50-page length requirement when the document includes legal argument, i.e., arguments of counsel such as, e.g., arguments that the claims are patentable or unpatentable, or that are directed to how an outstanding or proposed rejection is overcome, or, in the case of a document filed by the requester, how an outstanding or proposed rejection is supported. There are no *per se* rules for determining whether a document, such as an affidavit or declaration, contains a legal argument that will cause the document to be subject to the page count. Each determination is made on a case-by-case basis. In determining whether a document such as an affidavit or declaration under 37 CFR 1.132, or any other document of a submission, includes legal argument, the Office analyzes whether the document is providing factual evidence, i.e., evidence of **technological** facts, or whether the document contains argument that is merely an extension of the arguments of counsel. Factual evidence includes, for example, declarations that swear behind the filing date of a reference, that establish the date of a printed publication, that provide a technical explanation or technical definition of terms of art used by a reference, or that provide comparative test results and a scientific, or technological, analysis of the results (see, e.g., MPEP 716.02). If a document is limited to factual evidence, the document is not included in the page count. In addition, affidavits or declarations **limited to** establishing commercial success, long-felt need and failure of others, skepticism of experts, or copying, as per MPEP 716.03 -716.06, respectively, will not be included in the page count.

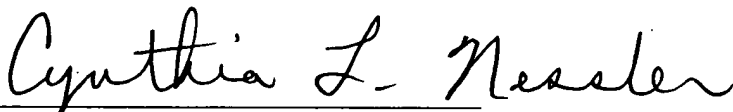
In support of its request for waiver of 37 CFR 1.943(b), the requester has submitted, on May 25, 2011, a comments submission that is in excess of 50 pages. Upon brief review, the May 26, 2011 comments submission includes 50 pages of comments and an eight-page declaration under 37 CFR 1.132 of Dr. Khalil Najafi. The 50 pages of comments are included in the page count. Two pages, i.e., pages 7 and 8, of the declaration under 37 CFR 1.132 of Dr. Khalil Najafi are deemed to be an extension of the arguments of counsel (see, for example, the heading "Obvious Design Choices and Modifications", and, for example, the following statements: "It would have

been obvious to provide solder pads on the bottom of the package of Sjursen . . . to achieve a package that can be mounted to [the] next level of interconnection from the underside” (paragraph 20); “and therefore the use of a printed circuit board as a package substrate is a matter of design choice” (paragraph 21). Thus, the 50 pages of comments and the two pages of the Najafi declaration, resulting in a total of 52 pages, are included in the page count.

Based on the individual facts and circumstances of this case including, for example, the five claims, including one independent claim, newly added by the patent owner, it is deemed equitable to waive the 50-page limit of 37 CFR 1.943(b) in this instance. Thus, even though requester’s May 26, 2011 comments submission exceeds the 50-page limit, it is still deemed equitable in this instance to waive the 50-page limit of 37 CFR 1.943(b) to the extent that the pages of requester’s comments submission that are deemed to be subject to the page limit not exceed 52 pages. Accordingly, requester’s petition under 37 CFR 1.183 is granted and the page limit of 37 CFR 1.943(b) is waived to the extent that requester’s May 26, 2011 comments submission may exceed the page limit by up to 52 pages. This waiver makes requester’s May 26, 2011 comments submission page-length compliant.

CONCLUSION

- The May 26, 2011 requester petition is granted and the page limit of 37 CFR 1.943(b) is waived to the extent that requester’s May 26, 2011 comments submission may exceed the page limit by up to 52 pages. This waiver makes requester’s May 26, 2011 comments submission page-length compliant.
- Any inquiry concerning this communication should be directed to the undersigned at (571) 272-7724.



Cynthia L. Nessler
Senior Legal Advisor
Office of Patent Legal Administration

6/26/11



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,254	02/17/2010	6953262	1781.020	4448
24350	7590	10/26/2010	EXAMINER	
STITES & HARBISON, PLLC 400 W MARKET ST SUITE 1800 LOUISVILLE, KY 40202-3352			ART UNIT	PAPER NUMBER

DATE MAILED: 10/26/2010

Please find below and/or attached an Office communication concerning this application or proceeding.



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
BOYLE FREDRICKSON S.C.
840 NORTH PLANKINTON AVENUE
MILWAUKEE, WI 53203

Date:

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OCT 26 2010

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001254
PATENT NO. : 6953262
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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OCT 26 2010

CENTRAL REEXAMINATION UNIT

STITES & HARBISON, PLLC
400 W MARKET ST
SUITE 1800
LOUISVILLE, KY 40202-3352

(For Patent Owner)

BOYLE FREDRICKSON S.C.
840 NORTH PLANKINTON AVENUE
MILWAUKEE, WI 53203

(For Third Party Requester)

In re Cleaver et al.
Inter Partes Reexamination Proceeding
Control No. 95/001,254
Filed: February 17, 2010
For: U.S. Patent No. 6,953,262

: **DECISION DISMISSING**
: **PETITION, EXPUNGING**
: **IMPROPER PAPER, AND**
: **SUA SPONTE WAIVING**
: **PATENT OWNER**
: **PAGE LIMIT**

This is a decision on the August 24, 2010 patent owner petition entitled "PETITION TO WAIVE PAGE LIMIT PURSUANT TO 37 C.F.R. § 1.183." The petition requests waiver of the requirement of 37 CFR 1.943(b) that the July 22, 2010 patent owner response not exceed fifty (50) pages in length.

The petition is before the Office of Patent Legal Administration for consideration.

The petition is dismissed for the reasons set forth below.

However, the present decision *sua sponte* waives the requirement of 37 CFR 1.943(b) to the extent that the page limit for any resubmitted patent owner response to the April 22, 2010 Office action is not to exceed 100 pages in length. **This waiver is conditional on the resubmitted patent owner response being in at least 12 point font and one-and-a-half or double spaced, with appropriate margins.**

For the reasons set forth below, the July 22, 2010 patent owner response is being expunged from the record without consideration by the examiner. Since the July 22, 2010 patent owner paper has been scanned into the Image File Wrapper (IFW) of the 95/001,254 *inter partes* reexamination proceeding, the July 22, 2010 paper is being expunged from the record by closing it and marking it "not public" in the IFW of the 95/001,254 *inter partes* reexamination proceeding.

Patent owner has **fifteen (15) days (not-extendable)** from the mailing date of this decision to re-submit a response to the non-final Office action, as discussed below.

If a resubmitted patent owner response pursuant to this decision is timely received, then under 37 CFR 1.947, the third party requester may once file written comments, limited to issues raised by the Office action or the patent owner's response to this decision, **within 30 days from the date of service of the patent owner's response to this decision.**

FEES

The petition fee of \$400.00 pursuant to 37 CFR 1.17(f) for patent owner's petition under 37 CFR 1.183 has been paid.

REVIEW OF THE RELEVANT FACTS

1. On October 11, 2005, United States Patent Number 6,953,262 (the '262 patent) issued.
2. On November 4, 2009, a request for *inter partes* reexamination of the '262 patent was deposited by a third party requester, which request was assigned Reexamination Control No. 95/001,254 ("the '1254 proceeding").
3. On February 17, 2010, a corrected request for *inter partes* reexamination of the '262 patent was filed by the third party requester in the '1254 proceeding, resulting in the proceeding being granted a filing date of February 17, 2010.
4. On April 13, 2010, the Office issued an order granting *inter partes* reexamination in the '1254 proceeding.
5. On April 22, 2010, the Office mailed a non-final Office action.
6. On May 27, 2010, patent owner filed a request for a one-month extension of time pursuant to 37 CFR 1.956 for filing a response to the April 22, 2010 non-final Office action.
7. On May 28, 2010, the Office mailed a decision granting the requested one-month extension, setting the response due date to July 22, 2010.
8. On July 22, 2010, patent owner timely filed a response to the Office action.
9. On August 23, 2010, the third party requester timely filed comments after patent owner's response.
10. On August 24, 2010, patent owner filed the instant petition entitled "PETITION TO WAIVE PAGE LIMIT PURSUANT TO 37 C.F.R. § 1.183."

DECISION

I. Relevant Regulations and Procedure

37 CFR 1.183 provides:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 CFR 1.943(b) provides:

Responses by the patent owner and written comments by the third party requester shall not exceed 50 pages in length, excluding amendments, appendices of claims, and reference materials such as prior art references.

MPEP § 2667(I), (TYPES OF PAPERS RETURNED WITH CENTRAL REEXAMINATION UNIT DIRECTOR OR REEXAMINATION LEGAL ADVISOR APPROVAL REQUIRED), provides in pertinent part:

Where the length of the patent owner submission exceeds that permitted by 37 CFR 1.943, the submission is improper. Accordingly, pursuant to 37 CFR 1.957(d), a Notice will be mailed to the patent owner. The Notice will be issued by the examiner and will permit the patent owner to exercise one of the following two options:

- (A) Submit a re-drafted response that does not exceed the page limit set by 37 CFR 1.943; or
- (B) File a copy of the supplemental response with pages redacted to satisfy the 37 CFR 1.943 page limit requirement.

The Notice will set a period of 15 days from the date of the notice to respond. If no response is received, the improper patent owner submission will not be considered. If the submission was necessary to respond to an outstanding Office action, the prosecution of the reexamination proceeding is either terminated pursuant to 37 CFR 1.957(b) or limited pursuant to 37 CFR 1.957(c). Any previously submitted third party comments in response to this improper patent owner submission would also not be considered, as being moot, since the patent owner did not in fact respond to the Office action in accordance with the rules.

If a response to the Notice is received, then under 37 CFR 1.947, the third party requester may once file written comments, limited to issues raised by the Office action or the patent owner's response to the Notice, within 30 days from the date of service of the patent owner's response to the Notice.

Any affidavit or declaration (or a clearly defined portion thereof) that contains opinion(s) of the affiant/declarant, or argument(s) that the art either does or does not anticipate or render obvious the claims, or specific claim elements, of the patent under reexamination, is considered to be part of the comments submitted by the patent owner, or by the third party requester, and is subject to the page limit requirements of 37 CFR 1.943. Affidavits or declarations that are excluded from the page limit

requirements include, for example, declarations attempting to swear behind (antedate) the filing date of a reference, or to establish the date of a printed publication, or declarations that provide comparative test data and an analysis of same. However, if the patent owner's affidavit or declaration includes any argument as to how an outstanding/proposed rejection is overcome, then the page(s) of the affidavit or declaration upon which the argument appears would be included against of the page limit count. Likewise, if a third party requester affidavit or declaration includes any argument as to how a rejection is supported, then the page(s) of the affidavit or declaration upon which the argument appears would be included against of the page limit count. Similarly, attached exhibits presenting data or drawings are not included against the page limit count, unless an exhibit or drawing includes argument as to how the outstanding rejection is overcome. Any page(s) of the exhibit or sheet(s) of drawings that include such argument would be included against the page limit count.

II. Patent Owner's Petition

In the instant petition, patent owner requests waiver of the requirement under 37 CFR 1.943(b) with respect to the 50-page limit for patent owner's response filed on July 22, 2010 to address the April 22, 2010 non-final Office action. In support of its request for waiver of the rule, patent owner argues that the April 22, 2010 Office action adopts twenty-eight different grounds of rejection, which rely on nine different prior art references.¹ Furthermore, patent owner argues that in the Office action, "the Examiner relied on various portions of and exhibits to the request for reexamination, which collectively included hundreds of pages of documents."²

III. Analysis and Findings

The instant petition under 37 CFR 1.183 has been fully considered. In this instance, petitioner patent owner's July 22, 2010 response includes 133 pages of remarks, which are subject to the 50 page limit. The following sections of the response are not included in the page limit: the cover page, the three pages of claim appendices, and the certificate of service page.

The patent owner response is also accompanied by a declaration of Mark Cleaver under 37 CFR 1.132. It is noted that, any portion of an affidavit/declaration that does not strictly adhere to presenting and explaining the evidence is subject to the 50-page limit of 37 CFR 1.943. Thus, opinion evidence that goes beyond explaining the evidence - legal assertions and conclusions, e.g. assertions of obviousness and anticipation, are counted as remarks, and are thus part of the 50-page limit of 37 CFR 1.943. The declaration of Mark Cleaver does not contain any legal arguments. Therefore, the July 22, 2010 patent owner response is 133 pages in length.

A review of the submitted patent owner remarks for economizing reveals that there is extraneous material and repetition throughout the remarks. For example, the first twenty-two pages of the remarks are devoted to providing the background and description of the invention and summary of the teachings of the prior art references that were applied in the grounds of rejection set forth in the non-final Office action. A substantial portion of the teachings and figures of the applied references are repeated in the remarks.

¹ Petition at page 1.

² *Id.*

In comparison, the April 22, 2010 non-final Office action is 32 pages in length and incorporates 68 pages by reference of the request. The Office action is effectively 100 pages in length. The Office action sets forth 28 grounds of rejection based on nine references for claims 1-8 of the patent under reexamination.

37 CFR 1.183 permits waiver of the page limitation requirement of the regulations in an extraordinary situation when justice requires. Under the facts and circumstances currently of record in the present *inter partes* reexamination proceeding, patent owner has failed to persuasively establish the existence of an extraordinary situation requiring waiver of the page limit requirements for its 133 page response to a 100 page Office action that sets forth prior art rejections based on 9 references for 8 claims of the patent under reexamination.

Therefore, the patent owner's request to waive 37 CFR 1.943(b), to permit its July 22, 2010 response of 133 pages is **dismissed**.

The patent owner's July 22, 2010 response is 133-pages, which greatly exceeds the 37 CFR 1.943(b) 50-page limit. Therefore, the entire patent owner submission filed on July 22, 2010, is subject to return to the patent owner. See MPEP 2667, Part I.A.2. The copy of the July 22, 2010 submission was, however, scanned into the electronic Image File Wrapper (IFW) of the proceeding, before the discovery of the impropriety. Thus, the copy cannot be physically returned to the patent owner. Rather, the IFW copy of the paper is being expunged, by closing it in the IFW file of the present proceeding and marking it "not public." It will not constitute part of the record of the present reexamination proceeding.

In a balancing of the equities, the Office *sua sponte* waives the 50-page limit requirement under 37 CFR 1.943(b) for any resubmitted patent owner response to the April 22, 2010 Office action, up to the length of the April 22, 2010 non-final Office action, which by this decision is determined to be 100 pages.. **This waiver is conditional on the resubmitted patent owner response being in at least 12 point font and one-and-a-half or double spaced, with appropriate margins.**

The August 23, 2010 third party requester comments filed in response to the improper July 22, 2010 patent owner response will not be considered.

PATENT OWNER OPTIONS

For the reasons given above, the July 22, 2010 patent owner response exceeds the 50-page limit established by 37 CFR 1.943(b). It is apparent, however, from the record that patent owner's response is a *bona fide* attempt to respond and to advance the prosecution.

Accordingly, patent owner may, **within 15 days from the date of this decision**, exercise one of the following two options:

1. Submit a re-drafted response that does not exceed the 100 page limit set forth in this decision; or,

2. File a copy of the original response, with pages redacted to satisfy the 100-page limit set forth in this decision.

This 15-day period for reply is **not extendable**.

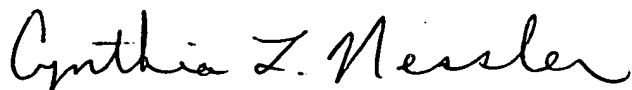
REQUESTER OPTIONS

If a resubmitted patent owner response pursuant to this decision is timely received, then under 37 CFR 1.947, the **third party requester** may once file written comments, limited to issues raised by the Office action or the patent owner's response to this decision, **within 30 days from the date of service of the patent owner's response to this decision**.

CONCLUSION

1. The patent owner's petition under 37 CFR 1.183 is dismissed. Patent owner's July 22, 2010 response is an improper paper, and therefore will NOT be made a part of the record of the '1254 proceeding.
2. Since the July 22, 2010 patent owner response was scanned into the electronic Image File Wrapper (IFW) of the '1254 proceeding, the paper is expunged by closing it in the '1254 reexamination proceeding's IFW file and marking it as "non-public."
3. No copy of the July 22, 2010 patent owner response will be maintained in the record, or elsewhere in the Office.
4. The August 23, 2010 third party requester comments filed in response to the improper July 22, 2010 patent owner response will not be considered.
5. This decision *sua sponte* waives the provisions of 37 CFR 1.943(b) to the extent that any resubmitted response by patent owner to the April 22, 2010 Office action, filed in response to this decision, shall not exceed 100 pages in length. **This waiver is conditional on the submission of the patent owner being in at least 12 point font and one-and-a-half or double spaced, with appropriate margins.**
6. Patent owner is given a 15-day non-extendable time period to resubmit a response to this decision. If no response is timely received from the patent owner, the July 22, 2010 patent owner response will remain expunged, and the proceeding will be terminated or limited pursuant to 37 CFR 1.957.
7. If a resubmitted patent owner response pursuant to this decision is timely received, then under 37 CFR 1.947, the third party requester may once file written comments, limited to issues raised by the April 22, 2010 Office action or by patent owner's response to this Office action, **within 30 days from the date of service of the resubmitted patent owner response, filed pursuant to this decision.**

7. Telephone inquiries related to the present decision should be directed to the Susy Tsang-Foster, Legal Advisor, at 571-272-7711.



Cynthia L. Nessler
Senior Legal Advisor
Office of Patent Legal Administration

10-18-10
Kenpet8/



UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

AFS/ANGIODYNAMICS
666 Third Avenue
Floor 10
New York, NY 10017

(For Patent Owner)

MAILED

SEP 17 2010

CENTRAL REEXAMINATION UNIT

Brad D. Pedersen
PATTERSON, THUENTE, SKAAR
& CHIRSTENSEN, P.A.
80 South 8th Street, 4800 IDS Center
Minneapolis, MN 55402

(For Requester)

In re Appling et al.
Reexamination Proceeding
Control No.: 95/001,256
Filing Date: November 6, 2009
For: U.S. Patent No.: 7,273,478

:
: DECISION
: DISMISSING
: PETITION
:

The above reexamination proceeding is before the Director of the Central Reexamination Unit after receipt of a July 28, 2010 patent owner petition, which is being treated as a petition under 37 CFR § 1.181 to invoke supervisory authority to not enter the third party requester's revised comments, dated July 23, 2010. This decision also addresses the two third party requester's petitions of August 27, 2010.

The patent owner's petition is dismissed as premature.

The third party requester's petitions are dismissed as premature.

BACKGROUND


1. U.S. Patent No. 7,273,478 (hereinafter, the '478 patent) issued on September 25, 2007.
2. On November 6, 2009, a request for *inter partes* reexamination of the '478 patent was filed. The request was assigned Control No. 95/001,256 (the '256 proceeding).
3. On December 18, 2009, *inter partes* reexamination was ordered for the '256 proceeding. On the same day, a non-final Office action was mailed in the '256 proceeding.
4. On February 18, 2010, patent owner filed a response to the December 18, 2009 Office action and concurrently filed a petition entitled, "PETITION UNDER 37 CFR 1.183 FOR ADDITIONAL PAGES."
5. On March 19, 2010, third party requested submitted responsive comments.
6. On June 8, 2010, a decision dismissing the February 18, 2010 petition was mailed. This decision gave patent owner 15 days to submit a corrected response.
7. On June 23, 2010, patent owner filed a corrected response.
8. On July 23, 2010, third party requester filed revised comments in the '256 proceeding in response to the June 23, 2010 patent owner's response.
9. On July 28, 2010, patent owner filed the present petition, which is being treated as a petition under 37 CFR 1.181 to invoke supervisory authority to not enter the third party requester's revised comments, dated July 23, 2010.
10. On August 27, 2010, third party requester filed a petition under 37 CFR 1.183 for suspension of the rules to permit consideration of a petition under 37 CFR 1.182 and a petition under 37 CFR 1.182 opposing patent owner's July 28, 2010 petition.

DECISION

As pointed out, the patent owner filed a July 28, 2010 petition, which is being treated as a petition under 37 CFR 1.181 to invoke supervisory authority to not enter the third party requester's revised comments, dated July 23, 2010. The third party requester filed petitions to oppose the patent owner's petition to not enter the third party requester's revised comments. However, there has been no decision by the examiner if the third party requester's revised comments are in compliance with Office rules and procedures. Accordingly, it is premature to invoke supervisory authority regarding entry or refusal to enter the revised comments because the examiner has not made his or her decision. Thus, the patent owner's July 28, 2010 petition and the third party requester's August 27, 2010 petitions are premature, and they are dismissed.

CONCLUSION

1. The July 28, 2010 patent owner's petition, which is treated as a petition under 37 CFR § 1.181, is dismissed.
2. The August 27, 2010 third party requester's petitions are dismissed.
3. Should the examiner enter the third party requester's revised comments into the record, the patent owner could submit a petition under 37 CFR 1.181 and third party requester could submit petitions under 37 CFR 1.182 and 1.183.
4. Telephone inquiries related to this decision should be directed Andy Kashnikow, Supervisory Patent Examiner, at (571) 272-4361.



Gregory Morse

Director

Central Reexamination Unit



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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P.O. Box 1450
Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,256	11/06/2009	7273478	P-32-RE/210657	8095
76147	7590	02/16/2011	EXAMINER	
AFS / ANGIODYNAMICS 666 THIRD AVENUE FLOOR 10 NEW YORK, NY 10017			ART UNIT	PAPER NUMBER

DATE MAILED: 02/16/2011

Please find below and/or attached an Office communication concerning this application or proceeding.



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Date: 2-16-11

Brad D. Pedersen

PATTERSON, THUENTE, SKAAR & CHRISTENSEN, P.A.

80 South 8th Street, 4800 IDS CENTER

Minneapolis, MN 55402

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001256

PATENT NO. : 7273478

TECHNOLOGY CENTER : 3999

ART UNIT : 3993

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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FEB 16 2011

CENTRAL REEXAMINATION UNIT

AFS / Angiodynamics
666 Third Avenue
Floor 10
New York, NY 10017

(For Patent Owner)

Brad D. Pedersen
Patterson, Thunte, Skaar Christensen, P.A.
80 South 8th Street, 4800 IDS Center
Minneapolis, MN 55402

(For Third Party Requester)

In re Appling *et al.*

Inter Partes Reexamination Proceeding

Control No: 95/001,256

Filing Date: November 6, 2009

For: U.S. Patent No.: 7,273,478

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**DECISION GRANTING
PETITION TO TERMINATE
INTER PARTES PROCEEDING**

This is a decision on the patent owner petition filed on December 23, 2010, entitled "Consented-To Petition Under 35 U.S.C. § 317(b) and 37 CFR § 1.182 To Terminate *Inter Partes* Reexamination."

The petition is before the Office of Patent Legal Administration for consideration as to whether the relief requested by patent owner is to be granted.

The patent owner's petition is **granted**.

BACKGROUND

1. Patent number 7,273,478 B2 (the '478 patent) issued on September 25, 2007, the patent having claims 1-5.
2. On June 3, 2009, the patent owner disclaimed claims 1, 2, and 3 under 37 C.F.R. § 1.321(a).
3. On July 29, 2009, the '478 patent became the subject of a litigation proceeding, which, upon transfer of venue, became styled *Angiodynamics v. Vascular Solutions*, U.S. District Court of Minnesota, docketed as 0:10cv3601.
4. On November 6, 2009, a request for *inter partes* reexamination of claims 4 and 5 of the '478 patent (the only "live" claims) was filed by third party requester Vascular Solutions ("VSI")

as the real party in interest. This request was accorded reexamination control number 95/001,256 (“the ‘1256 reexamination”), and reexamination was ordered on December 18, 2009. A nonfinal Office action was mailed on that same date. On November 8, 2010, an Action Closing Prosecution (“ACP”) was issued in the ‘1256 reexamination. The ACP stated that no claims have been amended or added in the reexamination proceeding, and that each rejection made in the ACP was a rejection reiterated from the Office action mailed December 18, 2009.

5. On December 1, 2009, Vascular Solutions (“VSI”) filed, in the litigation (in the court proceeding), an answer including contentions of invalidity as to claims 4 and 5 of the ‘478 patent. This answer referenced VSI’s prior-filed request for *inter partes* reexamination. On February 23, 2010, Angiodynamics filed a paper in the court proceeding that included, as Exhibit I, the patent owner’s response to the nonfinal Office action in the ‘1256 reexamination.
6. On December 23, 2010, an order for judgment was entered in *Angiodynamics v. Vascular Solutions*, *supra*.
7. On December 23, 2010, the instant petition was filed in the reexamination proceeding.
8. On December 27, 2010, judgment was entered in *Angiodynamics v. Vascular Solutions*, *supra*, setting forth the following:
 - a. VSI has not sustained its burden of proving the invalidity of claims 4 or 5 of the ‘478 patent.
 - b. Claims 4 and 5 of the ‘478 patent are valid and enforceable.
 - c. VSI’s counterclaims are dismissed with prejudice.
 - d. This consent judgment is, and is intended to be, final, enforceable, and nonappealable. The parties expressly waive their rights to appeal.

DECISION

I. Pertinent Regulations

35 U.S.C. § 317 states:

(a) ORDER FOR REEXAMINATION. — Notwithstanding any provision of this chapter, once an order for *inter partes* reexamination of a patent has been issued under section 313, neither the third-party requester nor its privies may file a subsequent request for *inter partes* reexamination of the patent until an *inter partes* reexamination certificate is issued and published under section 316, unless authorized by the Director.

(b) FINAL DECISION. — Once a **final decision has been entered against a party** in a civil action arising in whole or in part under section 1338 of title 28, **that the party has not**

sustained its burden of proving the invalidity of any patent claim in suit or if a final decision in an *inter partes* reexamination proceeding instituted by a third-party requester is favorable to the patentability of any original or proposed amended or new claim of the patent, then neither that party nor its privies may thereafter request an *inter partes* reexamination of any such patent claim on the basis of issues which that party or its privies raised or could have raised in such civil action or *inter partes* reexamination proceeding, and an *inter partes* reexamination requested by that party or its privies on the basis of such issues may not thereafter be maintained by the Office, notwithstanding any other provision of this chapter. This subsection does not prevent the assertion of invalidity based on newly discovered prior art unavailable to the third-party requester and the Patent and Trademark Office at the time of the *inter partes* reexamination proceedings. (Emphasis added)

37 CFR § 1.182 states:

All situations not specifically provided for in the regulations of this part will be decided in accordance with the merits of each situation by or under the authority of the Director, subject to such other requirements as may be imposed, and such decision will be communicated to the interested parties in writing. Any petition seeking a decision under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 C.F.R. § 1.907 states:

(a) Once an order to reexamine has been issued under § 1.931, neither the third party requester, nor its privies, may file a subsequent request for *inter partes* reexamination of the patent until an *inter partes* reexamination certificate is issued under § 1.997, unless authorized by the Director.

(b) Once a **final decision has been entered against a party** in a civil action arising in whole or in part under 28 U.S.C. 1338 **that the party has not sustained its burden of proving invalidity of any patent claim-in-suit**, then neither that party nor its privies may thereafter request *inter partes* reexamination of any such patent claim on the basis of issues which that party, or its privies, raised or could have raised in such civil action, and an *inter partes* reexamination requested by that party, or its privies, on the basis of such issues may not thereafter be maintained by the Office.

(c) If a final **decision** in an *inter partes* reexamination proceeding instituted by a third party requester is favorable to patentability of any original, proposed amended, or new claims of the patent, then neither that party nor its privies may thereafter request *inter partes* reexamination of any such patent claims on the basis of issues which that party, or its privies, raised or could have raised in such *inter partes* reexamination proceeding. (Emphasis added)

MPEP 2686.04(V) states, in pertinent part:

[T]he following factors are to be considered in determining whether it is appropriate to refuse to order an *inter partes* reexamination, terminate the reexamination, or suspend action in the reexamination, based on litigation in which the reexamination requester is a party to the litigation.

(A) The 35 U.S.C. 317(b) estoppel applies only to patent claims that were litigated in the suit, i.e., litigated claims. The estoppel does not apply to non-litigated patent claims. Where there are non-litigated claims for which reexamination had been requested in the inter partes reexamination request, the reexamination proceeding is to go forward based on those non-litigated claims. If, however, during the reexamination proceeding, the patent owner disclaimed all the non-litigated claims, leaving only litigated claims, the proceeding is to be referred to the Office of Patent Legal Administration (OPLA).

(B) The 35 U.S.C. 317(b) estoppel applies only to issues which the requester or its privies raised or could have raised in the civil action. The estoppel does not apply where new issues are raised in the request. If the request provides new art/issues not raised in the litigation (civil action), and which could not have been so raised, then estoppel does not attach. The patent owner has the burden of showing that the art and issues applied in the request was available to the third-party requester and could have been placed in the litigation.

(C) The 35 U.S.C. 317(b) estoppel applies only in a situation where a final decision adverse to the requester has already been issued. If there remains any time for an appeal, or a request for reconsideration, from a court (e.g., District Court or Federal Circuit) decision, or such action has already been taken, then the decision is not final, and the estoppel does not attach. A stay/suspension of action may be appropriate for the reexamination proceeding if the litigation has advanced to a late enough stage and there is sufficient probability that a final decision will be adverse to the requester; however, that is a matter to be discussed with the OPLA in any such instance.

(D) Is there a concurrent ex parte reexamination proceeding for the patent? As stated in MPEP § 2286: "The issuance of a final Federal Court decision upholding validity during an ex parte reexamination also will have no binding effect on the examination of the reexamination. This is because the court states in *Ethicon v. Quigg*, 849 F.2d 1422, 1428, 7 USPQ2d 1152, 1157 (Fed. Cir. 1988) that the Office is not bound by a court's holding of patent validity and should continue the reexamination." If there is a concurrent ex parte reexamination proceeding having overlapping issues with an inter partes reexamination proceeding where the estoppel has the potential to attach, but no final decision has been issued, then the Office may in some instances (depending on the individual facts and circumstances), to go forward with statutorily required "special dispatch" as per *Ethicon* in a merged proceeding containing both the inter partes reexamination and the ex parte reexamination. This is a matter of administrative convenience to avoid rework and make the process more efficient. Again, OPLA should be consulted.

II. Findings and Analysis

Petitioner patent owner requests that this *inter partes* reexamination proceeding be terminated following the conclusion of the litigation proceedings between the patent owner and the real party in interest in the '1256 reexamination in the civil proceeding *Angiodynamics v. Vascular Solutions*, U.S. District Court of Minnesota, docketed as 0:10cv3601. This proceeding was concluded with the issuance of a Judgment on December 27, 2010.

The MPEP sets forth four requirements for termination of an *inter partes* reexamination proceeding based upon estoppel pursuant to § 317(b). In this instance, each requirement is met, as detailed below.

First, the estoppel only applies to litigated claims; thus, the proceeding will not be terminated if other (non-litigated) claims remain in the reexamination. In the present case, claims 4 and 5 were litigated, and only claims 4 and 5 are in the '1256 reexamination. Therefore, this requirement is met.

Second, the estoppel applies only to issues which the requester or its privies raised or could have raised in the civil action, and not where new issues/art are raised in the request. In the present case, the invalidity contentions set forth in VSI's December 1, 2009 in the civil action referred directly to the issues and art raised in the reexamination request.¹ No new art or grounds of rejection were made beyond those present in the initial request for reexamination.² Therefore, there are no issues or art present in the reexamination that were unknown to VSI at the time VSI asserted its invalidity contentions in the civil action, as evidenced by VSI's statements in its December 1, 2009 filing in the civil action. This requirement is also met.

Third, the estoppel only applies where a decision adverse to the requester has been issued, and that decision is final. In the present case, the December 27, 2010 judgment is stated to be final and nonappealable, with the parties having expressly waived their rights of appeal. The December 27, 2010 judgment is adverse to requester VSI; it states that "VSI has not sustained its burden of proving the invalidity of claims 4 or 5 of the '478 patent." This requirement is therefore met.

Fourth, the estoppel may not attach, in some instances, where there is a concurrent *ex parte* reexamination for the patent. In the present case, there is no concurrent *ex parte* reexamination for the patent. This requirement is therefore also met.

Therefore, in accordance with 35 U.S.C. § 317(b), the instant '1256 *inter partes* reexamination proceeding may no longer be maintained by the Office.

For conclusion of the proceeding: The CRU will mail the present decision and process the reexamination file to update the Image File Wrapper (IFW) records for this proceeding. The terminated proceeding will be assigned an 820 status. A copy of the PALM "Application Number Information" screen and the "Contents" screen will be printed, the printed copy will be annotated by adding the comment "PROCEEDING CONCLUDED," and the annotated copy will then be scanned into Image File Wrapper (IFW) using the miscellaneous letter document code.

CONCLUSION

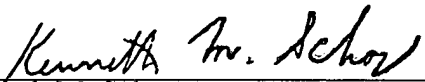
1. The patent owner petition for termination filed on December 23, 2010 is **granted**.

¹ "Answer and Counterclaim of Defendant Vascular Solutions, Inc.," December 1, 2009, *Angiodynamics v. Vascular Solutions*, U.S. District Court of Minnesota, docketed as 0:10cv3601.

² See Action Closing Prosecution, November 8, 2010.

2. The Central Reexamination Unit will proceed with appropriate action to terminate the instant proceedings. The terminated proceeding will be assigned an 820 status. A copy of the PALM "Application Number Information" screen and the "Contents" screen will be printed, the printed copy will be annotated by adding the comment "PROCEEDING CONCLUDED," and the annotated copy will then be scanned into Image File Wrapper (IFW) using the miscellaneous letter document code.
3. Any further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop
Commissioner for Patents
Post Office Box 1450
Alexandria, VA 22313-1450
4. Telephone inquiries related to this decision should be directed to Michael Cygan, Legal Advisor, at (571) 272-7700.


Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

February 15, 2011
Kenpet8



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CENTRAL REEXAMINATION UNIT

Brad D. Pedersen
PATTERSON, THUENTE, SKAAR
& CHIRSTENSEN, P.A.
80 South 8th Street, 4800 IDS Center
Minneapolis, MN 55402

(For Requester)

In re Appling et al.
Reexamination Proceeding
Control No.: 95/001,257
Filing Date: November 6, 2009
For: U.S. Patent No.: 7,559,329

:
: DECISION
: DISMISSING
: PETITION
:

The above reexamination proceeding is before the Director of the Central Reexamination Unit after receipt of a July 28, 2010 patent owner petition, which is being treated as a petition under 37 CFR § 1.181 to invoke supervisory authority to not enter the third party requester's revised comments, dated July 23, 2010. This decision also addresses the two third party requester's petitions of August 27, 2010.

The patent owner's petition is dismissed as premature.

The third party requester's petitions are dismissed as premature.

BACKGROUND

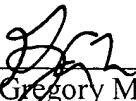
1. U.S. Patent No. 7,559,329 (hereinafter, the '329 patent) issued on July 14, 2009.
2. On November 6, 2009, a request for *inter partes* reexamination of the '329 patent was filed. The request was assigned Control No. 95/001,257 (the '257 proceeding).
3. On January 8, 2010, *inter partes* reexamination was ordered for the '257 proceeding. On the same day, a non-final Office action was mailed in the '257 proceeding.
4. On March 8, 2010, patent owner filed a response to the January 8, 2010 Office action and concurrently filed a petition entitled, "PETITION UNDER 37 CFR 1.183 FOR ADDITIONAL PAGES."
5. On April 6, 2010, third party requested submitted responsive comments.
6. On June 8, 2010, a decision dismissing the March 8, 2010 petition was mailed. This decision gave patent owner 15 days to submit a corrected response.
7. On June 23, 2010, patent owner filed a corrected response.
8. On July 23, 2010, third party requester filed revised comments in the '257 proceeding in response to the June 23, 2010 patent owner's response.
9. On July 28, 2010, patent owner filed the present petition, which is being treated as a petition under 37 CFR 1.181 to invoke supervisory authority to not enter the third party requester's revised comments, dated July 23, 2010.
10. On August 27, 2010, third party requester filed a petition under 37 CFR 1.183 for suspension of the rules to permit consideration of a petition under 37 CFR 1.182 and a petition under 37 CFR 1.182 opposing patent owner's July 28, 2010 petition.

DECISION

As pointed out, the patent owner filed a July 28, 2010 petition, which is being treated as a petition under 37 CFR 1.181 to invoke supervisory authority to not enter the third party requester's revised comments, dated July 23, 2010. The third party requester filed petitions to oppose the patent owner's petition to not enter the third party requester's revised comments. However, there has been no decision by the examiner if the third party requester's revised comments are in compliance with Office rules and procedures. Accordingly, it is premature to invoke supervisory authority regarding entry or refusal to enter the revised comments because the examiner has not made his or her decision. Thus, the patent owner's July 28, 2010 petition and the third party requester's August 27, 2010 petitions are premature, and they are dismissed.

CONCLUSION

1. The July 28, 2010 patent owner's petition, which is treated as a petition under 37 CFR § 1.181, is dismissed.
2. The August 27, 2010 third party requester's petitions are dismissed.
3. Should the examiner enter the third party requester's revised comments into the record, the patent owner could submit a petition under 37 CFR 1.181 and third party requester could submit petitions under 37 CFR 1.182 and 1.183.
4. Telephone inquiries related to this decision should be directed Andy Kashnikow, Supervisory Patent Examiner, at (571) 272-4361.



Gregory Morse
Director
Central Reexamination Unit



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,257	11/16/2009	M 7559329	P-32CONT-RE/210646	8155
76147	7590	02/16/2011	EXAMINER	
AFS / ANGIODYNAMICS 666 THIRD AVENUE FLOOR 10 NEW YORK, NY 10017			ART UNIT	PAPER NUMBER

DATE MAILED: 02/16/2011

Please find below and/or attached an Office communication concerning this application or proceeding.



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Brad D. Pedersen

Patterson, Thunte, Skaar & Christensen, P.A.

80 South 8th Street, 4800 IDS Center

Minneapolis, MN 55402-2100

Date:

MAILED

FEB 16 2011

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001257

PATENT NO. : 7559329

TECHNOLOGY CENTER : 3999

ART UNIT : 3993

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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(For Patent Owner)

FEB 16 2011

CENTRAL REEXAMINATION UNIT

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80 South 8th Street, 4800 IDS Center
Minneapolis, MN 55402

(For Third Party Requester)

In re Appling *et al.*
Inter Partes Reexamination Proceeding
Control No: 95/001,257
Filing Date: November 16, 2009
For: U.S. Patent No.: 7,559,329

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**DECISION GRANTING
PETITION TO TERMINATE
INTER PARTES PROCEEDING**

This is a decision on the patent owner petition filed on December 23, 2010, entitled "Consented-To Petition Under 35 U.S.C. § 317(b) and 37 C.F.R. § 1.182 To Terminate *Inter Partes* Reexamination."

The petition is before the Office of Patent Legal Administration for consideration as to whether the relief requested by patent owner is to be granted.

The patent owner's petition is **granted**.

BACKGROUND

1. Patent number 7,559,329 B2 (the '329 patent) issued on July 14, 2009, the patent having claims 1-31.
2. On July 29, 2009, the '329 patent became the subject of a litigation proceeding, which, upon transfer of venue, became styled *Angiodynamics v. Vascular Solutions*, U.S. District Court of Minnesota, docketed as 0:10cv3601.
3. On November 16, 2009, a request for *inter partes* reexamination of claims 1-31 of the '478 patent (all of the patent claims) was filed by third party requester Vascular Solutions ("VSI") as the real party in interest. This request was accorded reexamination control number 95/001,257 ("the '1257 reexamination"), and reexamination was ordered on January 8, 2010.

A nonfinal Office action was mailed on that same date. On November 8, 2010, an Action Closing Prosecution (“ACP”) was issued in the ‘1257 reexamination. The ACP stated that no claims have been amended or added in the reexamination proceeding, and that each rejection made in the ACP was a rejection reiterated from the Office action mailed January 8, 2010.

4. On December 1, 2009, Vascular Solutions (“VSI”) filed, in the litigation (in the court proceeding), an answer including contentions of invalidity as to claims 1-31 of the ‘329 patent. This answer referenced VSI’s prior-filed request for *inter partes* reexamination. On February 23, 2010, Angiodynamics filed a paper in the court proceeding that included, as Exhibit I, the patent owner’s response to the nonfinal Office action in the ‘1257 reexamination.
5. On December 23, 2010, an order for judgment was entered in *Angiodynamics v. Vascular Solutions*, *supra*.
6. On December 23, 2010, the instant petition was filed in the reexamination proceeding.
7. On December 27, 2010, judgment was entered in *Angiodynamics v. Vascular Solutions*, *supra*, setting forth the following:
 - a. VSI has not sustained its burden of proving the invalidity of claims 1-31 of the ‘329 patent.
 - b. Claims 1-31 of the ‘329 patent are valid and enforceable.
 - c. VSI’s counterclaims are dismissed with prejudice.
 - d. This consent judgment is, and is intended to be, final, enforceable, and nonappealable. The parties expressly waive their rights to appeal.

DECISION

I. Pertinent Regulations

35 U.S.C. § 317 states:

(a) ORDER FOR REEXAMINATION. — Notwithstanding any provision of this chapter, once an order for *inter partes* reexamination of a patent has been issued under section 313, neither the third-party requester nor its privies may file a subsequent request for *inter partes* reexamination of the patent until an *inter partes* reexamination certificate is issued and published under section 316, unless authorized by the Director.

(b) FINAL DECISION. — Once a **final decision has been entered against a party** in a civil action arising in whole or in part under section 1338 of title 28, **that the party has not sustained its burden of proving the invalidity of any patent claim in suit** or if a final decision in an *inter partes* reexamination proceeding instituted by a third-party requester is

favorable to the patentability of any original or proposed amended or new claim of the patent, then neither that party nor its privies may thereafter request an *inter partes* reexamination of any such patent claim on the basis of issues which that party or its privies raised or could have raised in such civil action or *inter partes* reexamination proceeding, and an *inter partes* reexamination requested by that party or its privies on the basis of such issues may not thereafter be maintained by the Office, notwithstanding any other provision of this chapter. This subsection does not prevent the assertion of invalidity based on newly discovered prior art unavailable to the third-party requester and the Patent and Trademark Office at the time of the *inter partes* reexamination proceedings. (Emphasis added)

37 CFR § 1.182 states:

All situations not specifically provided for in the regulations of this part will be decided in accordance with the merits of each situation by or under the authority of the Director, subject to such other requirements as may be imposed, and such decision will be communicated to the interested parties in writing. Any petition seeking a decision under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 C.F.R. § 1.907 states:

(a) Once an order to reexamine has been issued under § 1.931, neither the third party requester, nor its privies, may file a subsequent request for *inter partes* reexamination of the patent until an *inter partes* reexamination certificate is issued under § 1.997, unless authorized by the Director.

(b) Once a **final decision has been entered against a party** in a civil action arising in whole or in part under 28 U.S.C. 1338 **that the party has not sustained its burden of proving invalidity of any patent claim-in-suit**, then neither that party nor its privies may thereafter request *inter partes* reexamination of any such patent claim on the basis of issues which that party, or its privies, raised or could have raised in such civil action, and an *inter partes* reexamination requested by that party, or its privies, on the basis of such issues may not thereafter be maintained by the Office.

(c) If a final **decision** in an *inter partes* reexamination proceeding instituted by a third party requester is favorable to patentability of any original, proposed amended, or new claims of the patent, then neither that party nor its privies may thereafter request *inter partes* reexamination of any such patent claims on the basis of issues which that party, or its privies, raised or could have raised in such *inter partes* reexamination proceeding. (Emphasis added)

MPEP 2686.04(V) states, in pertinent part:

[T]he following factors are to be considered in determining whether it is appropriate to refuse to order an *inter partes* reexamination, terminate the reexamination, or suspend action in the reexamination, based on litigation in which the reexamination requester is a party to the litigation.

(A) The 35 U.S.C. 317(b) estoppel applies only to patent claims that were litigated in the suit, i.e., litigated claims. The estoppel does not apply to non-litigated patent claims. Where there are non-litigated claims for which reexamination had been requested in the *inter partes*

reexamination request, the reexamination proceeding is to go forward based on those non-litigated claims. If, however, during the reexamination proceeding, the patent owner disclaimed all the non-litigated claims, leaving only litigated claims, the proceeding is to be referred to the Office of Patent Legal Administration (OPLA).

(B) The 35 U.S.C. 317(b) estoppel applies only to issues which the requester or its privies raised or could have raised in the civil action. The estoppel does not apply where new issues are raised in the request. If the request provides new art/issues not raised in the litigation (civil action), and which could not have been so raised, then estoppel does not attach. The patent owner has the burden of showing that the art and issues applied in the request was available to the third-party requester and could have been placed in the litigation.

(C) The 35 U.S.C. 317(b) estoppel applies only in a situation where a final decision adverse to the requester has already been issued. If there remains any time for an appeal, or a request for reconsideration, from a court (e.g., District Court or Federal Circuit) decision, or such action has already been taken, then the decision is not final, and the estoppel does not attach. A stay/suspension of action may be appropriate for the reexamination proceeding if the litigation has advanced to a late enough stage and there is sufficient probability that a final decision will be adverse to the requester; however, that is a matter to be discussed with the OPLA in any such instance.

(D) Is there a concurrent ex parte reexamination proceeding for the patent? As stated in MPEP § 2286: "The issuance of a final Federal Court decision upholding validity during an ex parte reexamination also will have no binding effect on the examination of the reexamination. This is because the court states in *Ethicon v. Quigg*, 849 F.2d 1422, 1428, 7 USPQ2d 1152, 1157 (Fed. Cir. 1988) that the Office is not bound by a court's holding of patent validity and should continue the reexamination." If there is a concurrent ex parte reexamination proceeding having overlapping issues with an inter partes reexamination proceeding where the estoppel has the potential to attach, but no final decision has been issued, then the Office may in some instances (depending on the individual facts and circumstances), to go forward with statutorily required "special dispatch" as per *Ethicon* in a merged proceeding containing both the inter partes reexamination and the ex parte reexamination. This is a matter of administrative convenience to avoid rework and make the process more efficient. Again, OPLA should be consulted.

II. Findings and Analysis

Petitioner patent owner requests that this *inter partes* reexamination proceeding be terminated following the conclusion of the litigation proceedings between the patent owner and the real party in interest in the '1257 reexamination in the civil proceeding *Angiodynamics v. Vascular Solutions*, U.S. District Court of Minnesota, docketed as 0:10cv3601. This proceeding was concluded with the issuance of a Judgment on December 27, 2010.

The MPEP sets forth four requirements for termination of an *inter partes* reexamination proceeding based upon estoppel pursuant to § 317(b). In this instance, each requirement is met, as detailed below.

First, the estoppel only applies to litigated claims; thus, the proceeding will not be terminated if other (non-litigated) claims remain in the reexamination. In the present case, claims 1-31 were litigated, and only claims 1-31 are in the '1257 reexamination. Therefore, this requirement is met.

Second, the estoppel applies only to issues which the requester or its privies raised or could have raised in the civil action, and not where new issues/art are raised in the request. In the present case, the invalidity contentions set forth in VSI's December 1, 2009 in the civil action referred directly to the issues and art raised in the reexamination request.¹ No new art or grounds of rejection were made beyond those present in the initial request for reexamination.² Therefore, there are no issues or art present in the reexamination that were unknown to VSI at the time VSI asserted its invalidity contentions in the civil action, as evidenced by VSI's statements in its December 1, 2009 filing in the civil action. This requirement is also met.

Third, the estoppel only applies where a decision adverse to the requester has been issued, and that decision is final. In the present case, the December 27, 2010 judgment is stated to be final and nonappealable, with the parties having expressly waived their rights of appeal. The December 27, 2010 judgment is adverse to requester VSI; it states that "VSI has not sustained its burden of proving the invalidity of claims 1-31 of the '329 patent." This requirement is therefore met.

Fourth, the estoppel may not attach, in some instances, where there is a concurrent *ex parte* reexamination for the patent. In the present case, there is no concurrent *ex parte* reexamination for the patent. This requirement is therefore also met.

Therefore, in accordance with 35 U.S.C. § 317(b), the instant '1257 *inter partes* reexamination proceeding may no longer be maintained by the Office.

For conclusion of the proceeding: The CRU will mail the present decision and process the reexamination file to update the Image File Wrapper (IFW) records for this proceeding. The terminated proceeding will be assigned an 820 status. A copy of the PALM "Application Number Information" screen and the "Contents" screen will be printed, the printed copy will be annotated by adding the comment "PROCEEDING CONCLUDED," and the annotated copy will then be scanned into Image File Wrapper (IFW) using the miscellaneous letter document code.

CONCLUSION

1. The patent owner petition for termination filed on December 23, 2010 is **granted**.
2. The Central Reexamination Unit will proceed with appropriate action to terminate the instant proceedings. The terminated proceeding will be assigned an 820 status. A copy of the PALM "Application Number Information" screen and the "Contents" screen will be printed, the

¹ "Answer and Counterclaim of Defendant Vascular Solutions, Inc.," December 1, 2009, *Angiodynamics v. Vascular Solutions*, U.S. District Court of Minnesota, docketed as 0:10cv3601.

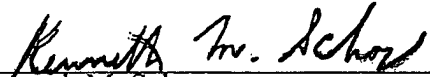
² See Action Closing Prosecution, November 8, 2010.

printed copy will be annotated by adding the comment "PROCEEDING CONCLUDED," and the annotated copy will then be scanned into Image File Wrapper (IFW) using the miscellaneous letter document code.

3. Any further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop
Commissioner for Patents
Post Office Box 1450
Alexandria, VA 22313-1450

4. Telephone inquiries related to this decision should be directed to Michael Cygan, Legal Advisor, at (571) 272-7700.


Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

February 15, 2011
Kenpet8



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,260	12/04/2009	7277765	51200-86407	4766
26162	7590	12/13/2011	EXAMINER	
FISH & RICHARDSON PC P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022			ART UNIT	PAPER NUMBER

DATE MAILED: 12/13/2011

Please find below and/or attached an Office communication concerning this application or proceeding.



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Matthew J. Himich
THOMPSON COBURN LLP
ONE US BANK PLAZA, SUITE 3500
ST. LOUIS, MO 63101-1693

Date:

MAILED

DEC 13 2011

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001260
PATENT NO. : 7277765
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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DEC 13 2011

FISH & RICHARDSON PC
PO BOX 1022
MINNEAPOLIS, MN 55440-1022

: (For Patent Owner)

CENTRAL REEXAMINATION UNIT

THOMPSON COBURN LLP
ONE US BANK PLAZA
SUITE 3500
ST LOUIS, MO 63101

: (For Third-Party Requester)

In re BECKMANN
Reexamination Proceeding
Control No. 95/001,260
Request Deposited: December 12, 2009
For: U.S. Patent No. 7,277,765

: DECISION ON
: PETITION REQUESTING
: ENTRY OF
: DECLARATION
:

This is a decision on the petition filed on October 29, 2010 by which Patent Owner requests entry of declaration, waiver of prohibition of an extension of time for filing an appeal brief, and extension of time period of time to file appeal brief. The petition is considered pursuant to 37 CFR 1.181.

The petition is dismissed.

REVIEW OF RELEVANT FACTS

1. Reexamination of U.S. Patent No. 7,277,765 was ordered in the Order mailed January 13, 2010, which was accompanied by a first non-final office action.
2. On March 15, 2010, Patent Owner responded to the first office action and included a Declaration from Paul Beckmann. Third Party Requester then filed remarks on April 14, 2010.
3. On June 7, 2010, an Action Closing Prosecution was mailed. Patent Owner responded on July 7, 2010, and included a second Declaration from Paul Beckmann. This was followed by Third Party Requesters filed remarks on August 6, 2010.

Art Unit: 3992

4. On September 29, 2010, a Right of Appeal Notice (RAN) was mailed maintaining all rejections. In the RAN, the examiner did not enter the second Beckmann Declaration.
5. A Notice of Appeal was filed on October 29, 2010. This was followed by and Appeal Brief on December 17, 2010, a Respondent Brief on January 18, 2011, an Examiners Answer on September 28, 2011, and a Rebuttal Brief on October 28, 2011. In the Examiners Answer from September 28, 2011, the examiner entered and considered the second Beckmann declaration into the record as attached comments.
6. On November 30, 2011, an Appeal Docketing Notice indicated that the appeal has been assigned to the Board of Patent Appeals and Interferences.

DECISION

37 CFR 1.951(a) states:

§1.951 Options after Office action closing prosecution in inter partes reexamination. (a) After an Office action closing prosecution in an inter partes reexamination, the patent owner may once file comments limited to the issues raised in the Office action closing prosecution. The comments can include a proposed amendment to the claims, which amendment will be subject to the criteria of § 1.116 as to whether or not it shall be admitted. The comments must be filed within the time set for response in the Office action closing prosecution.

In view of the relevant facts above, the examiner, in the Examiners Answer mailed September 28, 2011, has entered and considered the second Beckmann Declaration of July 7, 2010.

Accordingly, the request for entry of declaration is moot. The case has been forwarded to the Board of Patent Appeals and Interferences.

Additionally, as Patent Owner's Appeal Brief was timely filed on December 17, 2010, the request to waive the prohibition of time for filing an appeal brief, as well as the request to extend the period of time for filing Patent Owner's appeal brief until after a decision on the petition to enter the second Beckmann Declaration, are moot.

CONCLUSION

1. Petitioner's request is **DISMISSED**.
2. **All** correspondence relating to this *inter partes* reexamination proceeding should be directed:

By EFS: Registered users may submit via the electronic filing system EFS-Web, at <https://efs.uspto.gov/efile/myportal/efs-registered>

By Mail to: Mail Stop *Inter Partes* Reexam

Art Unit: 3992

Central Reexamination Unit
Commissioner for Patents
United States Patent & Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

By FAX to: (571) 273-9900
Central Reexamination Unit

By hand: Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

For EFS-Web transmissions, 37 CFR 1.8(a)(1)(i) (C) and (ii) states that correspondence (except for a request for reexamination and a corrected or replacement request for reexamination) will be considered timely filed if (a) it is transmitted via the Office's electronic filing system in accordance with 37 CFR 1.6(a)(4), and (b) includes a certificate of transmission for each piece of correspondence stating the date of transmission, which is prior to the expiration of the set period of time in the Office action.

3. Telephone inquiries related to this decision should be directed to Alexander Kosowski, at (571) 272-3744, Mark Reinhart, at (571) 272-1611 or Sudhanshu Pathak at (571) 272-5509.

This decision is final and nonappealable. See 37 CFR 1.927. No further communication on this matter will be acknowledged or considered.



Irem Yuçel
Director, Central Reexamination Unit



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(For Patent Owner)

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(NDQ Reexamination Group)
1000 Louisiana Street
Fifty-Third Floor
Houston, TX 77002

(For Requester)

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JAN 12 2011

CENTRAL REEXAMINATION UNIT

In re White et al
Inter Partes Reexamination Proceeding
Control No. 95/001,262
Filed: November 13, 2009
For: U.S. Patent No. 7,187,947

:
: **DECISION**
: **GRANTING**
: **PETITION**
:

This is a decision on requester's petition entitled "Petition under 37 C.F.R. § 1.183 to Waive the Provisions of 37 C.F.R. § 1.943(b) to Increase the Number of Pages Permitted for Requester's Written Comments Beyond the 50-Page Limitation", filed on August 4, 2010 (the August 4, 2010 requester petition).¹

The August 4, 2010 requester petition, and the record as a whole, are before the Office of Patent Legal Administration.

The petition fee of \$400.00 pursuant to 37 CFR 1.17(f) for the petition under 37 CFR 1.183 has been received.

DECISION

Requester's August 4, 2010 petition under 37 CFR 1.183, requesting waiver of the 50-page limit of 37 CFR 1.943(b) for its comments filed on August 25, 2010, has been fully considered.

37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party. The burden is on petitioner to set forth with specificity the facts that give rise to an extraordinary situation in which justice requires suspension of a rule. A showing which petitioner can make in support of a request for waiver of the 50-page limit of 37 CFR 1.943(b) can be an attempt to draft a patent owner's response in compliance with the 50-page limit, and submission of a resulting response that is in excess of 50 pages concurrently with a petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b), requesting entry of the submitted response. Such a response can be evaluated for economizing, extraneous material, and arrangement, without repetition of information already of record. In this way, petitioner can rely on the proposed response: (1) for justification that more pages are needed to complete the

¹ A copy of the August 4, 2010 requester petition, designated as Exhibit A, also accompanied requester's comments filed August 25, 2010.

response, and (2) to set forth an accurate determination of exactly how many additional pages are needed to complete the response.

In the instant petition under 37 CFR 1.183, the requester requests that the Office waive the page length requirements of 37 CFR 1.943(b). Specifically, the requester argues that the requester must present proposed rejections of newly added claims 43-64, a detailed discussion of the newly added claims, and must also satisfy any applicable requirements of 37 CFR 1.948(a).

A document is deemed to be subject to the 50-page length requirement when the document includes legal argument, i.e., arguments of counsel such as, e.g., arguments that the claims are patentable or unpatentable, or that are directed to how an outstanding or proposed rejection is overcome, or, in the case of a document filed by the requester, how an outstanding or proposed rejection is supported. There are no *per se* rules for determining whether a document, such as an affidavit or declaration, contains a legal argument that will cause the document to be subject to the page count. Each determination is made on a case-by-case basis. In determining whether a document such as an affidavit or declaration under 37 CFR 1.132, or any other document of a submission, includes legal argument, the Office analyzes whether the document is providing factual evidence, i.e., evidence of **technological** facts, or whether the document contains argument that is merely an extension of the arguments of counsel. Factual evidence includes, for example, declarations that swear behind the filing date of a reference, that establish the date of a printed publication, that provide a technical explanation or technical definition of terms of art used by a reference, or that provide comparative test results and a scientific, or technological, analysis of the results (see, e.g., MPEP 716.02). If a document is limited to factual evidence, the document is not included in the page count. In addition, affidavits or declarations **limited to** establishing commercial success, long-felt need and failure of others, skepticism of experts, or copying, as per MPEP 716.03 -716.06, respectively, will not be included in the page count.

In support of its request for waiver of 37 CFR 1.943(b), the requester has submitted, on August 25, 2010, a comments submission that is in excess of 50 pages.² Upon brief review, the August 25, 2010 comments submission includes 66 pages of comments and a 22-page declaration under 37 CFR 1.132 of Dr. Bruce Maggs. The 66 pages of comments are included in the page count. The declaration under 37 CFR 1.132 of Dr. Bruce Maggs is replete with arguments that are deemed to be an extension of the arguments of counsel, i.e., arguments that the claims of the '947 patent are obvious, or that one of ordinary skill would have been motivated to combine the teachings of the prior art (see, e.g., headings A – G, and paragraphs 10, 12, 20, 29, 31, 33-36, 39, 40, 45, 46, 51, 57, 58, 60, 61, and 68), causing the entirety of the declaration to be subject to the page count. Thus, the 66 pages of comments and the 22-page Maggs declaration, resulting in a total of 88 pages, are included in the page count.

Based on the individual facts and circumstances of this case including, for example, the 21 claims newly added by the patent owner, it is deemed equitable to waive the 50-page limit of 37

² The Office notes that had the requester failed to submit a comments submission, for which the present petition requests waiver of the page length requirements, the above analysis of the comments submission would not have been possible, resulting in the likelihood of a dismissal of the present petition. For this reason, a petition under 37 CFR 1.183 should be filed concurrently with the comments (or response) submission to which it pertains.

CFR 1.943(b) in this instance. Thus, even though requester's August 25, 2010 comments submission exceeds the 50-page limit, it is still deemed equitable in this instance to waive the 50-page limit of 37 CFR 1.943(b) to the extent that requester's comments not exceed 88 pages. Accordingly, requester's petition under 37 CFR 1.183 is granted and the page limit of 37 CFR 1.943(b) is waived to the extent of permitting requester's comments submission to exceed the page limit by up to 38 pages. This waiver makes requester's August 25, 2010 comments submission page-length compliant.

CONCLUSION

- The August 4, 2010 requester petition is granted and the page limit of 37 CFR 1.943(b) is waived to the extent of permitting requester's August 25, 2010 comments submission to exceed the page limit by up to 38 pages. This waiver makes requester's August 25, 2010 comments submission page-length compliant.
- Any inquiry concerning this communication should be directed to the undersigned at (571) 272-7724.



Cynthia L. Nessler
Senior Legal Advisor
Office of Patent Legal Administration

1/10/11



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(For Patent Owner)

Novak Druce & Quigg, LLP
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Fifty-Third Floor
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(For Requester)

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JAN 12 2011

CENTRAL REEXAMINATION UNIT

In re White et al
Inter Partes Reexamination Proceeding
Control No. 95/001,262
Filed: November 13, 2009
For: U.S. Patent No. 7,187,947

:
: **DECISION**
: **DISMISSING**
: **PETITION**
:

This is a decision on patent owner's petition entitled "Petition under 37 C.F.R. § 1.183 to Waive Page Limit Requirements for the Patent Owner Reply under 37 C.F.R. § 1.943(b)" filed on August 17, 2010.

The August 17, 2010 patent owner petition is before the Office of Patent Legal Administration.

The petition fee of \$400.00 pursuant to 37 CFR 1.17(f) for the petition under 37 CFR 1.183 has been received.

SUMMARY

The August 17, 2010 patent owner petition under 37 CFR 1.183 is **dismissed as moot**.

DECISION

Patent owner's August 17, 2010 petition under 37 CFR 1.183, requesting waiver of the 50-page limit of 37 CFR 1.943(b) for its response to the May 24, 2010 Office action, has been fully considered.

37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party. The burden is on petitioner to set forth with specificity the facts that give rise to an extraordinary situation in which justice requires suspension of a rule. A showing which petitioner can make in support of a request for waiver of the 50-page limit of 37 CFR 1.943(b) can be an attempt to draft a patent owner's response in compliance with the 50-page limit, and submission of a resulting response that is in excess of 50 pages concurrently with a petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b), requesting entry of the submitted response. Such a response can be evaluated for economizing, extraneous material, and arrangement, without repetition of information already of record. In this way, petitioner can rely

on the proposed response: (1) for justification that more pages are needed to complete the response, and (2) to set forth an accurate determination of exactly how many additional pages are needed to complete the response.

In the instant petition under 37 CFR 1.183, the patent owner “requests entry of the Reply to Office Action that exceeds the 50 page limit by 35 pages, with a filing that includes 85 pages that are subject to the page limit of 37 CFR § 1.943(b)”. Patent owner’s July 23, 2010 and July 26, 2010 responses to the May 24, 2010 Office action, however, are determined to comply with 37 CFR 1.943(b).

A document is deemed to be subject to the 50-page length requirement when the document includes legal argument, such as arguments that the claims are patentable or unpatentable, or that are directed to how an outstanding or proposed rejection is overcome, or, in the case of a document filed by the requester, how an outstanding or proposed rejection is supported. There are no *per se* rules for determining whether a document, such as an affidavit or declaration, contains a legal argument that will cause the document to be subject to the page count. Each determination is made on a case-by-case basis. In determining whether a document such as an affidavit or declaration under 37 CFR 1.132, or any other document of a submission, includes legal argument, the Office analyzes whether the document is providing factual evidence, i.e., evidence of **technological** facts, or whether the document contains argument that is merely an extension of the arguments of counsel. Factual evidence includes, for example, declarations that swear behind the filing date of a reference, that establish the date of a printed publication, that provide a technical explanation or technical definition of terms of art used by a reference, or that provide comparative test results and a scientific, or technological, analysis of the results (see, e.g., MPEP 716.02). If a document is limited to factual evidence, the document is not included in the page count. In addition, affidavits or declarations **limited to** establishing commercial success, long-felt need and failure of others, skepticism of experts, or copying, as per MPEP 716.03 -716.06, respectively, will not be included in the page count.

In the present case, the patent owner filed a response to the May 24, 2010 Office action on July 23, 2010. On July 26, 2010, the patent owner filed a supplemental response. Patent owner’s July 26, 2010 supplemental response appears to be identical to the July 23, 2010 response, with the exception that the patent owner, in the July 26, 2010 supplemental response, corrected the underlining of all new claims originally added by amendment in the July 23, 2010 response, and with the exception that the declaration under 37 CFR 1.132 of Russell W. White, and accompanying exhibits, which was included in the July 23, 2010 response, was not included in the July 26, 2010 supplemental response. Accordingly, the July 26, 2010 supplemental response does not appear to add additional arguments of counsel, and is deemed to be limited to a correction of purely formal issues.¹ For this reason, the pages of the (identical) supplemental response will not be subject to the page count.

Upon brief review, patent owner’s response, filed on July 23, 2010, includes a 33-page remarks section, a three-page appendix providing support for the claim amendments; a 14-page declaration under 37 CFR 1.132 of Russell W. White, and 40 pages of claim charts (Exhibits I

¹ If this is not the case, the patent owner is required to so inform the Office.

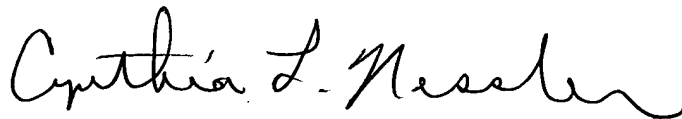
and V). The 33-page remarks section and the three-page appendix providing support for the claim amendments are included in the page count. The declaration under 37 CFR 1.132 of Russell W. White includes arguments deemed to be an extension of the arguments of counsel, i.e., arguments that the "claims of the '947 patent are not obvious" (see paragraphs 21, 32, 37, 49 and 50), causing four pages of the declaration to be subject to the page count. The remainder of the arguments included in the declaration of Russell W. White is deemed to be **limited to** the establishment of commercial success, skepticism of experts, and copying. Thus, the remainder of the White declaration is not included in the page count. Similarly, the claim charts of Exhibits I and V are not comparing the limitations of the claims under reexamination with the teachings of a reference cited against the claims. Rather, the claim charts of Exhibits I and V are comparing the present invention to that of an device which patent owner alleges is infringing the claims of the '947 patent, and are provided as alleged evidence of copying and of commercial success (see, e.g., pages 5 and 12 of the White declaration). For this reason, the claim charts of Exhibits I and V are not included in the page count.

Thus, the 33-page remarks section, the three-page appendix providing support for the claim amendments, and four pages of the White declaration, resulting in a total of 40 pages, are included in the page count.

For the reasons given above, the patent owner's response, filed on July 23, 2010 and July 26, 2010, is deemed to be within the 50-page regulatory limit. Accordingly, the August 17, 2010 patent owner petition is **dismissed as moot**.

CONCLUSION

- Patent owner's August 17, 2010 petition is **dismissed as moot**. Patent owner's response filed on July 23, 2010 and July 26, 2010 is deemed to be page-length compliant.
- Any inquiry concerning this communication should be directed to the undersigned at (571) 272-7724.



Cynthia L. Nessler
Senior Legal Advisor
Office of Patent Legal Administration

1/10/11



UNITED STATES PATENT AND TRADEMARK OFFICE

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(For Patent Owner)

TROP, PRUNER & HU, P.C.
1616 S. VOSS ROAD, SUITE 750
HOUSTON TX 77057-2631

MAILED

APR 15 2011

(For Requester) **CENTRAL REEXAMINATION UNIT**

NOVAK DRUCE & QUIGG, LLP
(NDQ REEXAMINATION GROUP)
1000 LOUISIANA STREET
FIFTY-THIRD FLOOR
HOUSTON, TX 77002

In re: White et alia
Reexamination Proceeding
Control No. 95/001,262
Request Deposited: November 13, 2009
For: U.S. Patent No. 7,187,947

:
: **DECISION**
: **DISMISSING**
: **PETITIONS**
:

The *inter partes* reexamination is before the Central Reexamination Unit to address the third party requester (3PR) paper of August 6, 2010 entitled "PETITION UNDER 37 C.F.R. §§1.181 AND 1.183 TO DECLARE THE PATENT OWNER SUBMISSIONS OF JULY 23, 2010 AND JULY 26, 2010 IMPROPER PAPERS AND STRIKE THEM FROM THE RECORD" and the patent owner (PO) paper of August 17, 2010 entitled "PETITION UNDER 37 C.F.R. §1.182 TO STRIKE THE THIRD PARTY REQUESTER'S 'PETITION UNDER 37 C.F.R. §§1.181 AND 1.183 TO DECLARE THE PATENT OWNER SUBMISSIONS OF JULY 23, 2010 AND JULY 26, 2010 IMPROPER PAPERS AND STRIKE THEM FROM THE RECORD'"

3PR requests relief under 37 CFR 1.181 and/or 37 CFR 1.183 and also requests alternative relief under 37 CFR 1.183.

37 CFR 1.4 states:

Since different matters may be considered by different branches or sections of the United States Patent and Trademark Office, each distinct subject, inquiry or order must be contained in a separate paper to avoid confusion and delay in answering papers dealing with different subjects.

Art Unit: 3992

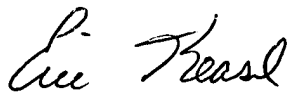
In view of the fact that the petition improperly combines multiple, distinct matters considered by different branches of the USPTO in a single paper, the petition is **dismissed** under 37 CFR 1.4(c).

As to the merits of the request, 3PR's attention is directed to the decision of January 12, 2011 dismissing as moot PO's request for a page limit waiver because the Office found the PO response to be page-limit compliant. Since the Office has already decided the issue, 3PR should not refile their combined petition as two separate petitions.

Although styled as a petition to "strike", the PO paper of August 17, 2010 is essentially a petition opposing the August 6, 2010 petition. Since the 3PR petition is dismissed, the PO petition is **dismissed as moot**.

CONCLUSION

1. The 3PR and PO petitions are **dismissed**.
2. Inquiries regarding this decision may be directed to Eric Keasel, Supervisory Patent Examiner, at (571) 272-4929.
3. This decision is not a final agency decision and is without prejudice to request reconsideration or higher-level review.



Eric Keasel
SPE, Central Reexamination Unit



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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OCT 28 2011

CENTRAL REEXAMINATION UNIT

Trop, Pruner & Hu, P.C.
1947 S. Voss Road
Suite 750
Houston, TX 77057-2631

(For Patent Owner)

Novak Druce & Quigg LLP
(NDQ Reexamination Group)
1000 Louisiana Street
Fifty-Third Floor
Houston, TX 77002

(For *Inter Partes* and *Ex Parte* Requesters)

In re Russell W. White et al.
Inter Partes Reexamination Proceeding
Control No.: 95/001,262
Filed: November 13, 2009
For: U.S. Patent No. 7,187,947

:
:
:
: **DECISION, *SUA SPONTE*,**
: **TO MERGE**
: **REEXAMINATION**
: **PROCEEDINGS**

In re Russell W. White et al.
Ex Parte Reexamination Proceeding
Control No.: 90/011,254
Filed: September 23, 2010
For: U.S. Patent No.: 7,187,947

:
:
:
:

The above-captioned reexamination proceedings are before the Office of Patent Legal Administration for *sua sponte* consideration of whether the proceedings should be merged at this time.

Inter partes reexamination proceeding No. 95/001,262 and *ex parte* reexamination proceeding No. 90/011,254 **are merged** into a single proceeding.

BACKGROUND

1. United States Patent Number 7,187,947 ("the '947 patent") issued to Russell W. White et al. on March 6, 2007, with 42 claims.
2. A request for *inter partes* reexamination of claims 1-42 of the '947 patent was filed November 13, 2009, by a third party requester, and was assigned Reexamination Control

No. 95/001,262 (“the ‘1262 proceeding”). The request identified Apple Inc. as the real party in interest.

3. The Office mailed an order granting *inter partes* reexamination of claims 1-42 of the ‘947 patent for the ‘1262 proceeding on February 5, 2010.
4. The Office mailed a non-final rejection action for the ‘1262 proceeding on May 24, 2010.
5. On July 26, 2010, the patent owner filed a response to the May 24, 2010 Office action, requesting reconsideration of the rejections of the original claims and adding new claims 43-64.
6. The third party requester in the ‘1262 proceeding filed comments to patent owner’s July 26, 2010 response on August 25, 2010.
7. A request for *ex parte* reexamination of claims 1-19 and 29-42 of the ‘947 patent was filed on September 23, 2010, by third party requester Tracy W. Druce, and the request was assigned control number 90/011,254 (“the ‘11254 proceeding”).
8. An order granting *ex parte* reexamination of claims 1-19 and 29-42 of the ‘947 patent was mailed for the ‘11254 reexamination proceeding on December 16, 2010. No Office action has been issued in the ‘11254 reexamination proceeding. No Patent Owner statement has been filed in the ‘11254 reexamination proceeding; and the time for filing same has expired.

DECISION

I. MERGER OF PROCEEDINGS

Reexamination is ordered in the above-captioned two proceedings for overlapping claims of the same patent. One of the proceedings (the ‘1262 proceeding) is an *inter partes* proceeding. The other proceeding (the ‘11254 proceeding) is an *ex parte* proceeding. Both proceedings are still pending, and have not been terminated. In addition, the period for filing the patent owner’s statement in the *ex parte* proceeding has expired. Therefore, consideration of merger is ripe at this point in time.

37 CFR 1.989 provides:

- (a) If any reexamination is ordered while a prior *inter partes* reexamination proceeding is pending for the same patent and prosecution in the prior *inter partes* reexamination proceeding has not been terminated, a decision may be made to merge the two proceedings or to suspend one of the two proceedings. Where merger is ordered, the merged examination will normally result in the issuance of a single reexamination certificate under § 1.997.

(b) An *inter partes* reexamination proceeding filed under § 1.913 which is merged with an *ex parte* reexamination proceeding filed under § 1.510 will result in the merged proceeding being governed by §§ 1.902 through 1.997, except that the rights of any third party requester of the *ex parte* reexamination shall be governed by §§ 1.510 through 1.560.

MPEP 2686.01 points out:

Where a second request for reexamination is filed and reexamination is ordered, and a first reexamination proceeding is pending, the proceedings will be merged where the Office (in its discretion) deems it appropriate to do so, to facilitate the orderly handling of the proceedings. However, a decision not to merge is within the sole discretion of the Office to facilitate/carry out the statutory mandate of 35 U.S.C. 314(c) to conduct reexamination proceedings with "special dispatch."

In this instance, based upon the record as a whole, it is found, based on the facts as they exist at present, that merger of the proceedings should facilitate the orderly handling of the proceedings with special dispatch. Accordingly, the 95/001,262 and 90/011,254 proceedings are hereby merged. The merged proceeding will be conducted in accordance with the guidelines and requirements that follow.

II. THE SAME CLAIMS MUST BE MAINTAINED IN BOTH PROCEEDINGS

New claims 43-64 have been proposed in the '1262 proceeding, while there is no amendment in the '11254 proceeding. Thus, the claims are not currently the same in both proceeding files. Accordingly, a copy of claims 43-64 from the amendment in the *inter partes* reexamination proceeding is being placed in the *ex parte* reexamination IFW file, and is entered in the *ex parte* reexamination. Claims 1-64 will be addressed in the next Office action on the merits for the now merged proceeding. Such action is appropriate in this situation, because the *inter partes* reexamination requester has already had an opportunity to comment on the amendment in the *inter partes* reexamination and has done so.

The patent owner is required to continue to maintain the same claims (and specification) in both files throughout the merged proceeding.

III. CONDUCT OF MERGED PROCEEDING

A. Governing regulations for the merged proceeding:

The present decision merges an *inter partes* reexamination proceeding with an *ex parte* reexamination proceeding. Pursuant to 37 CFR 1.989(b), the merged proceeding is governed by 37 CFR 1.902 through 1.997, except that the rights of the third party requester of the *ex parte* reexamination are governed by 37 CFR 1.510 through 1.560.

B. *Inter partes* Third Party Requester Participation:

1. Comment rights:

The *inter partes* requester can comment pursuant to 35 U.S.C. 314(b)(2).¹ First, an *inter partes* requester's right to comment is contingent upon the patent owner responding to, or commenting on, an Office action. Second, the *inter partes* requester's right to comment is limited to issues raised in either the Office action or the patent owner's response to the action.

2. Appeal Rights:

The *inter partes* reexamination procedures for taking appeal, and for participating in the patent owner's appeal, are explained in MPEP 2674 through 2675 and 2678 through 2683. As pointed out in MPEP 2674:

A notice of appeal by a third party requester must identify each rejection *that was previously proposed by that third party requester* which the third party requester intends to contest. It is not sufficient to merely appeal from the allowance of a claim (i.e., the examiner's finding of a claim patentable); the third party requester must identify each previously proposed rejection to be contested.

Thus, the *inter partes* reexamination requester's appeal must **only** be taken from the finding(s) of patentability of claims in the RAN as to the rejections the third party requester proposed in the *inter partes* reexamination request (not as to the rejections proposed in the *ex parte* reexamination request), and any that the *inter partes* third party requester properly added during the examination stage of the merged proceeding. Also, as provided by 37 CFR 41.67(c)(1)(vi):

No new ground of rejection can be proposed by a third party requester appellant, unless such ground was withdrawn by the examiner during the prosecution of the proceeding, and the third party requester has not yet had an opportunity to propose it as a third party requester proposed ground of rejection.

Thus, an appellant's brief shall present a concise statement of each issue. And, no new ground of rejection (i.e., a ground that the requester did not propose in the *inter partes* reexamination request, or during the merged proceeding) can be proposed by the *inter partes* third party requester appellant, unless that ground was withdrawn by the examiner during the prosecution of the proceeding, and the *inter partes* third party requester did not yet have an opportunity to propose it as a third party requester proposed ground of rejection.

¹ Each time that the patent owner files a response to an action on the merits from the Patent and Trademark Office, the *inter partes* third-party requester shall have one opportunity to file written comments addressing issues raised by the action of the Office or the patent owner's response thereto, if those written comments are received by the Office within 30 days after the date of service of the patent owner's response.

C. Papers mailed/filed:

All papers mailed by the Office throughout the merged proceeding will take the form of a single action which applies to both proceedings. All papers issued by the Office, or filed by the patent owner and the third party requesters, will contain the identifying data for both files and will be physically entered in each reexamination file. All papers filed by the patent owner and the third party requesters must consist of a single paper, **filed in duplicate**, each bearing a signature and identifying data for both files, for entry into each file.

All papers filed by the patent owner and the third party requesters should be directed:

by Mail to: Attn: Mail Stop "*Inter Partes* Reexam"
Central Reexamination Unit
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

by FAX to: (571) 273-9900
Central Reexamination Unit

by Hand to: Customer Service Window
Attn: Central Reexamination Unit
Randolph Building, Lobby Level
401 Dulany Street
Alexandria, VA 22314

by EFS: Registered users may submit papers via the
electronic filing system EFS-Web, at:

<https://portal.uspto.gov/authenticate/authenticateuserlocalepf.html>

Patent owner and requesters are reminded that every paper filed (including papers filed *via* facsimile transmission) in the merged proceeding subsequent to this decision must be served on the other party, and every paper filed must reflect that such paper was served on the other party, pursuant to 37 CFR 1.903.² All papers are to be addressed to the Central Reexamination Unit as provided above.

D. Amendments:

The filing of any amendments to the drawings, specification or claims must comply with 37 CFR 1.943, which incorporates the provisions of 37 CFR 1.530, and the guidelines of MPEP § 2666.01, which in turn references the guidelines of MPEP § 2250.

² It is noted that the *inter partes* requester and the *ex parte* requester are to be treated as separate parties, even if the parties are being represented by the same practitioner.

37 CFR 1.121 does not apply to amendments in reexamination. Accordingly, clean copies of the amended claims are not required and are not to be submitted; rather amendments are to be presented via markings pursuant to paragraph 37 CFR 1.530(f), except that a claim should be canceled by a statement canceling the claim, without presentation of the text of the claim.

Pursuant to 37 CFR 1.530(i), all amendments must be made relative to the patent specification, including the claims, and drawings, which are in effect as of the date of filing the request for reexamination. *Amendments are not to be made relative to previous amendments.* Thus, for all amendments, all words not appearing in the patent are always underlined, and only words being deleted from the patent appear in brackets.

E. Fees:

Where a paper is filed that requires payment of a fee (*e.g.*, petition fee, excess claims fee, extension of time fee, appeal fee, brief fee, oral hearing fee), only a single fee need be paid. For example, only one fee need be paid for any patent owner's appellant brief (or that of the *inter partes* reexamination requester) which may be filed, even though the brief relates to merged multiple proceedings, and copies must be filed (as pointed out above) for each file in the merged proceeding.

F. Citation of Patents and Printed Publications:

Upon return of the present merged proceeding to the examiner, the examiner will review the files to ensure that each file contains identical citations of prior patents and printed publications, and will cite such documents as are necessary as part of the next action in order to place the files in that condition.

CONCLUSION

1. *Inter partes* Reexamination Control No. 95/001,262 and *ex parte* Reexamination Control No. 90/011,254 are merged into a single proceeding, to be conducted in accordance with the procedure set forth above.
2. A copy of the new claims added via the 95/001,262 *inter partes* reexamination proceeding has been placed in the *ex parte* 90/011,254 reexamination proceeding, thus, making the claims the same in both proceedings.
3. The examiner will prepare an Office action on the merits for the merged proceeding in due course.

4. Any questions concerning this communication should be directed to Raul Tamayo, Legal Advisor, at 571-272-7728.

Pinchus M. Laufer

Pinchus M. Laufer
Senior Legal Advisor
Office of Patent Legal Administration

10-27-2011



UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,263	11/13/2009	7486926	AFF.0004B6US	6721
21906	7590	01/06/2011	EXAMINER	
TROP, PRUNER & HU, P.C. 1616 S. VOSS ROAD, SUITE 750 HOUSTON, TX 77057-2631			ART UNIT	PAPER NUMBER

DATE MAILED: 01/06/2011

Please find below and/or attached an Office communication concerning this application or proceeding.



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patents and Trademark Office
P.O.Box 1450
Alexandria, VA 22313-1450
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
NOVAK DRUCE & QUIGG, LLC
(NDQ REEXAMINATION GROUP)
1000 LOUISIANA STREET, FIFTY-THIRD FLOOR
HOUSTON, TX 77002

Date:

MAILED

JAN 06 2011

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001263
PATENT NO. : 7486926
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



United States Patent and Trademark Office

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TROP, PRUNER & HU, P.C.
1616 S. VOSS ROAD, SUITE 750
HOUSTON, TX 77057-2631

(For Patent Owner)

NOVAK, DRUCE & QUIGG LLP
(NDQ REEXAMINATION GROUP)
1000 LOUISIANA AVENUE
FIFTY-THIRD FLOOR
HOUSTON, TX 77002

(For *Inter Partes* Requester)

MAILED

JAN 06 2011

CENTRAL REEXAMINATION UNIT

Inter Partes Reexamination Proceeding
Control No. 95/001,263
Filed: November 13, 2009
For: U.S. Patent No. 7,486,926

:
: **DECISION**
: **DISMISSING**
: **PETITION**

This is a decision on the November 5, 2010 patent owner petition entitled "PETITION UNDER 37 C.F.R. § 1.183" (the petition under 37 CFR 1.183), requesting waiver of the 37 CFR 1.98 copy requirement and the 37 CFR 1.903 service requirement with respect to "non-U.S. references" (i.e., non-U.S. patent documents and non-patent literature) cited in patent owner's concurrently filed information disclosure statement (IDS) submissions.

The petition is before the Office of Patent Legal Administration for consideration.

The petition fee of \$400.00 pursuant to 37 CFR 1.17(f) for patent owner's petition under 37 CFR 1.183 has been paid.

Patent owner's petition under 37 CFR 1.183 is dismissed for the reasons set forth herein.

BACKGROUND

1. On February 3, 2009, the Office issued U.S. Patent No. 7,486,926 (the '926 patent) to White *et al.*
2. On November 13, 2009, a request for *inter partes* reexamination of the '926 patent was filed by a third party requester and real party in interest, Apple, Inc.. The request was assigned control number 95/001,263 (the '1263 proceeding).
3. On February 5, 2010, *inter partes* reexamination was ordered for the '1263 proceeding.

4. On July 9, 2010, the Office issued a non-final Office action in the '1263 proceeding.
5. On September 9, 2010, patent owner timely filed a response to the July 9, 2010 non-final Office action.
6. On October 12, 2010, third party requester filed comments after patent owner's September 9, 2010 response.
7. On November 5, 2010, patent owner filed the instant petition under 37 CFR 1.183, concurrently with IDS submissions.

DECISION

I. Relevant Regulations and Procedure

37 CFR 1.98(a)(2) provides that any IDS filed under § 1.97 shall include:

A legible copy of:

- (i) Each foreign patent;
- (ii) Each publication or that portion which caused it to be listed, other than U.S. patents and U.S. patent application publications unless required by the Office;
- (iii) For each cited pending unpublished U.S. application, the application specification including the claims, and any drawing of the application, or that portion of the application which caused it to be listed including any claims directed to that portion; and
- (iv) All other information or that portion which caused it to be listed.

37 CFR 1.555(a) provides in-part (emphasis added):

The duty to disclose all information known to be material to patentability in a reexamination proceeding is deemed to be satisfied if all information known to be material to patentability of any claim in the patent after issuance of the reexamination certificate was cited by the Office or submitted to the Office in an information disclosure statement. However, the duties of candor, good faith, and disclosure have not been complied with if any fraud on the Office was practiced or attempted or the duty of disclosure was violated through bad faith or intentional misconduct by, or on behalf of, the patent owner in the reexamination proceeding. Any information disclosure statement must be filed with the items listed in § 1.98(a) as applied to individuals associated with the patent owner in a reexamination proceeding, and should be filed within two months of the date of the order for reexamination, or as soon thereafter as possible.

37 CFR 1.183 provides:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 CFR 1.903 provides:

The patent owner and the third party requester will be sent copies of Office actions issued during the *inter partes* reexamination proceeding. After filing of a request for *inter partes* reexamination by a third party requester, any document filed by either the patent owner or the third party requester must be served on every other party in the reexamination proceeding in the manner provided in § 1.248. Any document must reflect service or the document may be refused consideration by the Office. The failure of the patent owner or the third party requester to serve documents may result in their being refused consideration.

II. Patent Owner's Petition

In the instant petition, patent owner requests waiver of the requirement under 37 CFR 1.98 that patent owner submit copies of "non-U.S. references" (i.e., non-U.S. patent documents and non-patent literature; subsequently referred to herein as "references") cited on patent owner's IDS submissions filed concurrently with the instant petition on November 5, 2010.¹ In support of its request for waiver of the rule, patent owner states that it has recently filed (in four boxes) copies of the same references in connection with IDS submissions filed in co-pending reexamination proceeding control no. 95/001,262 (the '1262 proceeding) and that "[t]o avoid the need to re-send these duplicative documents, Patent Owner respectfully requests this petition be granted."² Patent owner also requests waiver of the requirement under 37 CFR 1.903 that patent owner serve copies of these same references on third party requester (Apple Inc.), as patent owner has already served these same documents on Apple Inc. in the co-pending '1262 proceeding.³ Patent owner states that it "makes this petition to avoid the expense and burden on the Patent Owner, Patent Office and Requester that the preparation, filing, uploading to PAIR, and so forth would require of all of these parties" and that "[t]his burden is especially unwarranted, as all of the documents that would be avoided by the granting of this petition have already been provided both to the Patent Office and to Requester."⁴

III. Analysis and Findings

37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition

¹ Petition at page 1.

² *Id.*

³ *Id.*

⁴ *Id.* at page 2.

of the interested party. The burden is on petitioner to set forth with specificity the facts that give rise to an extraordinary situation in which justice requires suspension of a rule.

Waiver of the copy requirement of 37 CFR 1.98(a)(2)

As a general rule, waiver of a rule in the interest of justice is not available when there is recourse within the rules of practice. In this instance, petitioner requests waiver of the rules governing submission of documents to the Office based on the alleged burden of submitting to the Office physical copies of numerous references in multiple reexamination proceedings. In lieu of submitting to the Office physical copies of the references, however, petitioner patent owner may use the Office's Web-based electronic filing system (EFS-Web) to submit electronic copies of the references to the Office. In this way, petitioner need only scan the references into an acceptable electronic format (e.g., Adobe Portable Document Format (PDF)) once, and petitioner can then submit the scanned references to the Office via EFS-Web in any number of reexamination proceedings.

Additionally, Office systems, as currently configured, do not have the capability of copying, in bulk, references from the IFW of one reexamination proceeding into the IFWs of other reexamination proceedings. Any such copying by the Office would be on an individual citation basis and would be lengthy and tedious. Thus, if the Office were to grant petitioner's request, the logistics of insuring that each of the references is properly included in the IFW of the instant proceeding would be shifted to the Office. Accuracy of the reexamination file should be paramount when determining who is better positioned to provide the required copies of references cited in an IDS submission. Patent owner has greater knowledge of the references cited in the IDS and is better able to address issues that may arise during introduction of the copies of the references into the instant proceeding. For these reasons, patent owner is better positioned to supply the required copies of the IDS references in question, and therefore must comply with 37 CFR 1.98(a)(2).

Accordingly, for all of the reasons set forth above, petitioner has not presented facts that demonstrate an extraordinary situation in which justice requires suspension of 37 CFR 1.98(a)(2), and the petition is dismissed.

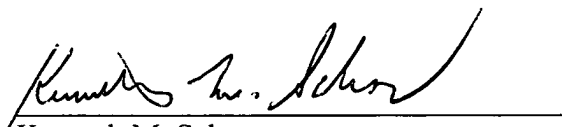
Waiver of the service requirement of 37 CFR 1.903

35 U.S.C. 314(b)(1) provides: "With the exception of the *inter partes* reexamination request, any document filed by either the patent owner or the third-party requester shall be served on the other party." 37 CFR 1.183 is clear that it applies only to a "requirement of the regulations in this part which is not a requirement of the statutes" (emphasis added), and it should be equally clear that a requirement of the statute cannot be waived.

Accordingly, patent owner's petition under 37 CFR 1.183 as to waiver of the service requirement of 37 CFR 1.903 is dismissed.

CONCLUSION

1. Patent owner's November 5, 2010 petition under 37 CFR 1.183 is dismissed.
2. Telephone inquiries related to the present decision should be directed to Nicole Dretar Haines, Legal Advisor, at 571-272-7717.

A handwritten signature in cursive script, appearing to read "Kenneth M. Schor", is written over a horizontal line.

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

January 5, 2011
Ken pet 8/



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,263	11/13/2009	7486926	AFF.0004B6US	6721
21906	7590	01/12/2011	EXAMINER	
TROP, PRUNER & HU, P.C. 1616 S. VOSS ROAD, SUITE 750 HOUSTON, TX 77057-2631			ART UNIT	PAPER NUMBER

DATE MAILED: 01/12/2011

Please find below and/or attached an Office communication concerning this application or proceeding.



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
NOVAK DRUCE & QUIGG, LLC
(NDQ REEXAMINATION GROUP)
1000 LOUISIANA STREET, FIFTY-THIRD FLOOR
HOUSTON, TX 77002

Date:

MAILED

JAN 12 2011

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001263
PATENT NO. : 7486926
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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TROP, PRUNER & HU, P.C.
1616 S. VOSS ROAD, SUITE 750
HOUSTON, TX 77057-2631

(For Patent Owner)

MAILED

JAN 12 2011

NOVAK DRUCE & QUIGG, LLC
(NDQ REEXAMINATION GROUP)
1000 LOUISIANA STREET, FIFTY-THIRD FLOOR
HOUSTON, TX 77002

(For Third Party Requester)

CENTRAL REEXAMINATION UNIT

Inter Partes Reexamination Proceeding
Control No. 95/001,263
Filed: November 13, 2009
For: U.S. Patent No. 7,486,926

: **DECISION**
: **GRANTING**
: **PETITION**
:

This is a decision on third party requester's petition paper entitled "PETITION UNDER 37 C.F.R. § 1.183 TO WAIVE THE PROVISIONS OF 37 C.F.R. § 1.943(b) TO INCREASE THE NUMBER OF PAGES PERMITTED FOR REQUESTER'S WRITTEN COMMENTS BEYOND THE 50-PAGE LIMITATION," filed on October 12, 2010. The petition requests waiver of the requirement of 37 CFR 1.943(b) that the written comments by third party requester not exceed fifty (50) pages in length, and requests that the page limit be extended to 70 pages. Third party requester timely filed comments under 37 CFR 1.947 concurrently with the petition.

The petition is before the Office of Patent Legal Administration for consideration.

Third party requester's petition under 37 CFR 1.183 to waive the 37 CFR 1.943(b) limit as to the number of pages permitted in comments by third party requester is granted to the extent that the page limit for comments by third party requester is extended to not exceed 72 pages in length.

FEES

The petition fee of \$400.00 pursuant to 37 CFR 1.17(f) for third party requester's petition under 37 CFR 1.183 has been paid.

BACKGROUND

1. On February 3, 2009, United States Patent No. 7,486,926 (the '926 patent) issued to White et al.

2. On November 13, 2009, a request for *inter partes* reexamination of the '926 patent was filed by a third party requester, which request was assigned Reexamination Control No. 95/001,263 (the '1263 proceeding).
3. On February 5, 2010, *inter partes* reexamination was ordered in the '1263 proceeding.
4. On July 9, 2010, a non-final Office action was mailed in the '1263 proceeding.
5. On September 9, 2010, patent owner filed a timely response to the Office action.
6. On October 12, 2010, third party requester filed the instant petition entitled "PETITION UNDER 37 C.F.R. § 1.183 TO WAIVE THE PROVISIONS OF 37 C.F.R. § 1.943(b) TO INCREASE THE NUMBER OF PAGES PERMITTED FOR REQUESTER'S WRITTEN COMMENTS BEYOND THE 50-PAGE LIMITATION" (petition under 37 CFR 1.183), concurrently with third party requester's comments. This petition is the subject of the present decision.

DECISION

I. Relevant Regulations and Procedure

37 CFR 1.183 provides:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 CFR 1.943(b) provides:

Responses by the patent owner and written comments by the third party requester shall not exceed 50 pages in length, excluding amendments, appendices of claims, and reference materials such as prior art references.

MPEP § 2667(I), (TYPES OF PAPERS RETURNED WITH CENTRAL REEXAMINATION UNIT DIRECTOR OR REEXAMINATION LEGAL ADVISOR APPROVAL REQUIRED), provides in pertinent part:

Any affidavit or declaration (or a clearly defined portion thereof) that contains opinion(s) of the affiant/declarant, or argument(s) that the art either does or does not anticipate or render obvious the claims, or specific claim elements, of the patent under reexamination, is considered to be part of the comments submitted by the patent owner, or by the third party requester, and is subject to the page limit requirements of 37 CFR 1.943. Affidavits or declarations that are excluded from the page limit requirements include, for example, declarations attempting to swear behind (antedate) the filing date of a reference, or to establish the date of a printed publication, or declarations that provide comparative test data and an analysis of same. However, if the patent owner's affidavit or declaration includes any

argument as to how an outstanding/proposed rejection is overcome, then the page(s) of the affidavit or declaration upon which the argument appears would be included against of the page limit count. Likewise, if a third party requester affidavit or declaration includes any argument as to how a rejection is supported, then the page(s) of the affidavit or declaration upon which the argument appears would be included against of the page limit count. Similarly, attached exhibits presenting data or drawings are not included against the page limit count, unless an exhibit or drawing includes argument as to how the outstanding rejection is overcome. Any page(s) of the exhibit or sheet(s) of drawings that include such argument would be included against the page limit count.

II. Third Party Requester's Petition

In the instant petition, third party requester requests waiver of the requirement under 37 CFR 1.943(b) with respect to the 50-page limit for third party requester's comments filed on October 12, 2010, and requests that the page limit be extended to 70 pages.¹ In support of its request for waiver of the rule, third party requester argues that additional pages are needed to "provide detailed discussion of the grounds of rejection proposed for the newly added claims (which have nearly doubled the number of claims at issue) that would satisfy the requirements of MPEP 2617" and to "fully address the patentability of new claims 21-37."² Third party requester further argues that it must provide detailed arguments under the Office's rules in responding "to the Patent Owner's Reply, the new claims, the declaration of Russell W. White, and the Office Action."³

III. Analysis and Findings

The instant petition under 37 CFR 1.183 has been fully considered. In this instance, petitioner third party requester's October 12, 2010 written comments include 54 pages of remarks, which are subject to the 50 page limit.

The third party requester comments is also accompanied by Exhibit A, which includes a declaration of Dr. Bruce Maggs under 37 CFR 1.132.

A document is deemed to be subject to the 50-page length requirement when the document includes legal argument, i.e., arguments of counsel such as, e.g., arguments that the claims are patentable or unpatentable, or that are directed to how an outstanding or proposed rejection is overcome, or, in the case of a document filed by the requester, how an outstanding or proposed rejection is supported. There are no *per se* rules for determining whether a document, such as an affidavit or declaration, contains a legal argument that will cause the document to be subject to the page count. Each determination is made on a case-by-case basis. In determining whether a document such as an affidavit or declaration under 37 CFR 1.132, or any other document of a submission, includes legal argument, the Office analyzes whether the document is providing factual evidence, i.e., evidence of **technological** facts, or whether the document is merely an extension of the arguments of counsel. Factual evidence includes, for example, declarations that swear behind the filing date of a reference, that establish the date of a printed publication, that provide a technical explanation or technical definition of terms of art used by a reference, or that

¹ Petition at pages 7 and 9.

² *Id.* at page 7.

³ *Id.* at page 8.

provide comparative test results and a scientific, or technological, analysis of the results (see, e.g., MPEP 716.02). If a document is limited to factual evidence, the document is not included in the page count. In addition, affidavits or declarations **limited to** establishing commercial success, long-felt need and failure of others, skepticism of experts, or copying, as per MPEP 716.03 -716.06, respectively, will not be included in the page count.

The 18-page declaration of Dr. Bruce Maggs (included in Exhibit A) is replete with legal arguments. For this reason, the entirety of the declaration is counted toward the page limit. Examples of legal arguments in the Maggs declaration, which are not exhaustive, that count toward the page limit are: In paragraph 11, on page 3, declarant Maggs states: "One of ordinary skill in the art would have been motivated to combine the references as presented in the *inter partes* request." In paragraph 15, on page 5, declarant Maggs states: "...it would have been obvious to a person of ordinary skill in the art..." (see also paragraphs 16, 17, 18, 21, 22, 25, 26, 28, 31, 32, 34, 36, 37, 39, 40, 43, 46, 47, and 49).

Accordingly, the October 12, 2010 third party requester comments *in toto* is 72 pages in length.

Upon review of the submitted response for economizing, extraneous material, and arrangement, without repetition of information already of record, it is found that the 22 pages of arguments in excess of 50 required to complete the third party requester's comments are not unreasonable in this instance, in view of the present facts and circumstances. Furthermore, patent owner's response added 17 new claims. It is deemed equitable to waive the 50-page limit of 37 CFR 1.943(b) in this instance.

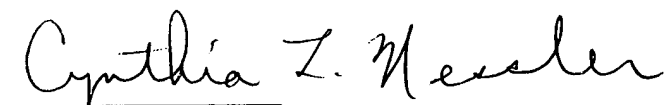
37 CFR 1.183 permits waiver of the page limitation requirement of the regulations in an extraordinary situation when justice requires. Under the facts and circumstances currently of record in the present reexamination proceeding, the instant third party requester petition is deemed to establish that a waiver of 37 CFR 1.943(b) to the extent of permitting third party requester's comments to run 72 pages in length is appropriate in the interest of justice.

Accordingly, third party requester's petition under 37 CFR 1.183 is **granted** to the extent that the page limit of 37 CFR 1.943(b) is waived to the extent of permitting requester's comments submission to exceed the page limit by up to 22 pages. This waiver makes requester's October 12, 2010 comments submission page-length compliant.

CONCLUSION

1. Third party requester's petition under 37 CFR 1.183 is **granted**, and the page limit of 37 CFR 1.943(b) is waived to the extent that third party requester's comments filed on October 12, 2010 may exceed the page limit by up to 22 pages. This waiver makes the October 12, 2010 third party requester comments submission page-length compliant.

2. Telephone inquiries related to the present decision should be directed to the Susy Tsang-Foster, Legal Advisor, at 571-272-7711.

A handwritten signature in cursive script that reads "Cynthia L. Nessler". The signature is written in black ink and is positioned above a horizontal line.

Cynthia L. Nessler
Senior Legal Advisor
Office of Patent Legal Administration

1/11/11
Kenpet8/



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,264	11/13/2009	7324833	AFF.0004B5US	6910
21906	7590	11/19/2010	EXAMINER	
TROP, PRUNER & HU, P.C. 1616 S. VOSS ROAD, SUITE 750 HOUSTON, TX 77057-2631			ART UNIT	PAPER NUMBER

DATE MAILED: 11/19/2010

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NOVAK DRUCE & QUIGG, LLP
(NDQ REEXAMINATION GROUP)
1000 LOUISIANA STREET, FIFTY-THIRD FLOOR
HOUSTON, TX 77002

Date:

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NOV 19 2010

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001264
PATENT NO. : 7324833
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,223	09/22/2009	7324833	AFF.0004B2US	1290
21906	7590	11/19/2010	EXAMINER	
TROP, PRUNER & HU, P.C. 1616 S. VOSS ROAD, SUITE 750 HOUSTON, TX 77057-2631			ART UNIT	PAPER NUMBER

DATE MAILED: 11/19/2010

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
KENYON & KENYON LLP
ONE BROADWAY
NEW YORK, NY 10004

Date:

MAILED

NOV 19 2010

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001223
PATENT NO. : 7324833
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,333	11/07/2008	7324833	AFF.0004B1US	6333
21906	7590	11/19/2010	EXAMINER	
TROP, PRUNER & HU, P.C. 1616 S. VOSS ROAD, SUITE 750 HOUSTON, TX 77057-2631			ART UNIT	PAPER NUMBER

DATE MAILED: 11/19/2010

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
KNOBBE MARTENS OLSON & BEAR LLP
2040 MAIN STREET
FOURTEENTH FLOOR
IRVINE, CA 92614

Date:

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CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010333
PATENT NO. : 7324833
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified ex parte reexamination proceeding (37 CFR 1.550(f)).

Where this copy is supplied after the reply by requester, 37 CFR 1.535, or the time for filing a reply has passed, no submission on behalf of the ex parte reexamination requester will be acknowledged or considered (37 CFR 1.550(g)).



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TROP, PRUNER & HU, P.C.
1616 S. VOSS ROAD, SUITE 750
HOUSTON, TX 77057-2631

(For Patent Owner) **CENTRAL REEXAMINATION UNIT**

KENYON & KENYON LLP
ONE BROADWAY
NEW YORK, NY 10004

(For first *Inter Partes* Requester)

NOVAK, DRUCE & QUIGG LLP
(NDQ REEXAMINATION GROUP)
1000 LOUISIANA AVENUE
FIFTY-THIRD FLOOR
HOUSTON, TX 77002

(For second *Inter Partes* Requester)

KNOBBE, MARTENS OLSON & BEAR, LLP
2040 MAIN ST. 14TH FLOOR
IRVINE, CA 92614

(For *Ex Parte* Requester)

Inter Partes Reexamination Proceeding
Control No. 95/001,223
Filed: September 22, 2009
For: U.S. Patent No. 7,324,833

Inter Partes Reexamination Proceeding
Control No. 95/001,264
Filed: November 13, 2009
For: U.S. Patent No. 7,324,833

Ex Parte Reexamination Proceeding
Control No. 90/010,333
Filed: November 7, 2008
For: U.S. Patent No. 7,324,833

**DECISION
GRANTING-IN-PART
PETITION**

This is a decision on the September 14, 2010 patent owner petition entitled "PETITION UNDER 37 C.F.R. § 1.183 TO WAIVE PAGE LIMIT REQUIREMENT FOR THE PATENT OWNER REPLY UNDER 37 C.F.R. § 1.943(b)."

The petition requests waiver of the requirement of 37 CFR 1.943(b) that the patent owner response not exceed fifty (50) pages in length, and requests that the page limit be extended to 141 pages in order to fully address the June 14, 2010 non-final Office action. Patent owner timely filed its response pursuant to 37 CFR 1.945 concurrently with the petition.

The petition is before the Office of Patent Legal Administration for consideration.

Patent owner's petition under 37 CFR 1.183 to waive the 37 CFR 1.943(b) limit as to the number of pages permitted in patent owner's response is granted to the extent that the page limit for patent owner's response is extended to not exceed 81 pages in length, excluding amendments, appendices of claims, and reference materials such as prior art references.

FEES

The petition fee of \$400.00 pursuant to 37 CFR 1.17(f) for patent owner's petition under 37 CFR 1.183 has been paid.

REVIEW OF RELEVANT FACTS

1. On January 29, 2008, the Office issued U.S. Patent No. 7,324,833 (the '833 patent) to White *et al.*
2. On November 7, 2008, a request for *ex parte* reexamination of all the claims in the '833 patent was filed by a third party requester. The request was assigned control number 90/010,333 (the '10333 proceeding).
3. On December 19, 2008, *ex parte* reexamination was ordered on all the claims of the '833 patent in the '10333 proceeding.
4. On August 5, 2009, a non-final Office action was mailed in the '10333 proceeding, rejecting all the claims of the '833 patent.
5. On September 22, 2009, a first request for *inter partes* reexamination of all the claims in the '833 patent was filed by a third party requester and real party in interest, Volkswagen Group of Americas, Inc. The request was assigned control number 95/001,223 (the '1223 proceeding).
6. On October 2, 2009, patent owner timely filed, in the '10333 proceeding, an amendment and response to the August 5, 2009 Office action, amending claims 1 and 17. No claims were added or canceled.
7. On November 9, 2009, *inter partes* reexamination was ordered in the '1223 proceeding.

8. On November 13, 2009, a second request for *inter partes* reexamination of all the claims in the '833 patent, was filed by a third party requester and real party in interest, Apple, Inc. The request was assigned control number 95/001,264 (the '1264 proceeding).
9. On February 5, 2010, *inter partes* reexamination was ordered in the '1264 proceeding.
10. On June 14, 2010, the '10333, '1223, and '1264 proceedings were merged. A non-final Office action was mailed on even date.
11. On July 15, 2010, patent owner filed a request for a one-month extension of time pursuant to 37 CFR 1.956 for filing a response to the June 14, 2010 non-final Office action.
12. On July 21, 2010, the Office mailed a decision granting the requested one-month extension, setting the response due date to September 14, 2010.
13. On September 14, 2010, patent owner filed the instant petition entitled "PETITION UNDER 37 C.F.R. § 1.183 TO WAIVE PAGE LIMIT REQUIREMENT FOR THE PATENT OWNER REPLY UNDER 37 C.F.R. § 1.943(b)." Concurrently with the petition, patent owner timely filed a response to the June 14, 2010 non-final Office action.

DECISION

I. Relevant Regulations and Procedure

37 CFR 1.183 provides:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 CFR 1.943(b) provides:

Responses by the patent owner and written comments by the third party requester shall not exceed 50 pages in length, excluding amendments, appendices of claims, and reference materials such as prior art references.

MPEP § 2667(I), (TYPES OF PAPERS RETURNED WITH CENTRAL REEXAMINATION UNIT DIRECTOR OR REEXAMINATION LEGAL ADVISOR APPROVAL REQUIRED), provides in pertinent part:

Any affidavit or declaration (or a clearly defined portion thereof) that contains opinion(s) of the affiant/declarant, or argument(s) that the art either does or does not anticipate or render obvious the claims, or specific claim elements, of the patent under reexamination, is considered to be part of the comments submitted by the patent owner, or by the third party requester, and is subject to the page limit requirements of 37 CFR 1.943. Affidavits or declarations that are excluded from the page limit.

requirements include, for example, declarations attempting to swear behind (antedate) the filing date of a reference, or to establish the date of a printed publication, or declarations that provide comparative test data and an analysis of same. However, if the patent owner's affidavit or declaration includes any argument as to how an outstanding/proposed rejection is overcome, then the page(s) of the affidavit or declaration upon which the argument appears would be included against of the page limit count. Likewise, if a third party requester affidavit or declaration includes any argument as to how a rejection is supported, then the page(s) of the affidavit or declaration upon which the argument appears would be included against of the page limit count. Similarly, attached exhibits presenting data or drawings are not included against the page limit count, unless an exhibit or drawing includes argument as to how the outstanding rejection is overcome. Any page(s) of the exhibit or sheet(s) of drawings that include such argument would be included against the page limit count.

II. Patent Owner's Petition

In the instant petition, patent owner requests waiver of the requirement under 37 CFR 1.943(b) with respect to the 50-page limit for patent owner's response filed on September 14, 2010 to address the June 14, 2010 non-final Office action, and requests that the page limit be extended to 141 pages.¹ In support of its request for waiver of the rule, patent owner argues that large portions of the request were incorporated by reference into the 46 page Office action and that patent owner's 141 page submission is much smaller than the more than 800 pages constituting the three different Requests for reexamination and accompanying exhibits.² Patent owner asserts that "this waiver is in keeping with the substantial interest of justice, in that the Patent Owner should have the opportunity to adequately respond and amend the claims in view of the pending claim rejections" and that "[e]nforcing the page limit would prevent the Patent Owner from making a full and complete response to the Office Action as required by the patent statute and the rules."³

III. Analysis and Findings

37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party. The burden is on petitioner to set forth with specificity the facts that give rise to an extraordinary situation in which justice requires suspension of a rule. A showing which petitioner can make in support of a request for waiver of the 50-page limit of 37 CFR 1.943(b) can be an attempt to draft comments in compliance with the 50-page limit, and submission of the resulting comments paper that is in excess of 50 pages concurrently with a petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b), requesting entry of the submitted comments. Such a comments submission can be evaluated for economizing, extraneous material, and arrangement, without repetition of information already of record. In this way, petitioner can rely on the proposed comments submission: (1) for justification that more pages are needed to complete the comments submission, and (2) to set forth an accurate determination of exactly how many additional pages are needed to complete the comments submission.

¹ Petition at page 2.

² *Id.*

³ *Id.*

The instant petition under 37 CFR 1.183 has been fully considered. In this instance, petitioner patent owner's September 14, 2010 response includes 37 pages of remarks, which are subject to the 50 page limit. The following sections of the response are not included in the page limit: the cover page, the five page listing of claims, the signature page, and the two pages of certificate of service.

The patent owner response is also accompanied by Appendix A, Appendix B, declarations of Paul Polansky under 37 CFR 1.132 and of Russell White under 37 CFR 1.132, and four pages of certificate of service for these two declarations.

There are no *per se* rules for determining whether a document, such as an affidavit or declaration, contains a legal argument that will cause the document to be subject to the page count. Each determination is made on a case-by-case basis. In determining whether a document such as an affidavit or declaration under 37 CFR 1.132, or any other document of a submission, includes legal argument, the Office analyzes whether the document is providing factual evidence, i.e., evidence of **technological** facts, or whether the affidavit or declaration is merely an extension of the arguments of counsel. Factual evidence includes, for example, declarations that swear behind the filing date of a reference, that establish the date of a printed publication, that provide a technical explanation or technical definition of terms of art used by a reference, or that provide comparative test results and a scientific, or technological, analysis of the results (see, e.g., MPEP 716.02). If a document is limited to factual evidence, the document is not included in the page count. In addition, affidavits or declarations **limited** to establishing commercial success, long-felt need and failure of others, skepticism of experts, or copying, as per MPEP 716.03 -716.06, respectively, will not be included in the page count.

Appendix A is a 4-page claim chart showing support for the new claims, and is counted toward the page limit. Appendix B consists of Office actions, applicant's responses to those Office actions, and an interview summary, all of which are from the original prosecution of the instant patent under reexamination. The copies of these documents, which are of record for the patented file, do not count toward the page limit.

The declaration of Polansky and the accompanying Appendices A-Y do not contain any legal arguments and therefore do not count toward the page limit.

The declaration of White is accompanied by Exhibits A-M and contain legal arguments as follows: On page 2, declarant White states: "The following facts establish that the claims of the '833 patent are not obvious..." On page 8, declarant White states: "For at least these reasons, the claims of the '833 patent are not obvious." The remaining pages of the White declaration are strictly drawn to evidence of commercial success and/or copying, which do not count toward the page limit. Attached Exhibit C is a 31-page Claim Construction order that is replete with legal arguments and relied upon by patent owner in its remarks; therefore, the claim construction order is counted toward the page limit. Exhibit D is patent owner's infringement contentions and contain legal arguments regarding the priority date of the patent claims on pages 3-5, 7-9, and 11, which count toward the page limit.

Accordingly, the September 14, 2010 patent owner response *in toto* is 81 pages in length.

Upon review of the submitted response for economizing, extraneous material, and arrangement, without repetition of information already of record, it is found that the 31 pages of arguments in excess of 50 required to complete the patent owner's response are not unreasonable in this instance, in view of the present facts and circumstances. The June 14, 2010 non-final Office action is 46 pages in length (excluding 6 cover sheets) and incorporates by reference 36 pages of the Request and more than 57 pages of the claim charts accompanying the Request. The June 14, 2010 non-final Office is effectively more than 139 pages in length.

37 CFR 1.183 permits waiver of the page limitation requirement of the regulations in an extraordinary situation when justice requires. Under the facts and circumstances currently of record in the present merged reexamination proceeding, the instant patent owner petition is deemed to establish that a waiver of 37 CFR 1.943(b) to the extent of permitting patent owner's response to run 81 pages in length is appropriate in the interest of justice.

Accordingly, patent owner's petition under 37 CFR 1.183 is **granted** to the extent that the page limit of 37 CFR 1.943(b) is waived as to the **31 pages** of the arguments portion of patent owner's September 14, 2010 response that exceed the 50-page limit.

CONCLUSION

1. Patent owner's petition under 37 CFR 1.183 is **granted-in-part**, and the page limit of 37 CFR 1.943(b) is **waived to the extent that** patent owner's response to the June 14, 2010 Office action **not exceed 81 pages** in length, excluding appendices of claims and reference materials, such as prior art references. **This waiver makes the September 14, 2010 patent owner response page-length compliant.**
2. Telephone inquiries related to the present decision should be directed to the Susy Tsang-Foster, Legal Advisor, at 571-272-7711.



Cynthia L. Nessler
Senior Legal Advisor
Office of Patent Legal Administration

11-18-10
Cindypet/



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United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,264	11/13/2009	7324833	AFF.0004B5US	6910
21906	7590	01/06/2011	EXAMINER	
TROP, PRUNER & HU, P.C. 1616 S. VOSS ROAD, SUITE 750 HOUSTON, TX 77057-2631			ART UNIT	PAPER NUMBER

DATE MAILED: 01/06/2011

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HOUSTON, TX 77002

Date:

MAILED

JAN 06 2011

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001264
PATENT NO. : 7324833
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,223	09/22/2009	7324833	AFF.0004B2US	1290
21906	7590	01/06/2011	EXAMINER	
TROP, PRUNER & HU, P.C. 1616 S. VOSS ROAD, SUITE 750 HOUSTON, TX 77057-2631			ART UNIT	PAPER NUMBER

DATE MAILED: 01/06/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
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ONE BROADWAY
NEW YORK, NY 10004

Date:

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JAN 06 2011

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001223
PATENT NO. : 7324833
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,333	11/07/2008	7324833	AFF.0004B1US	6333
21906	7590	01/06/2011	EXAMINER	
TROP, PRUNER & HU, P.C. 1616 S. VOSS ROAD, SUITE 750 HOUSTON, TX 77057-2631			ART UNIT	PAPER NUMBER

DATE MAILED: 01/06/2011

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IRVINE, CA 92614

Date:

MAILED

JAN 06 2011

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010333
PATENT NO. : 7324833
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified ex parte reexamination proceeding (37 CFR 1.550(f)).

Where this copy is supplied after the reply by requester, 37 CFR 1.535, or the time for filing a reply has passed, no submission on behalf of the ex parte reexamination requester will be acknowledged or considered (37 CFR 1.550(g)).



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HOUSTON, TX 77057-2631

(For Patent Owner)

MAILED

JAN 06 2011

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(For second *Inter Partes* Requester)

KNOBBE, MARTENS OLSON & BEAR, LLP
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IRVINE, CA 92614

(For *Ex Parte* Requester)

Inter Partes Reexamination Proceeding
Control No. 95/001,223
Filed: September 22, 2009
For: U.S. Patent No. 7,324,833

Inter Partes Reexamination Proceeding
Control No. 95/001,264
Filed: November 13, 2009
For: U.S. Patent No. 7,324,833

Ex Parte Reexamination Proceeding
Control No. 90/010,333
Filed: November 7, 2008
For: U.S. Patent No. 7,324,833

DECISION
DISMISSING
PETITION

This is a decision on the October 20, 2010 patent owner petition entitled "PETITION UNDER 37 C.F.R. § 1.183" (the petition under 37 CFR 1.183), requesting waiver of the 37 CFR 1.98 copy requirement and the 37 CFR 1.903 service requirement with respect to "non-U.S. references" (i.e., non-U.S. patent documents and non-patent literature) cited in patent owner's concurrently filed information disclosure statement (IDS) submissions.

The petition is before the Office of Patent Legal Administration for consideration.

The petition fee of \$400.00 pursuant to 37 CFR 1.17(f) for patent owner's petition under 37 CFR 1.183 has been paid.

Patent owner's petition under 37 CFR 1.183 is dismissed for the reasons set forth herein.

BACKGROUND

1. On January 29, 2008, the Office issued U.S. Patent No. 7,324,833 (the '833 patent) to White *et al.*
2. On November 7, 2008, a request for *ex parte* reexamination of the '833 patent was filed by a third party requester. The request was assigned control number 90/010,333 (the '10333 proceeding).
3. On December 19, 2008, *ex parte* reexamination was ordered for the '10333 proceeding.
4. On September 22, 2009, a first request for *inter partes* reexamination of the '833 patent was filed by a third party requester and real party in interest, Volkswagen Group of Americas, Inc.. The request was assigned control number 95/001,223 (the '1223 proceeding).
5. On November 9, 2009, *inter partes* reexamination was ordered for the '1223 proceeding.
6. On November 13, 2009, a second request for *inter partes* reexamination of the '833 patent was filed by a third party requester and real party in interest, Apple, Inc.. The request was assigned control number 95/001,264 (the '1264 proceeding).
7. On February 5, 2010, *inter partes* reexamination was ordered for the '1264 proceeding.
8. On June 14, 2010, the '10333, '1223, and '1264 proceedings were merged (the merged proceeding). A non-final Office action was mailed on even date.
9. On September 14, 2010, patent owner timely filed a response to the June 14, 2010 non-final Office action.¹
10. On October 20, 2010, patent owner filed the instant petition under 37 CFR 1.183, concurrently with IDS submissions.

¹ On July 21, 2010, the Office mailed a decision granting patent owner's July 15, 2010 request for a one-month extension of time, setting the response due date to September 14, 2010.

DECISION

I. Relevant Regulations and Procedure

37 CFR 1.98(a)(2) provides that any IDS filed under § 1.97 shall include:

A legible copy of:

- (i) Each foreign patent;
- (ii) Each publication or that portion which caused it to be listed, other than U.S. patents and U.S. patent application publications unless required by the Office;
- (iii) For each cited pending unpublished U.S. application, the application specification including the claims, and any drawing of the application, or that portion of the application which caused it to be listed including any claims directed to that portion; and
- (iv) All other information or that portion which caused it to be listed.

37 CFR 1.555(a) provides in-part (emphasis added):

The duty to disclose all information known to be material to patentability in a reexamination proceeding is deemed to be satisfied if all information known to be material to patentability of any claim in the patent after issuance of the reexamination certificate was cited by the Office or submitted to the Office in an information disclosure statement. However, the duties of candor, good faith, and disclosure have not been complied with if any fraud on the Office was practiced or attempted or the duty of disclosure was violated through bad faith or intentional misconduct by, or on behalf of, the patent owner in the reexamination proceeding. Any information disclosure statement must be filed with the items listed in § 1.98(a) as applied to individuals associated with the patent owner in a reexamination proceeding, and should be filed within two months of the date of the order for reexamination, or as soon thereafter as possible.

37 CFR 1.183 provides:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 CFR 1.903 provides:

The patent owner and the third party requester will be sent copies of Office actions issued during the *inter partes* reexamination proceeding. After filing of a request for *inter partes* reexamination by a third party requester, any document filed by either the patent owner or the third party requester must be served on every other party in the reexamination proceeding in the manner provided in § 1.248. Any document must

reflect service or the document may be refused consideration by the Office. The failure of the patent owner or the third party requester to serve documents may result in their being refused consideration.

II. Patent Owner's Petition

In the instant petition, patent owner requests waiver of the requirement under 37 CFR 1.98 that patent owner submit copies of "non-U.S. references" (i.e., non-U.S. patent documents and non-patent literature; subsequently referred to herein as "references") cited on patent owner's IDS submissions filed concurrently with the instant petition on October 20, 2010.² In support of its request for waiver of the rule, patent owner states that it has recently filed (in four boxes) copies of the same references in connection with IDS submissions filed in co-pending reexamination proceeding control no. 95/001,262 (the '1262 proceeding) and that "[t]o avoid the need to re-send these duplicative documents, Patent Owner respectfully requests this petition be granted."³ Patent owner also requests waiver of the requirement under 37 CFR 1.903 that patent owner serve copies of these same references on second *inter partes* requester (Apple Inc.), as patent owner has already served these same documents on Apple Inc. in the co-pending '1262 proceeding.⁴ Patent owner states that it "makes this petition to avoid the expense and burden on the Patent Owner, Patent Office and Requester that the preparation, filing, uploading to PAIR, and so forth would require of all of these parties" and that "[t]his burden is especially unwarranted, as all of the documents that would be avoided by the granting of this petition have already been provided both to the Patent Office and to Requester Apple."⁵

III. Analysis and Findings

37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party. The burden is on petitioner to set forth with specificity the facts that give rise to an extraordinary situation in which justice requires suspension of a rule.

Waiver of the copy requirement of 37 CFR 1.98(a)(2)

As a general rule, waiver of a rule in the interest of justice is not available when there is recourse within the rules of practice. In this instance, petitioner requests waiver of the rules governing submission of documents to the Office based on the alleged burden of submitting to the Office physical copies of numerous references in multiple reexamination proceedings. In lieu of submitting to the Office physical copies of the references, however, petitioner patent owner may use the Office's Web-based electronic filing system (EFS-Web) to submit electronic copies of the references to the Office. In this way, petitioner need only scan the references into an acceptable electronic format (e.g., Adobe Portable Document Format (PDF)) once, and petitioner can then submit the scanned references to the Office via EFS-Web in any number of reexamination proceedings.

² Petition at pages 1-2.

³ *Id.* at page 2.

⁴ *Id.*

⁵ *Id.*

Additionally, Office systems, as currently configured, do not have the capability of copying, in bulk, references from the IFW of one reexamination proceeding into the IFWs of other reexamination proceedings. Any such copying by the Office would be on an individual citation basis and would be lengthy and tedious. Thus, if the Office were to grant petitioner's request, the logistics of insuring that each of the references is properly included in the IFW of the instant merged proceeding would be shifted to the Office. Accuracy of the reexamination file should be paramount when determining who is better positioned to provide the required copies of references cited in an IDS submission. Patent owner has greater knowledge of the references cited in the IDS and is better able to address issues that may arise during introduction of the copies of the references into the instant merged proceeding. For these reasons, patent owner is better positioned to supply the required copies of the IDS references in question, and therefore must comply with 37 CFR 1.98(a)(2).

Accordingly, for all of the reasons set forth above, petitioner has not presented facts that demonstrate an extraordinary situation in which justice requires suspension of 37 CFR 1.98(a)(2), and the petition is dismissed.

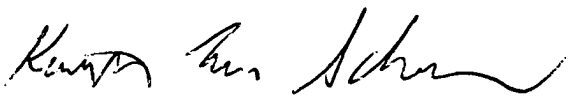
Waiver of the service requirement of 37 CFR 1.903

35 U.S.C. 314(b)(1) provides: "With the exception of the *inter partes* reexamination request, any document filed by either the patent owner or the third-party requester shall be served on the other party." 37 CFR 1.183 is clear that it applies only to a "requirement of the regulations in this part which is not a requirement of the statutes" (emphasis added), and it should be equally clear that a requirement of the statute cannot be waived.

Accordingly, patent owner's petition under 37 CFR 1.183 as to waiver of the service requirement of 37 CFR 1.903 is dismissed.

CONCLUSION

1. Patent owner's October 20, 2010 petition under 37 CFR 1.183 is dismissed.
2. Telephone inquiries related to the present decision should be directed to Nicole Dretar Haines, Legal Advisor, at 571-272-7717.



Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

January 5, 2011
Ken pet 8/



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,264	11/13/2009	7324833	AFF.0004B5US	6910
21906	7590	04/18/2011	EXAMINER	
TROP, PRUNER & HU, P.C. 1616 S. VOSS ROAD, SUITE 750 HOUSTON, TX 77057-2631			ART UNIT	PAPER NUMBER

DATE MAILED: 04/18/2011.

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HOUSTON, TX 77002

Date:

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APR 18 2011

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001264

PATENT NO. : 7324833

TECHNOLOGY CENTER : 3999

ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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TROP, PRUNER & HU, P.C.
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(For Patent Owner) CENTRAL REEXAMINATION UNIT

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2040 MAIN ST. 14TH FLOOR
IRVINE, CA 92614

(For *Ex Parte* Requester)

Inter Partes Reexamination Proceeding
Control No. 95/001,223
Filed: September 22, 2009
For: U.S. Patent No. 7,324,833

Inter Partes Reexamination Proceeding
Control No. 95/001,264
Filed: November 13, 2009
For: U.S. Patent No. 7,324,833

Ex Parte Reexamination Proceeding
Control No. 90/010,333
Filed: November 7, 2008
For: U.S. Patent No. 7,324,833

**DECISION
GRANTING
PETITION**

This is a decision on the 95/001,264 third party requester (Apple, Inc., hereinafter "Apple") petition entitled "PETITION UNDER 37 C.F.R. § 1.183 TO WAIVE THE PROVISIONS OF 37

C.F.R. § 1.943(B) TO INCREASE THE NUMBER OF PAGES PERMITTED FOR REQUESTER'S WRITTEN COMMENTS BEYOND THE 50-PAGE LIMITATION," filed on December 20, 2010. The petition requests waiver of the requirement of 37 CFR 1.943(b) that the written comments by third party requester not exceed fifty (50) pages in length, and requests that the page limit be extended to 91 pages. Third party requester Apple timely filed its comments pursuant to 37 CFR 1.947 concurrently with the petition.

The petition is before the Office of Patent Legal Administration for consideration.

Third party requester Apple's petition under 37 CFR 1.183 is granted.

DECISION

In the instant petition, third party requester Apple requests waiver of the requirement under 37 CFR 1.943(b) with respect to the 50-page limit for its comments filed on December 20, 2010, and requests that the page limit be extended to 91 pages.¹ In support of its request for waiver of the rule, third party requester Apple argues that additional pages are needed to "provide detailed discussion of the grounds of rejection proposed for the amended and newly added claims that would satisfy the requirements of MPEP § 2617" and to "fully address the patentability of the amended and new claims."² Third party requester Apple further argues that it must provide detailed arguments under the Office's rules in responding "to the Patent Owner's Reply of September 14, 2010, the amended and new claims, the declaration of Russell W. White and Paul J. Polansky, and the Office Action mailed June 14, 2010."³

The third party requester Apple's instant petition under 37 CFR 1.183 has been fully considered. In this instance, petitioner third party requester Apple's December 20, 2010 written comments include 66 pages of remarks, which are subject to the 50 page limit.

The third party requester Apple's written comments are also accompanied by Exhibits A-E.

A document is deemed to be subject to the 50-page length requirement when the document includes legal argument, i.e., arguments of counsel such as, e.g., arguments that the claims are patentable or unpatentable, or that are directed to how an outstanding or proposed rejection is overcome, or, in the case of a document filed by the requester, how an outstanding or proposed rejection is supported. There are no *per se* rules for determining whether a document, such as an affidavit or declaration, contains a legal argument that will cause the document to be subject to the page count. Each determination is made on a case-by-case basis. In determining whether a document such as an affidavit or declaration under 37 CFR 1.132, or any other document of a submission, includes legal argument, the Office analyzes whether the document is providing factual evidence, i.e., evidence of **technological** facts, or whether the document is merely an extension of the arguments of counsel. Factual evidence includes, for example, declarations that swear behind the filing date of a reference, that establish the date of a printed publication, that

¹ Petition at page 9.

² *Id.* at page 8.

³ *Id.*

provide a technical explanation or technical definition of terms of art used by a reference, or that provide comparative test results and a scientific, or technological, analysis of the results (see, e.g., MPEP 716.02). If a document is limited to factual evidence, the document is not included in the page count. In addition, affidavits or declarations **limited to** establishing commercial success, long-felt need and failure of others, skepticism of experts, or copying, as per MPEP 716.03 -716.06, respectively, will not be included in the page count.

After brief review, Exhibit A includes a 26-page declaration of Dr. Bruce Maggs, which is replete with legal arguments. For this reason, the entirety of the declaration is counted toward the page limit. Examples of legal arguments in the Maggs declaration, which are not exhaustive, that count toward the page limit are: In paragraph 9, on page 2, declarant Maggs states: "In my opinion, *the claims* of the '833 patent were all well known in the art before the filing date of the patent." In paragraph 11 on page 3, declarant Maggs states: "One of ordinary skill in the art would have been motivated to combine the references as presented in the *inter partes* request..." (also see, at a minimum, paragraphs 17, 18, 20-22, 26-39, 43-44, 47, 48, 50-52, 54-59, 61-67).

Accordingly, the December 20, 2010 third party requester Apple's comments *in toto* is 92 pages in length.

Upon review of the submitted response for economizing, extraneous material, and arrangement, without repetition of information already of record, it is found that the 42 pages of arguments in excess of 50 required to complete the third party requester Apple's comments are not unreasonable in this instance, in view of the present facts and circumstances. The September 14, 2010 patent owner response amends claims 1, 17, and 19 and adds 14 new claims. In addition, the examiner, in the June 14, 2010 non-final Office action, did not adopt at least 30 of Apple's proposed rejections.

37 CFR 1.183 permits waiver of the page limitation requirement of the regulations in an extraordinary situation when justice requires. Under the facts and circumstances currently of record in the present merged reexamination proceeding, the third party requester Apple's instant petition is deemed to establish that a waiver of 37 CFR 1.943(b) to the extent of permitting third party requester Apple's comments to run 92 pages in length is appropriate in the interest of justice.

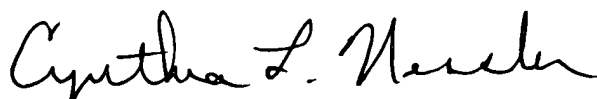
Accordingly, third party requester's petition under 37 CFR 1.183 is **granted** to the extent that the page limit of 37 CFR 1.943(b) is waived to the extent of permitting requester Apple's comments submission to exceed the page limit by up to **42 pages**. This waiver makes requester Apple's December 20, 2010 comments submission page-length compliant.

CONCLUSION

1. Third party requester Apple's petition under 37 CFR 1.183 is **granted**, and the page limit of 37 CFR 1.943(b) is waived to the extent that third party requester Apple's comments filed on December 20, 2010 may exceed the page limit by up to 42 pages. This waiver makes the

December 20, 2010 third party requester Apple's comments submission page-length compliant.

2. Telephone inquiries related to the present decision should be directed to the Susy Tsang-Foster, Legal Advisor, at 571-272-7711.



Cynthia L. Nessler
Cynthia L. Nessler
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4/15/11
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,264	11/13/2009	7324833	AFF.0004B5US	6910
21906	7590	04/18/2011	EXAMINER	
TROP, PRUNER & HU, P.C. 1616 S. VOSS ROAD, SUITE 750 HOUSTON, TX 77057-2631			ART UNIT	PAPER NUMBER

DATE MAILED: 04/18/2011

Please find below and/or attached an Office communication concerning this application or proceeding.



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Date:

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MAILED

APR 18 2011

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001264

PATENT NO. : 7324833

TECHNOLOGY CENTER : 3999

ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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APR 18 2011

CENTRAL REEXAMINATION UNIT

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Inter Partes Reexamination Proceeding
Control No. 95/001,223
Filed: September 22, 2009
For: U.S. Patent No. 7,324,833

Inter Partes Reexamination Proceeding
Control No. 95/001,264
Filed: November 13, 2009
For: U.S. Patent No. 7,324,833

Ex Parte Reexamination Proceeding
Control No. 90/010,333
Filed: November 7, 2008
For: U.S. Patent No. 7,324,833

DECISION
GRANTING-IN-PART
PETITION AND
EXPUNGING
IMPROPER PAPER

This is a decision on the 95/001,223 third party requester (Volkswagen Group of America, Inc., hereinafter "VWGoA") petition entitled "PETITION UNDER 37 C.F.R. § 1.183 TO WAIVE THE PAGE LIMIT FOR REQUESTER'S RESPONSE UNDER 37 C.F.R. § 1.943(b)," filed on December 20, 2010.

The petition requests waiver of the requirement of 37 CFR 1.943(b) that the written comments by third party requester VWGoA not exceed fifty (50) pages in length, and requests that the page limit be extended to 138 pages. Third party requester VWGoA timely filed its comments pursuant to 37 CFR 1.947 concurrently with the petition.

The petition is before the Office of Patent Legal Administration for consideration.

Third party requester VWGoA's petition under 37 CFR 1.183 to waive the 37 CFR 1.943(b) limit as to the number of pages permitted in written comments by third party requester VWGoA is granted to the extent that the page limit for written comments by third party requester is VWGoA extended to not exceed 92 pages in length.

For the reasons set forth below, third party requester VWGoA's comments submission is an improper paper and is being expunged without consideration. Since the third party requester VWGoA's paper has been scanned into the record, i.e., the Office's Image File Wrapper (IFW) file of the present merged reexamination proceeding, the December 20, 2010 third party requester comments submission by VWGoA is being expunged from the record by closing it and marking it "not public".

DECISION

I. DECISION GRANTING-IN-PART PETITION TO WAIVE THE REQUIREMENTS OF 37 CFR 1.943(b)

In the instant petition, third party requester VWGoA requests waiver of the requirement under 37 CFR 1.943(b) with respect to the 50-page limit for its comments filed on December 20, 2010, and request that the page limit be extended to 138 pages.¹ In support of its request for waiver of the rule, third party requester VWGoA argues that additional pages are needed to present new proposed grounds of rejection, which are either necessitated by patent owner's addition of 14 new claims in its response or by VWGoA's recent discovery of new prior art based on depositions that were conducted by patent owner in the concurrent litigation involving the '833 patent in April and May 2010, after the date of VWGoA's request for *inter partes* reexamination.² VWGoA also asserts that the new claims add subject matter that was not previously claimed in any of the original claims of the '833 patent.³ Finally, VWGoA argues that MPEP § 2617 requires a detailed explanation for the newly proposed rejections.⁴

The instant petition under 37 CFR 1.183 has been fully considered. In this instance, petitioner third party requester VWGoA's December 20, 2010 written comments include 42 pages of remarks, which are subject to the 50 page limit. The third party requester's written comments

¹ Petition at page 8.

² *Id.* at 8-9.

³ *Id.* at 8.

⁴ *Id.* at 9.

are also accompanied by 80 pages of claim charts for the new proposed grounds of rejection, Exhibits 1-12, and a declaration of Scott Andrews under 37 CFR 1.132.⁵

A document is deemed to be subject to the 50-page length requirement when the document includes legal argument, i.e., arguments of counsel such as, e.g., arguments that the claims are patentable or unpatentable, or that are directed to how an outstanding or proposed rejection is overcome, or, in the case of a document filed by the requester, how an outstanding or proposed rejection is supported. There are no *per se* rules for determining whether a document, such as an affidavit or declaration, contains a legal argument that will cause the document to be subject to the page count. Each determination is made on a case-by-case basis. In determining whether a document such as an affidavit or declaration under 37 CFR 1.132, or any other document of a submission, includes legal argument, the Office analyzes whether the document is providing factual evidence, i.e., evidence of **technological** facts, or whether the document is merely an extension of the arguments of counsel. Factual evidence includes, for example, declarations that swear behind the filing date of a reference, that establish the date of a printed publication, that provide a technical explanation or technical definition of terms of art used by a reference, or that provide comparative test results and a scientific, or technological, analysis of the results (see, e.g., MPEP 716.02). If a document is limited to factual evidence, the document is not included in the page count. In addition, affidavits or declarations **limited to** establishing commercial success, long-felt need and failure of others, skepticism of experts, or copying, as per MPEP 716.03 -716.06, respectively, will not be included in the page count.

The 80-page claim chart for the new proposed grounds of rejection is counted toward the page limit.

Exhibit 2 is VWGoA's 27-page post-trial brief filed in the concurrent litigation containing legal arguments regarding the '833 patent claims and is counted toward the page limit.

Exhibit 3 is a 27-page comparison of the parent '812 application as filed and the '833 patent as filed to support VWGoA's arguments regarding priority of the '833 patent claims and is counted toward the page limit.

The 12-page declaration of Andrews contains 8 pages of legal arguments. Examples of legal arguments in the Andrews declaration, which are not exhaustive are:

On page 2, paragraph 10, declarant Andrews states: "In my opinion, claims 1 to 35 of the '833 patent include subject matter not disclosed in the '812 application."

⁵ This decision would normally be limited to the page-limit issue and the propriety of third party requester's written comments would be reviewed by the Central Reexamination Unit (CRU). However, in response to VWGoA's statement on page 8 of the instant petition that it is presenting new proposed grounds of rejection based on new prior art, this decision notifies the requester that its comments submission facially fails to comply with 35 U.S.C. 314(b)(2) and 37 CFR 1.947.

On page 3, paragraph 12, declarant Andrews states: "In my opinion, the '812 application does not describe the following features included in claim 17 of the '833 patent."

On page 5, paragraph 20, declarant Andrews states: "Nor does the '812 application describe or suggest even such a hypothetical (and not described) portable radio 500..."

On page 6, paragraph 22, declarant Andrews states: "Nor does the '812 application describe or suggest even such a hypothetical (and not described) vehicle system..."

On page 7, paragraph 24, declarant Andrews states: In contrast to these systems described in the '812 application, the claims of the '833 patent require two devices..."

On page 9, paragraph 28, declarant Andrews states: "Therefore, conventional audio systems, at the time of filing the '812 application...were incapable of presenting graphical user interfaces or graphical menus of the type described in the claims of the '833 patent."

On page 10, paragraph 33, declarant Andrews states: "Based on the foregoing, it is my opinion that the '812 application does not describe the audio system described claim 1 of the '833 patent."

On page 11, paragraph 34, declarant Andrews states: "Furthermore, it is my opinion that the '812 application does not describe the audio system described in claim 17 of the '833 patent."

In addition, the Andrews declaration is accompanied by Exhibits A-C.

Exhibit B is a copy of application 09/537,812, which is the parent application of the '833 patent. This copy is not counted toward the page limit because it is presumed to have been reviewed by the examiner of the present merged proceeding.

Accordingly, the December 20, 2010 third party requester VWGoA's comments submission *in toto* is 184 pages in length, as to the pages counted toward the regulatory page limit.

Upon review of the submitted response for economizing, extraneous material, and arrangement, without repetition of information already of record, it is found that the 134 pages of arguments in excess of 50 required to complete third party requester VGWoA's comments are unreasonable in this instance, in view of the present facts and circumstances. The patent owner added only 14 new claims, and amended three original claims. As an initial matter, the submission of 134 additional pages of arguments to address the limited number of newly added claim limitations is deemed to be unreasonable.

In the decision addressing third party requester Apple's December 20, 2011 petition under 37 CFR 1.183 to waive the provisions of 37 CFR 1.943(b), which is being mailed on even date, the third party requester Apple's written comments submission was determined to be 92 pages in length, and was deemed page length compliant in view of the waiver granted therein.

In a balancing of the equities, and after a review of the comments submission, the third party requester VWGoA's petition under 37 CFR 1.183 is **granted** to the extent that the page limit of 37 CFR 1.943(b) is waived as to the **42 pages** of the portions of requester's written comments, which are included in the regulatory page count, that exceed the 50-page limit (assuming that requester revises the comments submission to properly limit it by deleting the comments that are directed to improperly proposed new prior art rejections, as discussed below).

Third party requester VWGoA's written comments submission does not comply with the page limit of ninety-two (92) pages in length granted in this decision by waiver, and thus lacks an entry right in the present merged proceeding. The written comments submission was entered (scanned) into the Office's IFW system before discovery of the defect in the paper, and as such, cannot be physically removed from the IFW. Therefore, the written comments paper is being expunged from the record by closing it and marking it "not public" in the IFW of the present merged reexamination proceeding.

II. THIRD PARTY REQUESTER VWGoA'S DECEMBER 20, 2010 COMMENTS SUBMISSION IS FACIALLY IMPROPER

The Office notes that third party requester VGWoA's comments submission improperly proposes rejections based on newly submitted prior art. For example, a brief review of VGWoA's comments submission reveals that the requester newly proposes rejections, based on newly submitted prior art, of unamended (original) claims.⁶ Such rejections are based on, for example, the Simon et al. and Empeg Car User Guide (hereinafter "Empeg") references.⁷ Third party requester VWGoA justifies these newly proposed prior art rejections as follows: With respect to the Simon et al. reference, third party requester VGWoA asserts that the reference, "first became known to VWGoA not earlier than April 27, 2010," the date on which patent owner held a deposition of the first named inventor Simon in connection with the concurrent litigation.⁸ With respect to the Empeg reference, VWGoA asserts that it is permissible under 37 CFR 1.948(a)(2) to cite this reference to rebut patent owner's response, that is to address the new claims presented in patent owner's response.⁹ In addition, VWGoA asserts that since the Empeg reference is applied to the new claims that are dependent claims, it is necessary to apply the reference against the independent claims as well.¹⁰

⁶ See for example, pages 1-39 of the 80-page claim chart attached to the December 20, 2010 VWGoA's comments, which contain newly proposed prior art rejections for unamended (original) claims.

⁷ *Id.*

⁸ See page 32 of the December 20, 2010 VWGoA's written comments.

⁹ *Id.*

¹⁰ *Id.*

The requester is reminded that the provisions of 37 CFR 1.948(a)(1)-(3) set forth the limitation on what newly cited prior art the requester may *file* in an *inter partes* reexamination, as part of, for example, a document entitled “information disclosure statement,” which is filed with requester’s comments. If the submission of newly cited prior art meets the rule, then the newly cited prior art is entered into the proceeding, i.e., the reference is made of record, considered, and the consideration is indicated by the examiner’s initials on the document entitled “information disclosure statement.” To newly propose a rejection based on such prior art, however, the requester must also show how the newly proposed rejection is necessitated by patent owner’s amendment of the claims, i.e., how the presence of a teaching, in each reference cited alone, or, if the reference is cited in a combination, in at least one of the references of the reference combination, corresponds to at least one claim limitation newly added by patent owner’s amendment. See 37 CFR 1.947 and MPEP 2666.05.

35 U.S.C. § 314(b)(2) limits the content of requester’s comments to “addressing issues raised by the action of the Office or the patent owner’s response thereto.” Even if the requester shows that the new prior art is submitted in compliance with 37 CFR 1.948, this does not necessarily permit requester to propose a new ground of rejection based on additional art, as (1) 37 CFR 1.947 must be satisfied in order for requester to be permitted to propose a new ground of rejection, and (2) 37 CFR 1.947 cannot be waived to the extent that it promulgates a requirement of the statute – in this instance, 35 U.S.C. § 314(b)(2). If the requester were permitted to newly propose rejections based on newly cited prior art, without showing how these rejections were necessitated by amendment, then the provisions of 35 U.S.C. § 314(b)(2) and 37 CFR 1.947 would essentially be a nullity. For example, an entirely new proposed ground of rejection, and one which is based on 37 CFR 1.948(a)(3) art, is not permitted by 35 U.S.C. 314(b)(2) because it would not address “issues raised by the action of the Office or the patent owner’s response.”

Therefore, the December 20, 2010 requester VWGoA comments do not have a right of entry under 37 CFR 1.947 and 1.948 and 35 U.S.C. § 314(b)(2). There is simply no statutory or regulatory authority for entry of the newly proposed prior art rejections not necessitated by an amendment to the patent claims. As pointed out above, the written comments paper was entered (scanned) into the Office’s IFW system before discovery of the defect in the paper, and as such, cannot be physically removed from the IFW system. Therefore, the written comments submission is being expunged from the record by closing it and by marking it “not public”.

In view of the above discussion as to the VWGoA comments filed on December 20, 2010 being improper, the comments are expunged from the record in the manner described above.

This decision primarily addresses requester’s petition under 37 CFR 1.183 for waiver of the page length requirements under 37 CFR 1.943(b), and does not include a complete analysis of the propriety, or lack thereof, of requester’s comments submission, pursuant to, for example, 37 CFR §§ 1.947 or 1.948, or MPEP 2666.05. As to the compliance of requester’s comments submission with any regulation other than 37 CFR 1.943(b), or any applicable statute or published procedure, this decision only notifies the requester that requester’s comments submission *facially* fails to comply with 35 U.S.C. 314(b)(2), 37 CFR 1.947, and MPEP 2666.05.

Any replacement comments submission filed in response to this decision will be reviewed by the examiner for compliance with all of the applicable statutes, regulations, and procedures.

THIRD PARTY REQUESTER OPTIONS

For the above reasons, the December 20, 2010 comments submission submitted by the third party requester VWGoA is improper.

Third party requester is given fifteen (15) days from the mailing date of this decision to file a replacement comments submission, which must be limited to 92 pages pursuant to the page limit waiver granted-in-part in this decision. The requester should review the entire replacement written comments submission, prior to its filing, for compliance with all applicable statutes, regulations, and published Office procedures, particularly 37 CFR §§ 1.943(b), 1.947, and 1.948, and MPEP 2666.05.

Any replacement comments submission filed in response to the notification must be strictly limited to (i.e., must not go beyond) the comments in the original (expunged) comments submission. No comments that add to those in the expunged paper will be considered for entry, other than what is strictly necessary to conform to the guidelines set forth in this decision.

If no replacement comments submission from the third party requester is timely received, the reexamination proceeding will be forwarded to the examiner for appropriate action, without entry of written comments by the third party requester.

CONCLUSION

1. Third party requester VWGoA's December 20, 2010 petition under 37 CFR 1.183 is granted in-part, and the page limit of 37 CFR 1.943(b) is waived to the extent that third party requester VWGoA's 37 CFR 1.947 comments submission after the September 14, 2010 patent owner response is not to exceed 92 pages in length. **This waiver is conditional on the submission being in at least 12 point font and at least one-and-a-half spaced, with appropriate margins.**
2. Third party requester VWGoA's written comments submission, filed on December 20, 2010, is improper, and will NOT be made a part of the record of the present merged proceeding.
3. Since third party requester VWGoA's comments submission and accompanying exhibits were scanned into the electronic Image File Wrapper (IFW) of the present merged proceeding, these papers are expunged by closing them in the present merged reexamination proceeding's IFW files and marking them as "non-public."
4. Third party requester VWGoA is given fifteen (15) days from the mailing date of this decision to file a replacement comments submission. Any replacement comments submission filed in

response to the notification **must be strictly limited to (i.e., must not go beyond) the comments in the original (now expunged) comments submission.** No comments that add to those in the original paper will be considered for entry, other than what is strictly necessary to conform to the guidelines set forth in this decision.

5. No copy of the third party requester VWGoA's December 20, 2010 written comments submission will be maintained in the record, or elsewhere in the Office.
6. Telephone inquiries related to this decision should be directed to Susy Tsang-Foster, Legal Advisor, at (571) 272-7711.



Cynthia L. Nessler
Senior Legal Advisor
Office of Patent Legal Administration

4/15/11
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CENTRAL REEXAMINATION L

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Inter Partes Reexamination Proceeding
Control No. 95/001,223
Filed: September 22, 2009
For: U.S. Patent No. 7,324,833

Inter Partes Reexamination Proceeding
Control No. 95/001,264
Filed: November 13, 2009
For: U.S. Patent No. 7,324,833

Ex Parte Reexamination Proceeding
Control No. 90/010,333
Filed: November 7, 2008
For: U.S. Patent No. 7,324,833

**DECISION
DENYING
PETITION AND
EXPUNGING
IMPROPER PAPERS**

This is a decision on the 95/001,223 third party requester (Volkswagen Group of America, Inc., hereinafter "VWGoA") petition entitled "PETITION UNDER 37 C.F.R. § 1.181 FOR RECONSIDERATION," filed on May 3, 2011.

The present petition for reconsideration requests that:

- (1) The April 18, 2011 Office decision granting-in-part the requester VWGoA's December 20, 2010 petition requesting waiver of the page limit requirement of 37 CFR 1.943(b) be vacated;
- (2) The requester VWGoA's December 20, 2010 petition requesting waiver of the page limit requirement of 37 CFR 1.943(b) be granted in its entirety; and
- (3) The requester VWGoA's expunged December 20, 2010 comments submission be entered into the record and considered.

The petition for reconsideration is before the Office of Patent Legal Administration for consideration.

SUMMARY

The petition for reconsideration is granted only to the extent that the April 18, 2011 Office decision has been reconsidered, but is denied as to the underlying relief requested.

The April 18, 2011 Office decision **properly granted-in-part** requester VWGoA's December 20, 2010 petition requesting waiver of the page limit requirement of 37 CFR 1.943(b) for its comments submission, and **properly expunged** VWGoA's December 20, 2010 comments submission that newly proposed rejections of unamended (original) claims that were based on newly cited prior art.

Exhibit 2, which is a copy of requester VWGoA's December 20, 2010 comments submission attached to the present petition, and the replacement comments filed concurrently with the present petition **are improper papers and are being expunged** without consideration. Since these papers have been scanned into the record, i.e., the Office's Image File Wrapper (IFW) file of the above-captioned merged reexamination proceeding, they are being expunged from the record by closing them and marking them "not public."

This decision is designated as a final agency action under 5 U.S.C. § 704.

BACKGROUND

1. On January 29, 2008, the Office issued U.S. Patent No. 7,324,833 (the '833 patent) to White *et al.*, with claims 1-35.
2. On November 7, 2008, a request for *ex parte* reexamination of all the claims in the '833 patent was filed by a third party requester. The request was assigned control number 90/010,333 (the '333 proceeding).

3. On December 19, 2008, *ex parte* reexamination was ordered on all the claims of the '833 patent in the '333 proceeding.
4. On August 5, 2009, a non-final Office action was mailed in the '333 proceeding, rejecting all the claims of the '833 patent.
5. On September 22, 2009, a first request for *inter partes* reexamination of all the claims in the '833 patent was filed by a third party requester and real party in interest, VWGoA. The request was assigned control number 95/001,223 (the '1223 proceeding).
6. On October 2, 2009, patent owner timely filed, in the '333 proceeding, an amendment and response to the August 5, 2009 Office action, amending claims 1 and 17. No claims were added or canceled.
7. On November 9, 2009, *inter partes* reexamination was ordered in the '1223 proceeding.
8. On November 13, 2009, a second request for *inter partes* reexamination of all the claims in the '833 patent, was filed by a third party requester and real party in interest, Apple, Inc. (hereinafter "Apple"). The request was assigned control number 95/001,264 (the '1264 proceeding).
9. On February 5, 2010, *inter partes* reexamination was ordered in the '1264 proceeding.
10. On June 14, 2010, the '333, '1223, and '1264 proceedings were merged. A non-final Office action was mailed on even date. Before the merger, no Office action was issued in the '1223 *inter partes* proceeding, nor in the '1264 *inter partes* proceeding, and no further Office action was issued in the '333 *ex parte* proceeding. The June 14, 2010 non-final Office action incorrectly stated on page 2 that claims 1, 17, and 19 were amended in the '333 proceeding. Only claims 1 and 17 were amended in the October 2, 2009 patent owner response filed in the '333 *ex parte* proceeding. The June 14, 2010 non-final Office action also stated on page 2 that claims 1-27 are not the same in all three proceedings and stated on page 3 that for examination purposes, the set of claims in the '333 proceeding would be utilized – i.e., the current set of claims in the '333 proceeding would be tentatively in effect for all three proceedings.¹

¹ It is noted that in the June 14, 2010 non-final Office action that was mailed concurrently with the June 14, 2010 decision merging the '333, '1223, and the '1264 proceedings, the examiner's use of the amended claim set from the *ex parte* proceeding, where claims 1 and 17 were amended, as the claim set in effect for the merged proceeding, is a harmless procedural error. The examiner should have waited for the patent owner to file a housekeeping amendment that placed the same amendment in each of the three proceedings before issuing the June 14, 2010 non-final Office action. In its September 14, 2010 patent owner response, the amendment shows claims 1, 17, and 19 in their original form and adds new claims 36-49. Claims 1-35 are original patent claims as is confirmed by patent owner's remarks on page 7 of patent owner's September 14, 2010 response. The patent owner's September 14, 2010 amendment returning claims 1 and 17 to their original form remedied the procedural error to the extent that the scope of the original claims that was in front of the requesters at the critical time had not been changed by the patent owner's response to the June 14, 2010 non-final Office action. Thus, the proposed rejections for the original claims as set forth in the requests by both *inter partes* requesters are still before the examiner for his consideration.

11. On December 20, 2010, third party requester Apple filed a petition entitled "PETITION UNDER 37 C.F.R. § 1.183 TO WAIVE THE PROVISIONS OF 37 C.F.R. § 1.943(B) TO INCREASE THE NUMBER OF PAGES PERMITTED FOR REQUESTER'S WRITTEN COMMENTS BEYOND THE 50-PAGE LIMITATION." Concurrently with the petition, third party requester Apple timely filed comments pursuant to 37 CFR 1.947.
12. On December 20, 2010, third party requester VWGoA filed a petition entitled " PETITION UNDER 37 C.F.R. § 1.183 TO WAIVE THE PAGE LIMIT FOR REQUESTER'S RESPONSE UNDER 37 C.F.R. § 1.943(b)." Concurrently with the petition, third party requester VWGoA timely filed comments pursuant to 37 CFR 1.947.
13. On April 18, 2011, the Office mailed a decision granting third party requester Apple's December 20, 2010 petition. The page limit waiver granted in the decision rendered requester Apple's December 20, 2010 comments submission page-length compliant.
14. On April 18, 2011, the Office mailed a decision granting-in-part requester VWGoA's December 20, 2010 petition (hereinafter "the April 18, 2011 decision"). The decision waived the page limit requirement of 37 CFR 1.943(b) to the extent that the page limit for requester VWGoA's written comments was extended not to exceed 92 pages in length. The requester's VWGoA's December 20, 2010 written comments submission, having a effective page length of 184 pages, did not comply with the page limit of 92 pages that was granted in the decision by waiver and thus lacked an entry right in the merged proceeding. Furthermore, the requester's VWGoA's December 20, 2010 written comments submission was found to be facially improper for proposing rejections based on newly submitted prior art for unamended (original) claims. Accordingly, the April 18, 2011 decision expunged requester's VWGoA's December 20, 2010 written comments submission from the record.
15. On May 3, 2011, third party requester VWGoA filed the instant petition entitled " PETITION UNDER 37 C.F.R. § 1.181 FOR RECONSIDERATION." Concurrently with the petition, third party requester VWGoA filed its replacement comments submission.

RELEVANT STATUTES, REGULATIONS, AND EXAMINING PROCEDURE

35 U.S.C. § 314(b)(2) states (emphasis added):

Each time that the patent owner files a response to an action on the merits from the Patent and Trademark Office, the third-party requester shall have **one opportunity** to file written comments **addressing issues raised by the action of the Office or the patent owner's response thereto**, if those written comments are received by the Office within 30 days after the date of service of the patent owner's response.

37 CFR 1.947 states (emphasis added):

Each time the patent owner files a response to an Office action on the merits pursuant to § 1.945, a third party requester may **once file written comments** within a period of 30 days from the date of service of the patent owner's response. These comments **shall be limited to issues**

raised by the Office action or the patent owner's response. The time for submitting comments by the third party requester may not be extended. For the purpose of filing the written comments by the third party requester, the comments will be considered as having been received in the Office as of the date of deposit specified in the certificate under § 1.8.

37 CFR 1.948(a) states (emphasis added):

After the *inter partes* reexamination order, the third party requester may only cite additional prior art as defined under § 1.501 if it is filed as part of a comments submission under § 1.947 or § 1.951(b) and is limited to prior art:

- (1) which is necessary to rebut a finding of fact by the examiner;
- (2) which is necessary to rebut a response of the patent owner; or
- (3) which for the first time became known or available to the third party requester after the filing of the request for *inter partes* reexamination proceeding. Prior art submitted under paragraph (a)(3) of this section must be accompanied by a statement as to when the prior art first became known or available to the third party requester and must include a **discussion of the pertinency of each reference** to the patentability of at least one claim.

The Manual of Patent Examining Procedure (MPEP), Section 2666.05 (II) states in pertinent part (emphasis added):

The third party requester comments must be directed to points and issues covered by the Office action and/or the patent owner's response.

Third party requester comments are limited to issues covered by the Office action or the patent owner's response. New prior art can be submitted with the comments **only** where the prior art (A) is necessary to rebut a finding of fact by the examiner, (B) is necessary to rebut a response of the patent owner, or (C) for the first time became known or available to the third party requester after the filing of the request for *inter partes* reexamination.

As to item (A) above, 37 CFR 1.948(a)(1) permits the requester to provide new prior art rebutting the examiner's interpretation/finding of what the art of record shows. **However, a statement in an Office action that a particular claimed feature is not shown by the prior art of record (which includes references that were cited by requester) does NOT permit the requester to then cite new art to replace the art originally advanced by requester. Such a substitution of a new art for the art of record is not a rebuttal of the examiner's finding that a feature in question is not taught by the art of record.** Rather, such a substitution would amount to a rebuttal of a finding that a feature in question is not taught by any art in existence. A finding that the feature in question is not taught by any art in existence could not realistically be made for the reexamination proceeding, since the proceeding does not include a comprehensive validity search, and such was not envisioned by Congress as evidenced by the 35 U.S.C. 314(c) mandate that reexamination proceedings are to be conducted in the Office with special dispatch.

As to item (B) above, 37 CFR 1.948(a)(2) permits the requester to provide a new proposed rejection, where such new proposed rejection is necessitated by patent owner's amendment of the claims.

As to item (C) above, prior art submitted under 37 CFR 1.948(a)(3) must be accompanied by a statement that explains the circumstances as to when the prior art first became known or available to the third party requester, including the date and manner that the art became known or available, and why it was not available earlier. The submission must also include a discussion of the pertinency of each reference to the patentability of at least one claim.

Where the **third party requester written comments are directed to matters other than issues and points covered by the Office action or the patent owner's response**, or where the prior art submitted with the comments does not satisfy at least one of (A) - (C) above, **the written comments are improper**. If the written comments are improper, the examiner should return the written comments (the entire paper) with an explanation of what is not proper; if the comments have been scanned into the Image File Wrapper (IFW) for the reexamination proceeding prior to the discovery of the impropriety, they should be expunged from the record, with notification being sent to the third party requester. The notification to the third party requester is to provide a time period of fifteen (15) days for the third party requester to rectify and refile the comments. If, upon the second submission, the comments are still not proper, the comments will be returned to third party requester with an explanation of what is not proper, and at that point the comments can no longer be resubmitted. The loss of right to submit further comments applies only to the patent owner response at hand. See MPEP § 2666.20. To the extent that 37 CFR 1.947 provides that the third party requester "may once" file written comments, that provision is hereby waived to the extent of providing the third party requester the one additional opportunity to **remedy a comments paper containing merits-content that goes beyond what is permitted by the rules**; 37 CFR 1.947 is not waived to provide any further opportunity in view of the statutory requirement for special dispatch in reexamination.

Any replacement comments submitted in response to the notification **must be strictly limited to (i.e., must not go beyond)** the comments in the original (returned) comments submission. No comments that add to those in the returned paper will be considered for entry.

DECISION ON PETITION UNDER 37 CFR 1.181

Requester VWGoA urges that the following points be reviewed:

A. Whether the Office erred by (1) refusing to enter and consider requester VWGoA's original comments submission, filed on December 20, 2010, and (2) expunging the original comments submission from the record;² and

B. Whether the April 18, 2011 decision properly limited requester VWGoA's comments to only 92 of the requested 184 pages.³

The present decision addresses both requester points.

² Petition for reconsideration at pages 7 and 13.

³ *Id.* at page 7. It is noted that requester VWGoA's December 20, 2010 petition requested 138 pages for its comments, not the 184 pages that it is requesting in the present petition for reconsideration. In the April 18, 2011 decision, the Office determined that requester VWGoA's comments submission was 184 pages in length, as to the pages counted toward the regulatory page limit.

A. The April 18, 2011 Decision Properly Denied Entry of, and Expunged, the Requester VWGoA Original Comments Submission Filed on December 20, 2010:

1. The Statute Does Not Permit Requester to Newly Propose Rejections For Unamended (Original) Claims Based on Newly Cited Prior Art

The April 18, 2011 Office decision held that requester VWGoA's newly proposed rejections in its December 20, 2010 submission, which applied newly cited prior art against unamended (original) claims of the '833 patent, were not permitted by 35 U.S.C. § 314(b)(2).⁴ Such newly proposed rejections were based on the Simon et al. and the Empeg Car User Guide (hereinafter "Empeg") references.⁵ Requester VWGoA argues that this holding is improper. To support its argument, requester VWGoA contends that the language in 35 U.S.C. § 314 (b)(2) "is permissive and open-ended, rather than limiting."⁶ Requester VWGoA argues that the language in 35 U.S.C. § 314 explains that the requester "shall have" certain rights, and that "the statute requires that the third-party requester be given **at least** 'one opportunity to file written comments' whenever the patent owner files as [sic] response, and that those comments be permitted to address **at least** 'issues raised by the action of the Office or the patent owner's response thereto.'"⁷ Based on its interpretation of the statute, requester VWGoA contends that the Office's rules implementing this statutory provision are improperly closed-ended, and limiting.⁸

Requester VWGoA's interpretation of 35 U.S.C. § 314(b)(2) is not found to be correct. The relevant language of the statute is that "the third-party requester shall have **one opportunity** to file written comments **addressing issues raised by the action of the Office or the patent owner's response thereto.**" (Emphasis added) Based on the plain meaning of the language in the statute, the statute is not construed to provide third party-requester with an extra opportunity to submit written comments or the right to comment on issues that are not limited to those raised by patent owner's response or the Office action, and there is no legislative history to the contrary.

In December 2000, the Office issued final rules to implement *inter partes* reexamination, which was newly enacted by the America Inventors Protection Act (AIPA) of 1999 (Public Law No. 106-113. *See Rules to Implement Optional Inter Partes Reexamination Proceedings; Final Rule*, 65 Fed. Reg. 76756 (December 7, 2000), effective date of February 5, 2001. In this rule making the Office did not construe the language in 35 U.S.C. § 314(b) contrary to its plain language when implementing the statute through 37 CFR 1.947.⁹

⁴ *Id.* at page 18.

⁵ See for example, pages 1-39 of the 80-page claim chart attached to the December 20, 2010 VWGoA's comments, which contain newly proposed prior art rejections for unamended (original) claims.

⁶ Petition for reconsideration at page 17.

⁷ *Id.*

⁸ *Id.* at pages 17-18.

⁹ One comment on the notice of proposed rule making suggested that the patent owner should have the right of the last comment, which the Office did not adopt. The Office's response, which is provided in the notice, explains that providing the patent owner with an opportunity to reply to third party comments would unduly prolong the pendency of the proceeding, contrary to the special dispatch requirement set forth in 35 U.S.C. § 314(c). The Office also noted that a patent owner response to the third party comments could be considered a (supplemental) patent owner

In the Office's implementation of *inter partes* reexamination, the rules which limit requester's written comments to issues raised in the patent owner response or in the Office action, and which provide only one opportunity to file comments after a patent owner response, were established through notice and comment. The final rule making notice points out that only three comments directed to proposed 37 CFR 1.947 were received. None of these comments challenged the Office's interpretation of the statute that is set forth in 37 CFR 1.947. To date, the text of 37 CFR 1.947 has not been amended since the rule first became effective on February 5, 2001.

It is to be noted that since the inception of optional *inter partes* reexamination, the Office has construed the statute to: 1) limit requester's comments to issues raised in the patent owner response or in the Office action, and 2) provide only one opportunity to file written comments, each time that a patent owner files a response to an Office action. If the Office were to adopt the petitioner's reading of the statute, the Office would be changing a well-established Office procedure, which would be contrary to *Cooper Techs. Co. v. Dudas*, 536 F.3d 1330, 87 USPQ 2d 1705 (Fed. Cir. 2008). In *Cooper*, the Federal Circuit stated:¹⁰

In this case, the Patent Office expressly interpreted "original application" as used in the AIPA, shortly after the AIPA was enacted. *See 65 Fed. Reg. at 76,757*. "[T]he Supreme Court has instructed that '**an administrative practice has particular weight when it involves a contemporaneous construction of a statute by the [persons] charged with the responsibility of setting its machinery in motion, of making the parts work efficiently and smoothly while they are yet untried and new.**'" *Daewoo Elecs. Co. v. Int'l Union of Elec., Elec., Technical, Salaried & Machine Workers, AFL-CIO*, 6 F.3d 1511, 1522 (Fed. Cir. 1993) (quoting *Zenith Radio Corp. v. United States*, 437 U.S. 443, 450, 98 S. Ct. 2441, 57 L. Ed. 2d 337 (1978) (second alteration in the original)). We therefore must give the Patent Office's construction "particular weight" in our analysis. [Emphasis added]

Pursuant to the Office's "contemporaneous construction" of 35 U.S.C. § 314(b), each time a patent owner files a response to an Office action, a requester may file comments only once, and such comments are limited to issues raised by the Office action or by the patent owner's response.

As a further point, had Congress intended to provide the requester with "at least one" opportunity to file comments, and to permit the requester to address "at least" the issues raised by the Office action or by the patent owner's response, the statute or legislative history would have explicitly stated so. The phrase "at least" does not appear in the text of 35 U.S.C. § 314(b) or in the legislative history. Further, the plain meaning of the language of the statute does not compel such a reading, as advocated by the requester.

response to the Office action, which would trigger a further right to third party comment under 35 U.S.C. § 314(b)(2), and thus create an endless cycle. Similarly, to provide requester with more than one opportunity to file comments is not only contrary to 35 U.S.C. § 314(b)(2), but also contrary to the statutory mandate for special dispatch.

¹⁰*Cooper Techs. Co. v. Dudas*, 536 F.3d at 1341.

Requester has referred to MPEP 2666.05, entitled “Third Party Comments after Patent Owner Response” to support its argument that the actions of the third party requester are limited by the rules of the Office, and not by the statute. Specifically, requester argues that this section of the MPEP waives the provision of the “may once” file written comments under 37 CFR 1.947 to permit requester to rectify improper comments by filing replacement comments.¹¹ Requester argues that this waiver in the MPEP would not be possible if the language of the statute (rather than the Office rules) limited the requester to one opportunity to file comments.¹² However, the first **improper comments submission** does not have an entry right and, for this reason, it was never officially “filed.” It is the corrected comments, the content of which is strictly limited to (i.e., must not go beyond) that of the original comments, that serves the function of the **one filing** of a comments submission under 37 CFR 1.947.

For all of the reasons given above, the April 18, 2011 decision properly expunged requester VWGoA’s December 20, 2010 comments submission. The statute simply does not permit a requester to newly propose rejections of unamended (original) claims over newly cited prior art as part of its comments submission, which is filed pursuant to 37 CFR 1.947.

2. The Provisions of 37 CFR 1.947 Do Not Conflict With Those of 37 CFR 1.948 That Permit Requester to Newly Cite the Simon et al. and the Empeg references

Requester contends that “the restrictive and limiting language of 37 C.F.R. § 1.947 cannot be used to impose the requirement that the newly cited prior art be applied only to new and amended claims as the Expungement Decision held,” since “[t]his interpretation of the rules would conflict with the other provisions of 37 C.F.R. and the M.P.E.P.”¹³ Specifically, requester argues that the April 18, 2011 decision, which explained that any newly proposed rejections over newly cited prior art may only be applied to claims which have been newly amended, limits the requester to applying prior art that may only be submitted under 37 CFR 1.948(a)(2). The requester further asserts that MPEP 2666.05(II) requires requester to include a discussion of any prior art submitted under 37 CFR 1.948(a)(3), regardless of whether that art also qualifies under 37 CFR 1.948(a)(2).¹⁴

As an initial matter, in the present petition for reconsideration, requester VWGoA’s statements regarding which specific subsections of 37 CFR 1.948(a) apply to the Simon et al. and the Empeg references appear to be inconsistent with those in its December 20, 2010 comments submission. In the present petition, requester VWGoA states that “[a]s VWGoA explained in its December Comments, the new citations to the Simon et al. and the Empeg references in that submission were proper under 37 C.F.R. §§ 1.948(a)(2) and (3), because those references were ‘necessary to rebut a response of the patent owner’ and ‘for the first time became known or available to [VWGoA] after the filing of the request for *inter partes* reexamination proceeding.’”¹⁵ This statement suggests that both references were cited under 37 CFR 1.948(a)(2) and (a)(3).

¹¹ *Id.* at page 18.

¹² *Id.* at page 18

¹³ *Id.* at page 19.

¹⁴ *Id.* at page 19.

¹⁵ Petition for reconsideration at page 16.

In contrast, in its December 20, 2010 comments paper, requester VWGoA justified its proposed rejections over these newly cited prior art references as follows: With respect to the Simon et al. reference, third party requester VWGoA asserts that the reference, “first became known to VWGoA not earlier than April 27, 2010,” the date on which patent owner held a deposition of the first named inventor Simon in connection with the concurrent litigation.¹⁶ With respect to the Empeg reference, VWGoA asserts that it is permissible under 37 CFR 1.948(a)(2) to cite this reference to rebut patent owner’s response, that is, to address the new claims presented in patent owner’s response.¹⁷ In addition, VWGoA asserts that since the Empeg reference is applied to the new claims that are dependent claims, it is necessary for VWGoA to apply the reference against the respective independent claims as well.¹⁸ In view of requester’s VWGoA’s December 20, 2010 comments, the Simon et al. reference was submitted under 37 CFR 1.948(a)(3) and the Empeg reference was submitted under 37 CFR 1.948(a)(2).

Regardless of which subsections of 37 CFR 1.948(a) apply to the newly cited Simon et al. and Empeg references, requester’s principal argument regarding the provisions of 37 CFR 1.948(a) is that “the limitations imposed by Section 1.947 do not apply to the discussion of new prior art that is properly cited under Section 1.948.”¹⁹ Requester argues that the guidance in MPEP 2666.05(II) together with the statement in MPEP 2648 that claims “will be reexamined in view of all prior art during the reexamination under 37 CFR 1.937” permits requester to apply the Simon et al. and the Empeg references to unamended (original) claims in a newly proposed rejection, as part of its comments submission submitted under 37 CFR 1.947.²⁰

However, there is nothing in MPEP 2666.05(II) that would permit prior art properly cited, i.e., made of record under 37 CFR 1.948(a)(1) and (a)(3) to be applied in a new rejection as to unamended (original) claims.

As to the statement in MPEP 2648 that claims “will be reexamined in view of all prior art during the reexamination under 37 CFR 1.937,” MPEP 2648 points out that the examiner will reexamine the claims in view of all of the prior art that is properly of record, in accordance with 37 CFR 1.937; accordingly, the examiner will apply any of that art which the examiner believes to have a bearing on patentability. While prior art properly made of record under 37 CFR 1.948(a)(1) and (a)(3) is available to the examiner for consideration, if such art does not have a bearing on patentability, the examiner is clearly not required to apply it. The statement in MPEP 2648 does not support requester’s argument that requester is permitted to newly propose art rejections for any unamended claim, simply by virtue of having made that art of record under 37 CFR 1.948(a)(1) and (a)(3). The MPEP would not make such a permissive statement, because the 37 CFR 1.947 provision that requester’s comments are limited to issues raised by the patent owner response, or by the Office action, is a statutory requirement (as discussed in detail above) that cannot be waived. Furthermore, the first line of section 2666.05(II) of the MPEP reiterates

¹⁶ See page 32 of the December 20, 2010 VWGoA’s written comments.

¹⁷ *Id.*

¹⁸ *Id.*

¹⁹ *Id.* at page 20.

²⁰ *Id.*

this statutory requirement as follows: "The third party requester comments must be directed to points and issues covered by the Office action and/or the patent owner's response."

In the present petition, the requester appears to be confusing a prior art citation submitted under 37 CFR 1.948 with the requirement for properly setting forth a proposed prior art rejection, as detailed in MPEP 2617. The requester is reminded that the provisions of 37 CFR 1.948(a)(1)-(3) are directed only as to what newly cited prior art the requester may *file* in an *inter partes* reexamination, as part of, for example, a document entitled "information disclosure statement," which is filed with requester's comments under 37 CFR 1.947. If the submission of newly cited prior art meets the rule, then the newly cited prior art is entered into the proceeding, i.e., the reference is made of record and considered, and the consideration is indicated by the examiner's initials on the document entitled "information disclosure statement." 37 CFR 1.948(a), however, does not authorize the requester to newly propose a *rejection* of unamended (original) claims based on prior art newly submitted under the rule. To newly propose a rejection based on such new prior art, the requester must also show how the newly proposed rejection is necessitated by patent owner's amendment of the claims, i.e., how the presence of a teaching, in each reference cited alone, or, if the reference is cited in a combination, in at least one of the references of the reference combination, corresponds to at least one claim limitation newly added by patent owner's amendment. See 37 CFR 1.947 and MPEP 2666.05.²¹

Finally, the requester argues that the limitations imposed by 37 CFR 1.947 do not apply to the discussion of new prior art that is properly cited under 37 CFR 1.948.²² 37 CFR 1.948(a)(3) requires that any prior art submitted under this provision must be accompanied by a statement that includes a discussion of the pertinency of each reference to the patentability of at least one claim. However, the provisions of 37 CFR 1.948(a)(3) do not require, nor permit, requester to propose a rejection of the claims based on the newly cited prior art. They only require a discussion of the *pertinence* of the newly cited prior art to the claims.

For all of the reasons given above, the provisions of 37 CFR 1.947 are not deemed to conflict with the provisions of 37 CFR 1.948(a), contrary to requester's arguments.

3. Requester's December 20, 2010 Comments Submission and the May 3, 2011 Replacement Comments Submission Are Improper

²¹ It is understood that new art may be added to an existing proposed rejection in order to rebut a point newly made in the Office action or a patent owner response if the point being rebutted is identified in requester comments, but that is not the same as making a new proposed rejection as is the case here. In this regard, MPEP 2666.05(II), reproduced above, explicitly prohibits the use of prior art cited under 37 CFR 1.948(a)(1) to replace the art originally advanced by the requester, where the Office action which the requester is addressing includes a statement that a particular claimed feature is not shown by the prior art originally cited against that claim. The relevant portion of MPEP 2666.05(II) states:

"However, a statement in an Office action that a particular claimed feature is not shown by the prior art of record (which includes references that were cited by requester) does NOT permit the requester to then cite new art to replace the art originally advanced by requester. Such a substitution of a new art for the art of record is not a rebuttal of the examiner's finding that a feature in question is not taught by the art of record."

²² *Id.* at page 20.

In view of the above discussion, requester VWGoA's argument that it was permitted to propose new rejections over the Simon et al. and Empeg references (that were cited under 37 CFR 1.948(a) and MPEP 2666.05(II)) for unamended claims in its December 2010 comments submission under 37 CFR 1.947²³ is not persuasive. 35 U.S.C. § 314(b)(2) limits the content of requester's comments to "addressing issues raised by the action of the Office or the patent owner's response thereto." Requester is not permitted to propose rejections based on the newly cited prior art submitted under 37 CFR 1.948(a)(2) or (a)(3) for unamended (original) claims since neither the Office action, nor the patent owner's response, raised an issue with regard to these claims.

Thus, the Office properly expunged the original December 20, 2010 comments submission, because it included newly proposed rejections which do not have a right of entry under 35 U.S.C. § 314(b)(2) and 37 CFR 1.947, i.e., the newly proposed rejections of the unamended (original) claims based on the newly cited Simon et al. and Empeg references. As explained in the April 18, 2011 decision, there is no statutory or regulatory authority for entry of newly proposed rejections that are not necessitated by an amendment to the patent claims.²⁴

Requester has attached Exhibits 1-3 to the present petition for reconsideration. Exhibit 1 is a copy of the April 18, 2011 Office decision, which granted-in-part requester VWGoA's December 20, 2010 petition under 37 CFR 1.183, and expunged requester VWGoA's December 20, 2010 comments submission. Exhibit 2 is a copy of the original December 20, 2010 comments submission by requester VWGoA. Exhibit 3 is a copy of requester VWGoA's December 20, 2010 petition under 37 CFR 1.183. However, the original comments submission is improper for reasons discussed above, as well as in the April 18, 2011 decision on requester's VWGoA's December 20, 2010 petition. Accordingly, Exhibit 2, which is attached to the present petition, is improper and is being expunged from the record.

Requester has also filed replacement comments concurrently with the present petition for reconsideration. Contrary to requester's assertion,²⁵ the replacement comments do not comply with the restrictions imposed by the Office's April 18, 2011 decision. In its May 3, 2011 transmittal letter for the replacement comments, requester VWGoA asserts "[s]ince claims 36 to 49 are all dependent claims, the Replacement Comments include claim charts applying the newly-cited prior [art] against the respective independent and intervening claims solely for the purpose of fully supporting the new proposed grounds of rejection applied against the newly-added dependent claims."²⁶

The replacement claim charts apply newly cited prior art against the original, independent claims,²⁷ which is prohibited by 35 U.S.C. § 314(b)(2) and 37 CFR 1.947, as extensively

²³ *Id.*

²⁴ See April 18, 2011 decision on VWGoA's December 20, 2010 petition at page 6.

²⁵ See Footnote 1 on page 2 of the petition for reconsideration.

²⁶ See page 2 of the May 3, 2011 transmittal letter for the replacement comments.

²⁷ Claims 1-35 are unamended (original) claims. The replacement charts apply newly cited prior art against some of the unamended (original) claims. See for example, pages 12-26, 42 and 43 of the replacement claim charts where the Empeg reference is applied against original claims 1, 3, 12, 17, 20, 28, 34, and 35, and pages 29-39 of the replacement claim charts where the Simon reference is applied against original claims 1, 17, 20, 28, 34, and 35.

discussed *supra*. In the May 3, 2011 transmittal letter for its replacement comments, requester VWGoA justifies applying the newly cited art to the unamended (original) claims in order to support the rejections of the dependent new claims. This argument is unpersuasive as the requester need only address the limitations of the dependent claims and how the newly cited art is needed to modify the rejections of record for the new dependent claims. The newly cited prior art must address the features of the new dependent claims; however, it is unnecessary and impermissible to apply the newly cited prior art to the unamended (original) claims from which these new claims depend (which unamended (original) claims do not contain the features of the new dependent claims).

Accordingly, the replacement comments submission is an improper paper, and it is being expunged.

Since Exhibit 2, which is attached to the present petition, and the replacement comments submission filed concurrently with the present petition have been scanned into the record, i.e., the Office's Image File Wrapper (IFW) file of the present merged reexamination proceeding, these papers are being expunged from the record by closing them and by marking them "not public."

B. The April 18, 2011 Decision Properly Granted-in-Part Requester VWGoA's December 20, 2010 Petition to Waive the Requirements of 37 CFR 1.943(b):

The present petition for reconsideration requests that requester VWGoA's December 20, 2010 petition under 37 CFR 1.183 for additional pages be granted in its entirety.²⁸ Requester VWGoA alleges that "the Office appears to have awarded VWGoA only 42 additional pages for its replacement comments solely on the length of Apple's comments submission."²⁹ Requester argues that it is unreasonable for the Office to base any decision on its request for additional pages on the unrelated comments filed by Apple.³⁰ Requester explains that the difference between Apple's request for 42 additional pages and VWGoA's request for 134 additional pages is that VWGoA submitted 80 pages of claim charts to support its new rejections proposed in its December 20, 2010 comments.³¹ Requester also argues that the Office also appeared to base its decision on the page limit issue on the incorrect interpretation of the rules which would limit VWGoA to asserting any new prior art against only new and amended claims of the '833 patent.³²

However, the Office pointed out in the April 18, 2011 decision that a substantial portion of the original claim charts was devoted to applying the newly cited Simon et al. and Empeg references against unamended (original) claims.³³ Since these newly proposed rejections for unamended (original) claims are improper for the reasons discussed in the April 18, 2011 decision and reiterated above, it is reasonable for the Office not to grant the 134 additional pages that are

²⁸ Petition for reconsideration at page 22.

²⁹ *Id.* at page 21.

³⁰ *Id.*

³¹ *Id.*

³² *Id.* at page 20.

³³ See footnote 6 on page 5 of the April 18, 2011 Office decision.

presently requested for the improper purpose of providing an explanation of how the newly cited references are applied to the unamended (original) claims.

Accordingly, requester's VWGoA's request that the December 20, 2010 petition under 37 CFR 1.183 to be granted in its entirety is denied.

For all the reasons given above, the requester VWGoA's petition under 37 CFR 1.181(a)(3) is denied.

CONCLUSION

1. The petition for reconsideration is granted only to the extent that the April 18, 2011 Office decision has been reconsidered, but is denied as to the underlying relief requested.
2. This decision is designated as a final agency action under 5 U.S.C. § 704.
3. The proceeding is being referred to the CRU for issuance of an Office action in due course addressing patent owner's September 14, 2010 response and requester Apple's December 20, 2010 written comments.
4. Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop
 Commissioner for Patents
 Post Office Box 1450
 Alexandria, VA 22313-1450
5. Any questions concerning this communication should be directed to Susy Tsang-Foster, Legal Advisor, at (571) 272-7711 or, in her absence, to the undersigned at (571) 272-7710.

/Kenneth M. Schor/

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

9-15-11
Kenpet8/



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,265	11/19/2009	6812841	ALIEG841REX	6917
35243	7590	04/15/2011	EXAMINER	
SEED INTELLECTUAL PROPERTY LAW GROUP PLLC 701 FIFTH AVENUE, SUITE 5400 SEATTLE, WA 98104-7092				
			ART UNIT	PAPER NUMBER

DATE MAILED: 04/15/2011

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

Michael J. Schallop
VAN PELT, YI & JAMES LLP
10050 N. Foothill Blvd. #200
Cupertino, CA 95014

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NUMBER 95/001,265.

PATENT NUMBER 6,812,841.

TECHNOLOGY CENTER 3900.

ART UNIT 3992.

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above-identified reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the *inter partes* reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an *ex parte* reexamination has been merged with the *inter partes* reexamination, no responsive submission by any *ex parte* third party requester is permitted.

All correspondence relating to this *inter partes* reexamination proceeding should be directed to the **Central Reexamination Unit** at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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APR 15 2011

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SEED INTELLECTUAL PROPERTY LAW GROUP PLLC
701 FIFTH AVENUE, SUITE 5400
SEATTLE WA 98104-7092

(For Patent Owner)

VAN PELT, YI & JAMES LLP
10050 N. FOOTHILL BLVD #200
CUPERTINO, CA 95014

(For Requester)

In re Heinrich et alia

US Patent Number 6,812,841

Control No.: 95/001,265

Filed: November 19, 2009

For: **PASSIVE RFID TAG THAT RETAINS STATE
AFTER TEMPORARY LOSS OF POWER**

**DECISION ON PETITIONS
UNDER 37 CFR 1.59**

This is a decision on the petitions under 37 CFR 1.59(b), filed April 8, 2011 and April 11, 2011, to expunge information from the above identified proceeding.

The petitions are **dismissed**.

Initially, it is noted that the petitions are similar in most aspects except the petition of April 8, 2011 refers to petitioner as "Applicant" on pages 1 and 2, whereas the petition of April 11, 2011 refers to petitioner as "Third Party Requester" on page 1 and "Applicant" on page 2.

Petitioner requests that a document entitled "Memorandum in Opposition to Alien's Motion for Reconsideration of the Court's Order Denying Summary Judgment of Non-Infringement of U.S. Patent No. 6,812,841", be expunged from the record in both petitions.

The petitions are deficient because the petitions do not contain a commitment on the part of petitioner to retain the information to be expunged for the life of the patent with regard to which such information has been submitted and the petitions do not contain a statement that each petition is being submitted by, or on behalf of, the party in interest who originally submitted the information.

Art Unit: 3992

Accordingly, the petitions are dismissed.

Both petitions are also defective because it appears that the petitions were not served on Patent Owner. After the filing of a request for *inter partes* reexamination by a third party requester, any document filed by either the patent owner or the third party requester must be served on the other party (or parties where two third party requester proceedings are merged) in the *inter partes* reexamination proceeding in the manner provided in 37 CFR 1.248. See 37 CFR 1.903. It is noted that the Appeal Brief of April 8, 2011 appears to have been served on Patent Owner, but neither petition appears to have been served.


ERIC S. KEASEL
CRU SPE-AU 3992



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,265	11/19/2009	6812841	ALIEG841REX	6917
35243	7590	02/17/2012	EXAMINER	
SEED INTELLECTUAL PROPERTY LAW GROUP PLLC 701 FIFTH AVENUE, SUITE 5400 SEATTLE, WA 98104-7092			ART UNIT	PAPER NUMBER

DATE MAILED: 02/17/2012

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Michael J. Schallop
VAN PELT YI & JAMES LLP
10050 N. Foothill Blvd., #200
Cupertino, CA 95014

Date:

MAILED

FEB 17 2012

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001265

PATENT NO. : 6812841

TECHNOLOGY CENTER : 3999

ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

**Decision Granting 37 CFR 1.59
Petition in Reexamination**

Control No.: 95/001,265

1. The petition under 37 CFR 1.59 to expunge proprietary, protective order and/or trade secret documents under 37 CFR 1.59 filed April 21, 2011 is granted.
2. The Patent owner's representative requests expungement of document(s) that have been filed under MPEP 724.02. The examiner has determined that the information in such document(s) presented under seal are not material to patentability in the instant reexamination proceeding. Further, the petitioner has complied with all of the requirements of MPEP 724.05.

A. ☐ Since the petition does not specify otherwise, the documents have been:

- i. ☐ Destroyed.
- ii. ☐ Expunged.

B. ☒ Other/Comment: The documents have been expunged.

3. CONCLUSION

Telephone inquiries with regard to this decision should be directed to Sudhanshu C. Pathak at 571-272-5509. In his/her absence, calls may be directed to Mark Reinhart at, 571-272-1611 in the Central Reexamination Unit

/Sudhanshu C. Pathak/
[Signature]

SPRS, CRU-3992
(Title)



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,266	11/13/2009	7440772	AFF.0004B4US	7020
21906	7590	01/06/2011	EXAMINER	
TROP, PRUNER & HU, P.C. 1616 S. VOSS ROAD, SUITE 750 HOUSTON, TX 77057-2631			ART UNIT	PAPER NUMBER

DATE MAILED: 01/06/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Date: 1-6-11

Tracy W. Druce

NOVAK, DRUCE & QUIGG, LLP

1000 Louisiana Street, 53rd Floor

Houston, TX 77002

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001266

PATENT NO. : 7440772

TECHNOLOGY CENTER : 3999

ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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TROP, PRUNER & HU, P.C.
1616 S. VOSS ROAD, SUITE 750
HOUSTON, TX 77057-2631

(For Patent Owner)

TRACY W. DRUCE
NOVAK, DRUCE & QUIGG LLP
1000 LOUISIANA AVENUE, 53RD FLOOR
HOUSTON, TX 77002

(For *Inter Partes* Requester)

Inter Partes Reexamination Proceeding
Control No. 95/001,266
Filed: November 13, 2009
For: U.S. Patent No. 7,440,772

:
: **DECISION**
: **DISMISSING**
: **PETITION**

This is a decision on the November 5, 2010 patent owner petition entitled "PETITION UNDER 37 C.F.R. § 1.183" (the petition under 37 CFR 1.183), requesting waiver of the 37 CFR 1.98 copy requirement and the 37 CFR 1.903 service requirement with respect to "non-U.S. references" (i.e., non-U.S. patent documents and non-patent literature) cited in patent owner's concurrently filed information disclosure statement (IDS) submissions.

The petition is before the Office of Patent Legal Administration for consideration.

The petition fee of \$400.00 pursuant to 37 CFR 1.17(f) for patent owner's petition under 37 CFR 1.183 has been paid.

Patent owner's petition under 37 CFR 1.183 is dismissed for the reasons set forth herein.

BACKGROUND

1. On October 21, 2008, the Office issued U.S. Patent No. 7,440,772 (the '772 patent) to White *et al.*
2. On November 13, 2009, a request for *inter partes* reexamination of the '722 patent was filed by a third party requester and real party in interest, Apple, Inc.. The request was assigned control number 95/001,266 (the '1266 proceeding).
3. On February 5, 2010, *inter partes* reexamination was ordered for the '1266 proceeding.

4. On August 2, 2010, the Office issued a non-final Office action in the '1266 proceeding.
5. On October 1, 2010, patent owner timely filed a response to the August 2, 2010 non-final Office action.
6. On November 1, 2010, third party requester filed comments after patent owner's October 1, 2010 response.
7. On November 5, 2010, patent owner filed the instant petition under 37 CFR 1.183, concurrently with IDS submissions.

DECISION

I. Relevant Regulations and Procedure

37 CFR 1.98(a)(2) provides that any IDS filed under § 1.97 shall include:

A legible copy of:

- (i) Each foreign patent;
- (ii) Each publication or that portion which caused it to be listed, other than U.S. patents and U.S. patent application publications unless required by the Office;
- (iii) For each cited pending unpublished U.S. application, the application specification including the claims, and any drawing of the application, or that portion of the application which caused it to be listed including any claims directed to that portion; and
- (iv) All other information or that portion which caused it to be listed.

37 CFR 1.555(a) provides in-part (emphasis added):

The duty to disclose all information known to be material to patentability in a reexamination proceeding is deemed to be satisfied if all information known to be material to patentability of any claim in the patent after issuance of the reexamination certificate was cited by the Office or submitted to the Office in an information disclosure statement. However, the duties of candor, good faith, and disclosure have not been complied with if any fraud on the Office was practiced or attempted or the duty of disclosure was violated through bad faith or intentional misconduct by, or on behalf of, the patent owner in the reexamination proceeding. Any information disclosure statement must be filed with the items listed in § 1.98(a) as applied to individuals associated with the patent owner in a reexamination proceeding, and should be filed within two months of the date of the order for reexamination, or as soon thereafter as possible.

37 CFR 1.183 provides:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 CFR 1.903 provides:

The patent owner and the third party requester will be sent copies of Office actions issued during the inter partes reexamination proceeding. After filing of a request for inter partes reexamination by a third party requester, any document filed by either the patent owner or the third party requester must be served on every other party in the reexamination proceeding in the manner provided in § 1.248. Any document must reflect service or the document may be refused consideration by the Office. The failure of the patent owner or the third party requester to serve documents may result in their being refused consideration.

II. Patent Owner's Petition

In the instant petition, patent owner requests waiver of the requirement under 37 CFR 1.98 that patent owner submit copies of "non-U.S. references" (i.e., non-U.S. patent documents and non-patent literature; subsequently referred to herein as "references") cited on patent owner's IDS submissions filed concurrently with the instant petition on November 5, 2010.¹ In support of its request for waiver of the rule, patent owner states that it has recently filed (in four boxes) copies of the same references in connection with IDS submissions filed in co-pending reexamination proceeding control no. 95/001,262 (the '1262 proceeding) and that "[t]o avoid the need to re-send these duplicative documents, Patent Owner respectfully requests this petition be granted."² Patent owner also requests waiver of the requirement under 37 CFR 1.903 that patent owner serve copies of these same references on third party requester (Apple Inc.), as patent owner has already served these same documents on Apple Inc. in the co-pending '1262 proceeding.³ Patent owner states that it "makes this petition to avoid the expense and burden on the Patent Owner, Patent Office and Requester that the preparation, filing, uploading to PAIR, and so forth would require of all of these parties" and that "[t]his burden is especially unwarranted, as all of the documents that would be avoided by the granting of this petition have already been provided both to the Patent Office and to Requester."⁴

III. Analysis and Findings

37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition

¹ Petition at page 1.

² *Id.*

³ *Id.* at page 2.

⁴ *Id.*

of the interested party. The burden is on petitioner to set forth with specificity the facts that give rise to an extraordinary situation in which justice requires suspension of a rule.

Waiver of the copy requirement of 37 CFR 1.98(a)(2)

As a general rule, waiver of a rule in the interest of justice is not available when there is recourse within the rules of practice. In this instance, petitioner requests waiver of the rules governing submission of documents to the Office based on the alleged burden of submitting to the Office physical copies of numerous references in multiple reexamination proceedings. In lieu of submitting to the Office physical copies of the references, however, petitioner patent owner may use the Office's Web-based electronic filing system (EFS-Web) to submit electronic copies of the references to the Office. In this way, petitioner need only scan the references into an acceptable electronic format (e.g., Adobe Portable Document Format (PDF)) once, and can then submit the scanned references to the Office via EFS-Web in any number of reexamination proceedings.

Additionally, Office systems, as currently configured, do not have the capability of copying, in bulk, references from the IFW of one reexamination proceeding into the IFWs of other reexamination proceedings. Any such copying by the Office would be on an individual citation basis and would be lengthy and tedious. Thus, if the Office were to grant petitioner's request, the logistics of insuring that each of the references is properly included in the IFW of the instant proceeding would be shifted to the Office. Accuracy of the reexamination file should be paramount when determining who is better positioned to provide the required copies of references cited in an IDS submission. Patent owner has greater knowledge of the references cited in the IDS and is better able to address issues that may arise during introduction of the copies of the references into the instant proceeding. For these reasons, patent owner is better positioned to supply the required copies of the IDS references in question, and therefore must comply with 37 CFR 1.98(a)(2).

Accordingly, for all of the reasons set forth above, petitioner has not presented facts that demonstrate an extraordinary situation in which justice requires suspension of 37 CFR 1.98(a)(2), and the petition is dismissed.

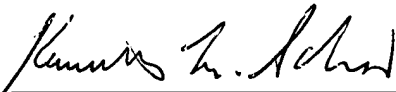
Waiver of the service requirement of 37 CFR 1.903

35 U.S.C. 314(b)(1) provides: "With the exception of the *inter partes* reexamination request, any document filed by either the patent owner or the third-party requester shall be served on the other party." 37 CFR 1.183 is clear that it applies only to a "requirement of the regulations in this part which is not a requirement of the statutes" (emphasis added), and it should be equally clear that a requirement of the statute cannot be waived.

Accordingly, patent owner's petition under 37 CFR 1.183 as to waiver of the service requirement of 37 CFR 1.903 is dismissed.

CONCLUSION

1. Patent owner's November 5, 2010 petition under 37 CFR 1.183 is dismissed.
2. Telephone inquiries related to the present decision should be directed to Nicole Dretar Haines, Legal Advisor, at 571-272-7717.



Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

January 5, 2011
Ken pet 8/



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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/001,267	11/18/2009	6377439	36856.1996

OSTROLENK FABER GERB & SOFFEN LLP
1180 AVENUE OF THE AMERICAS
NEW YORK, NY 10036-8403

EXAMINER
DIAMOND, ALAN D.

ART UNIT	PAPER
3991	

DATE MAILED:

10/12/10

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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/001,267	11/18/2009	6377439	36856.1996

OSTROLENK FABER GERB & SOFFEN LLP
1180 AVENUE OF THE AMERICAS
NEW YORK, NY 10036-8403

EXAMINER
DIAMOND, ALAN D.

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,267	11/18/2009	6377439	36856.1899-439IPR	2424
54066	7590	10/12/2010	EXAMINER	
MURATA MANUFACTURING COMPANY, LTD. C/O KEATING & BENNETT, LLP 1800 Alexander Bell Drive SUITE 200 Reston, VA 20191				
			ART UNIT	PAPER NUMBER
DATE MAILED: 10/12/2010				

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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/001,267	11/18/2009	6377439	36856.1996

O'MELVENY & MYERS LLP
IP&T CALENDAR DEPARTMENT LA-13-A7
400 SOUTH HOPE STREET
LOS ANGELES, CA 90071-2899

EXAMINER

DIAMOND, ALAN D.

ART UNIT PAPER

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COMMUNICATION**

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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/001,267	11/18/2009	6377439	36856.1996

O'MELVENY & MYERS LLP
IP&T CALENDAR DEPARTMENT LA-13-A7
400 SOUTH HOPE STREET
LOS ANGELES, CA 90071-2899

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DIAMOND, ALAN D.

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**INTER PARTES REEXAMINATION
COMMUNICATION**

BELOW/ATTACHED YOU WILL FIND A COMMUNICATION FROM THE UNITED STATES PATENT AND TRADEMARK OFFICE OFFICIAL(S) IN CHARGE OF THE PRESENT REEXAMINATION PROCEEDING.

All correspondence relating to this *inter partes* reexamination proceeding should be directed to the **Central Reexamination Unit** at the mail, FAX, or hand-carry addresses given at the end of this communication.



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Ostrolenk Faber Gerb & Soffen LLP
1180 Avenue of the Americas
New York, NY 10036-8403

(For Patent Owner)

O'Melveny & Myers, LLP
IP&T Calendar Department LA-13-A7
400 South Hope Street
Los Angeles, CA 90071-2899

(For 95/001,267 and 90/010,861
Requester)

Murata Manufacturing Company, Ltd.
C/O Keating & Bennett, LLP
1800 Alexander Bell Drive
Suite 200
Reston, VA 20191

(Courtesy Copy)

MAILED

OCT 12 2010

CENTRAL REEXAMINATION UNIT

In re Hiroshi Sekidou et al.
Inter Partes Reexamination Proceeding
Control No.: 95/001,267
Filed: November 18, 2009
For: U.S. Patent No. 6,377,439

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: **DECISION, *SUA SPONTE*,**
: **TO MERGE**
: **REEXAMINATION**
: **PROCEEDINGS**

In re Hiroshi Sekidou et al.
Ex Partes Reexamination Proceeding
Control No.: 90/010,861
Filed: February 12, 2010
For: U.S. Patent No.: 6,377,439

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The above-captioned reexamination proceedings are before the Office of Patent Legal Administration for *sua sponte* consideration of whether the proceedings should be merged under 37 CFR 1.989 at this time.

BACKGROUND

1. United States Patent Number 6,377,439 ("the '439 patent") issued to Hiroshi Sekidou et al. on April 23, 2002, with five claims.
2. A request for *inter partes* reexamination of claims 1-3 and 5 of the '439 patent was filed November 18, 2009, by third party requester David B. Murphy, in which Samsung Electro-Mechanics Co., Ltd. and Samsung Electro-Mechanics America, Inc. were identified as the real parties in interest, and the request was assigned Reexamination Control No. 95/001,267 ("the '1267 proceeding").

3. An order granting reexamination of claims 1-5 of the '439 patent was mailed for the '1267 proceeding on January 21, 2010; the order was accompanied by a non-final rejection action.
4. On March 19, 2010, the patent owner filed a response to the January 21, 2010 Office action, requesting reconsideration of the rejections of the original claims and adding new claims 6-39.
5. The third party requester in the '1267 proceeding filed a paper titled "Third Party Requester's Comments to Patent Owner's Response of March 19, 2010, Pursuant to 37 C.F.R. § 1.947" on April 15, 2010.
6. A request for *ex parte* reexamination of claims 1-3 and 5 of the '439 patent was filed on February 12, 2010, by third party requester David B. Murphy, and the request was assigned control number 90/010,861 ("the '10861 proceeding").
7. An order granting reexamination of claims 1-5 of the '439 patent was mailed for the '10861 reexamination proceeding on March 18, 2010. No Office action has been issued in the '10861 reexamination proceeding. No Patent Owner statement has been filed in the '10861 reexamination proceeding; and the time for filing same has expired.

DECISION

I. MERGER OF PROCEEDINGS

Reexamination has been ordered in two proceedings for the same claims of the same patent. One of the proceedings (the '1267 proceeding) is an *inter partes* proceeding. The other proceeding (the '10861 proceeding) is an *ex parte* proceeding. Both proceedings are still pending, and have not been terminated. In addition, the period for filing the patent owner's statement in the *ex parte* proceeding has expired. Therefore, consideration of merger pursuant to 37 CFR 1.989 is ripe at this point in time.

37 CFR 1.989 provides:

(a) If any reexamination is ordered while a prior *inter partes* reexamination proceeding is pending for the same patent and prosecution in the prior *inter partes* reexamination proceeding has not been terminated, a decision may be made to merge the two proceedings or to suspend one of the two proceedings. Where merger is ordered, the merged examination will normally result in the issuance of a single reexamination certificate under § 1.997.

(b) An *inter partes* reexamination proceeding filed under § 1.913 which is merged with an *ex parte* reexamination proceeding filed under § 1.510 will result in the merged proceeding being governed by §§ 1.902 through 1.997, except that the rights

of any third party requester of the *ex parte* reexamination shall be governed by §§ 1.510 through 1.560.

MPEP 2686.01 points out: "Where a second request for reexamination is filed and reexamination is ordered, and a first reexamination proceeding is pending, the proceedings will be merged where the Office (in its discretion) deems it appropriate to do so, to facilitate the orderly handling of the proceedings. However, a decision not to merge is within the sole discretion of the Office to facilitate/carry out the statutory mandate of 35 U.S.C. 314(c) to conduct reexamination proceedings with 'special dispatch.'" In this instance, based upon the record as a whole, it is found that merger of the proceedings should facilitate the orderly handling of the proceedings with special dispatch. Accordingly, in accordance with 37 CFR 1.989(a), the 95/001,267 and 90/010,861 proceedings are hereby merged. The merged proceeding will be conducted in accordance with the guidelines and requirements that follow.

II. THE SAME CLAIMS MUST BE MAINTAINED IN BOTH PROCEEDINGS

Patent owner is required to maintain the same claims (and specification) in both files throughout the merged proceeding. New claims 6-39 have been proposed in the '1267 proceeding, while there is no amendment in the '10861 proceeding. Thus, the claims are not currently the same in both files. Accordingly, attached is a copy of the listing of claims from the '1267 proceeding. A copy of these claims will be placed in the '10861 proceeding and claims 1-39 will be addressed in the next Office action on the merits. Such action is appropriate in this situation, because the *inter partes* reexamination requester has already had an opportunity to comment on new claims 6-39 (and has done so).

III. CONDUCT OF MERGED PROCEEDING

A. Governing regulations for the merged proceeding:

The present decision merges an *ex parte* reexamination proceeding with an *inter partes* reexamination proceeding. Pursuant to 37 CFR 1.989(b), the merged proceeding is governed by 37 CFR 1.902 through 1.997, except that the rights of the third party requester of the *ex parte* reexamination are governed by 37 CFR 1.510 through 1.560. In this instance, however, the *ex parte* reexamination was requested by the same third party that requested the *inter partes* reexamination.

B. *Inter partes* Third Party Requester Participation:

1. Comment rights:

The *inter partes* requester can comment pursuant to 35 U.S.C. 314(b)(2).¹ First, an *inter partes*

¹ Each time that the patent owner files a response to an action on the merits from the Patent and Trademark Office, the third-party requester shall have one opportunity to file written comments addressing issues raised by the action of the Office or the patent owner's response thereto, if those written comments are received by the Office within 30 days after the date of service of the patent owner's response.

requester's right to comment is contingent upon the patent owner responding to, or commenting on, an Office action. Second, the *inter partes* requester's right to comment is limited to issues raised in either the Office action or the patent owner's response to the action.

2. Appeal Rights:

The *inter partes* reexamination procedures for taking appeal, and for participating in the patent owner's appeal, are explained in MPEP 2674 through 2675.02, 2678 through 2683. As pointed out in MPEP 2674:

A notice of appeal by a third party requester must identify each rejection *that was previously proposed by that third party requester* which the third party requester intends to contest. It is not sufficient to merely appeal from the allowance of a claim (i.e., the examiner's finding of a claim patentable); the third party requester must identify each previously proposed rejection to be contested.

Thus, the *inter partes* reexamination requester's appeal must **only** be taken from the finding(s) of patentability of claims in the RAN as to the rejections the third party requester proposed in the *inter partes* reexamination request (not as to the rejections proposed in the *ex parte* reexamination request), and any that the third party requester properly added during the examination stage of the merged proceeding. Also, as provided by 37 CFR 41.67(c)(1)(vi):

No new ground of rejection can be proposed by a third party requester appellant, unless such ground was withdrawn by the examiner during the prosecution of the proceeding, and the third party requester has not yet had an opportunity to propose it as a third party requester proposed ground of rejection.

Thus, an appellant's brief shall present a concise statement of each issue. And, no new ground of rejection (i.e., a ground that the requester did not propose in the *inter partes* reexamination request, or during the merged proceeding) can be proposed by a third party requester appellant, unless that ground was withdrawn by the examiner during the prosecution of the proceeding, and the third party requester did not yet have an opportunity to propose it as a third party requester proposed ground of rejection.

C. Papers mailed/filed:

All papers mailed by the Office throughout the merged proceeding will take the form of a single action which applies to both proceedings. All papers issued by the Office, or filed by the patent owner and the third party requester(s), will contain the identifying data for both files and will be physically entered in each reexamination file. All papers filed by the patent owner and the third party requester(s) must consist of a single paper, filed in duplicate, each bearing a signature and identifying data for both files, for entry into each file.

All papers filed by the patent owner and the third party requester(s) should be directed:

by Mail to: Attn: Mail Stop "Inter Partes Reexam"
Central Reexamination Unit
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

by FAX to: (571) 273-9900
Central Reexamination Unit

by Hand to: Customer Service Window
Attn: Central Reexamination Unit
Randolph Building, Lobby Level
401 Dulany Street
Alexandria, VA 22314

by EFS: Registered users may submit papers via the
electronic filing system EFS-Web, at:

<https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html>

Patent owner and requester are reminded that every paper filed in the merged proceeding subsequent to this decision must be served on the other party (including papers filed *via* facsimile transmission), and every paper filed must reflect that such paper was served on the other party, pursuant to 37 CFR 1.903. All papers are to be addressed to the Central Reexamination Unit as provided above.

D. Amendments:

The filing of any amendments to the drawings, specification or claims must comply with 37 CFR 1.943, which incorporates the provisions of 37 CFR 1.530, and the guidelines of MPEP § 2666.01, which in turn references the guidelines of MPEP § 2250.

37 CFR 1.121 does not apply to amendments in reexamination. Accordingly, clean copies of the amended claims are not required and are not to be submitted; rather amendments are to be presented via markings pursuant to paragraph 37 CFR 1.530(f), except that a claim should be canceled by a statement canceling the claim, without presentation of the text of the claim.

Pursuant to 37 CFR 1.530(i), all amendments must be made relative to the patent specification, including the claims, and drawings, which are in effect as of the date of filing the request for reexamination. *Amendments are not to be made relative to previous amendments.* Thus, for all amendments, all words not appearing in the patent are always underlined, and only words being deleted from the patent appear in brackets.

E. Fees:

Where a paper is filed that requires payment of a fee (e.g., petition fee, excess claims fee, extension of time fee, appeal fee, brief fee, oral hearing fee), only a single fee need be paid. For example, only one fee need be paid for any patent owner's appellant brief (or that of the *inter partes* reexamination requester) which may be filed, even though the brief relates to merged multiple proceedings, and copies must be filed (as pointed out above) for each file in the merged proceeding.

F. Citation of Patents and Printed Publications:

Upon return of the present merged proceeding to the examiner, the examiner will review the files to insure that each file contains identical citations of prior patents and printed publications, and will cite such documents as are necessary as part of the next action in order to place the files in that condition.

PATENT OWNER'S ADDRESS

The current correspondence address of record for the patent file is the proper patent owner address for reexamination mailings, pursuant to 37 CFR 1.33(c). The current correspondence address of record for the 6,377,439 patent file is that of Ostrolenk Faber Gerb & Soffen LLP, 1180 Avenue of the Americas, New York, NY 10036-8403.

As a courtesy, this decision is being mailed to the address of Murata Manufacturing Company, Ltd., C/O Keating & Bennet, LLP, 1800 Alexander Bell Drive, Suite 200, Reston, VA 20191, in view of the December 2, 2009 Power of Attorney in the file of the '1267 reexamination proceeding and the February 18, 2010 Power of Attorney in the file of the '10861 reexamination proceeding.

The address of Ostrolenk Faber Gerb & Soffen LLP, 1180 Avenue of the Americas, New York, NY 10036-8403, will be the sole patent owner correspondence address used in future correspondence, until a change in correspondence address in the '439 patent file is made in accordance with 37 CFR 1.33(c).

CONCLUSION

1. *Inter partes* Reexamination Control No. 95/001,267 and *ex parte* Reexamination Control No. 90/010,861 are merged into a single proceeding, to be conducted in accordance with the procedure set forth above.
2. A current and complete listing of the claims from 95/001,267 has been placed in the *ex parte* 90/010,861 proceeding to replace any prior listing, thus, making claims the same in both proceedings.
3. The address of Ostrolenk Faber Gerb & Soffen LLP, 1180 Avenue of the Americas, New York, NY 10036-8403, will be the sole patent owner correspondence address used in

future correspondence, until a change in correspondence address in the '439 patent file is made in accordance with 37 CFR 1.33(c).

4. The examiner will prepare an Office action on the merits for the merged proceeding in due course.
6. Any questions concerning this communication should be directed to Raul Tamayo, Legal Advisor, at 571-272-7728.

/Kenneth M. Schor/

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

Attachment: 6 pages



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,267	11/18/2009	6377439	36856.1899-439IPR	2424
54066	7590	06/17/2011	EXAMINER	
MURATA MANUFACTURING COMPANY, LTD. C/O KEATING & BENNETT, LLP 1800 Alexander Bell Drive SUITE 200 Reston, VA 20191			ART UNIT	PAPER NUMBER

DATE MAILED: 06/17/2011

Please find below and/or attached an Office communication concerning this application or proceeding.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

Inter partes Samsung Electro-Mechanics Co., Ltd. &
Samsung Electro-Mechanics America, Inc.

Requesters

v.

Murata Manufacturing Co., Ltd.

Patent Owner

Merged Reexamination Control No. 95/001,267 & 90/010,861

Patent 6,377,439

Technology Center 3900

DECISION ON PETITION

This is a decision on patent owner's "Petition under 37 C.F.R. § 1.183 to Waive Page Limit Set by 37 C.F.R. § 1.943(c)," filed May 25, 2011. Petitioner requests waiver of the 14,000 word limit of 37 C.F.R. § 1.943(c), to permit entry of the patent owner's appellant brief indicated to be 46 pages. The petition fee of \$400 in accordance with 37 C.F.R. § 1.17(f) was

charged to petitioner's credit card account on May 25, 2011, along with the appeal brief fee.

FINDINGS

1. On November 18, 2009, third party requester filed a request for *inter partes* reexamination of U.S. Patent No. 6,377,439, which was assigned control no. 95/001,267.
2. Reexamination was ordered and a non-final Office action was mailed in the '267 proceeding on January 21, 2010, rejecting claims 1-5.
3. On February 12, 2010, third party requester filed a request for *ex parte* reexamination of U.S. Patent No. 6,377,439, which was assigned control no. 90/010,861.
4. Reexamination was ordered in the '861 proceeding on March 18, 2010.
5. In the '267 proceeding, patent owner filed a response to the Office action on March 19, 2010, adding claims 6-39, and third party requester filed comments in reply to the Office action and patent owner's response on April 15, 2010, within the 50 page limit pursuant to 37 C.F.R. § 1.943(b).
6. On October 12, 2010, the reexamination proceedings were merged.
7. On October 22, 2010, an Action Closing Prosecution (ACP) was mailed in the merged proceeding.
8. Patent owner filed a response on November 19, 2010 and third party requester filed comments on December 17, 2010, within the 50 page limit pursuant to 37 C.F.R. § 1.943(b).
9. On February 25, 2011, a Right of Appeal Notice (RAN) was mailed.

10. Patent Owner filed a Notice of Appeal on March 25, 2011, appealing the rejections of claims 1-5 and 7-39.

11. On May 25, 2011, Patent Owner filed an appellant's brief appealing the rejections of claims 1-5 and 7-39, and accompanied by the present petition.

DISCUSSION

In the present Petition, patent owner requests waiver of 37 C.F.R. § 1.943(c), which limits patent owner's appellant brief to thirty pages or 14,000 words in length. The patent owner's appellant brief is stated to be less than 46 pages.

Waiver is requested for the following reasons:

- (1) The RAN mailed on February 25, 2011, includes 12 prior art rejections and contains 55 pages.
- (2) The interests of justice require waiver of this rule so that Murata may fairly and completely address each of the rejections and arguments presented by the examiner.
- (3) It is not realistic that a patent owner could fairly and completely address each of the rejections and arguments set forth by the examiner in slightly more than one-half of the number of pages that was used by the examiner to set forth the explanations of the twelve different prior art rejections.

(4) The appellant's brief must be responsive to every grounds of rejection included in the Right of Appeal Notice, that Murata is presenting for review on appeal.

RELEVANT AUTHORITY

37 CFR 1.183 provides:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 CFR 1.943(c) provides:

Appellant's briefs filed by the patent owner and the third party requester shall not exceed thirty pages or 14,000 words in length, excluding appendices of claims and reference materials such as prior art references. All other briefs filed by any party shall not exceed fifteen pages in length or 7,000 words. If the page limit for any brief is exceeded, a certificate is required stating the number of words contained in the brief.

MPEP § 2667 I.A.2 (Response filed by Patent Owner that is too long) provides:

With respect to the length of the papers, the following additional information is to be noted. Similar to the Federal Rules of Appellate Procedure, the provisions of 37 CFR 1.943(c) are waived to the extent that the table of contents pages, the table of case law pages, and the pages of the claims (but not claim charts applying the art to the claims) are excluded from the thirty (30) page limit required by 37 CFR 1.943(c). Any affidavit or declaration (or a clearly defined portion thereof) that contains opinion(s) of the affiant/declarant, or argument(s) that the art either does or does not anticipate or render obvious the claims, or specific claim elements, of the patent under reexamination, is considered to be part of the comments submitted by the patent owner, or by the third party requester, and is subject to the page limit requirements of 37 CFR 1.943. Affidavits or declarations that are excluded from the page limit requirements include, for example, declarations attempting to swear behind (antedate) the filing date of a reference, or to establish the date of a printed publication, or declarations that provide comparative test data and an analysis of same. However, if the patent owner's affidavit or declaration includes any argument as to how an outstanding/proposed rejection is overcome, then the page(s) of the affidavit or declaration upon which the argument appears would be included against the page limit count. Likewise, if a third party requester affidavit or declaration includes any argument as to how a rejection is supported, then the page(s) of the affidavit or declaration upon which the argument appears would be included against the page limit count. Similarly, attached exhibits presenting data or drawings are not included against the page limit count, unless an exhibit or drawing

Inter Partes Reexamination Control No. 95/001,267 & 90/010,861
Patent No. 6,377,439

includes argument as to how the outstanding rejection is overcome. Any page(s) of the exhibit or sheet(s) of drawings that include such argument would be included against the page limit count.

MPEP § 2667 I.B.2 (Response filed by Third Party Requester that is too long) provides:

For additional information with respect to the length of papers, see Subsection I.A.2 above.

ANALYSIS

Upon review of the prosecution history of this proceeding, it is noted that the patent owner and third party requester responses and comments prior to appeal have been well within the page limit requirements. However, the appellant brief filed subsequent to appeal is significantly longer, whereas the rules require that the appellant brief be more limited than pre-appeal responses. Patent owner's appellant brief filed on May 25, 2011, is stated to be less than 46 pages which count toward the limit of 30 pages and 14,000 words.

Petitioner's reasons provided in support of waiving the page/word limits focus on the length of the RAN, and the numerous rejections which are appealed. However, the prosecution history reveals that the patent owner chose to present an additional 34 claims in their amendment in response to the non-final Office action, without canceling any of the original 5 patent claims. It is not surprising that Patent Owner is now challenged by the page and word limit, given that the number of claims being examined has increased from 5 to 39, and is now more than seven times the number of original patent claims. The Patent Owner caused this challenge itself. Presenting the Office with 34 new claims is not conducive to expediting *inter partes* reexamination of the instant patent.

The RAN contains one rejection under 35 U.S.C. 102(b) of 3 new claims, and 11 separate grounds of rejections under 35 U.S.C. 103(a) of 38 claims, as compared to the non-final action which contains one 102(b) rejection and seven 103(a) rejections of the 5 original patent claims. Patent owner's amendment necessitated new grounds of rejections by adding claims 6-39. Patent Owner responded to the new rejections prior to the RAN, *i.e.*, in response to the ACP of October 22, 2010, within the page limit requirements.

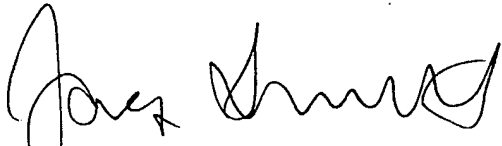
Patent Owner asserts that the length of appellant's brief is due to the number of grounds of rejection on appeal. Patent Owner contests each of the grounds of rejection on appeal. However, the brief includes 12 separate arguments addressing the rejections and 5 more sets of arguments addressing the examiner's response to previous arguments. It is not evident how appellant has attempted to consolidate their arguments so as to comply with the page and word limit. It is not surprising that Patent Owner is now challenged by the page and word limit, given that the number of issues has been expanded from 8 to 12 issues, and by virtue of all the claims added by Patent Owner.

A persuasive showing has not been made that this situation is extraordinary nor that justice requires that significantly more pages/words be allotted to appellant's brief compared to prior responses and comments submitted in reply to actions issued by the Office.

DECISION

Appellant is given one opportunity to file a corrected appellant brief in compliance with 37 CFR 1.943(c), within a non-extendable time period of 1 month from the mailing date of this decision. If a corrected appellant brief is not timely submitted, the appellant's appeal will be dismissed.

In view of the foregoing, the Petition is DENIED.



James Donald Smith
Chief Administrative Patent Judge

Counsel for Patent Owner:
KEATING & BENNETT, LLP
1800 Alexander Bell Drive
Suite 200
Reston, VA 20191

Counsel for Third Party Requester:
O'MELVENY & MYERS LLP
IP & T Calendar Department LA-13-A7
400 South Hope Street
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UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,267	11/18/2009	6377439	36856.1899-439IPR	2424
54066	7590	11/15/2011	EXAMINER	
MURATA MANUFACTURING COMPANY, LTD. C/O KEATING & BENNETT, LLP 1800 Alexander Bell Drive SUITE 200 Reston, VA 20191			ART UNIT	PAPER NUMBER

DATE MAILED: 11/15/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

O'MELVENY & MYERS LLP

IP & T CALENDAR DEPARTMENT LA-13-A7

400 SOUTH HOPE STREET

LOS ANGELES, CA 90071-2899

Date: **MAILED**

NOV 15 2011

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001267

PATENT NO. : 6377439

TECHNOLOGY CENTER : 3999

ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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Alexandria, VA 22313-1450
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NOV 15 2011

CENTRAL REEXAMINATION UNIT

Murata Manufacturing Company, Ltd.
C/O Keating & Bennett, LLP
1800 Alexander Bell Drive
Suite 200
Reston, Virginia 20191

(For Patent Owner)

O'Melveny & Myers, LLP
IP&T Calendar Department LA-13-A7
400 South Hope Street
Los Angeles, California 90071-2899

(For 95/001,267 and 90/010,861
Requester)

In re Hiroshi Sekidou et al.
Inter Partes Reexamination Proceeding
Control No.: 95/001,267
Filed: November 18, 2009
For: U.S. Patent No. 6,377,439

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: **DECISION DISMISSING**
: **PETITION TO**
: **SET ASIDE MERGER**

In re Hiroshi Sekidou et al.
Ex Partes Reexamination Proceeding
Control No.: 90/010,861
Filed: February 12, 2010
For: U.S. Patent No.: 6,377,439

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This is a decision on patent owner's October 21, 2010 petition titled "PETITION UNDER 37 C.F.R. §§ 1.182 AND 1.183 TO RECONSIDER AND SET ASIDE THE MERGER OF CO-PENDING REEXAMINATIONS." On November 4, 2010, third party requester filed an opposition to patent owner's October 21, 2010 petition, which has also been considered.

The patent owner petition and requester opposition are before the Office of Patent Legal Administration for consideration.

Patent Owner's petition is **dismissed** for the reasons set forth below.

REVIEW OF FACTS

1. United States Patent Number 6,377,439 ("the '439 patent") issued to Hiroshi Sekidou et al. on April 23, 2002, with five claims.

2. A request for *inter partes* reexamination of claims 1-3 and 5 of the '439 patent was filed November 18, 2009, by a third party requester, and was assigned Reexamination Control No. 95/001,267 ("the '1267 proceeding"). The request identified Samsung Electro-Mechanics Co., Ltd. and Samsung Electro-Mechanics America, Inc. as the real parties in interest.
3. An order granting reexamination of claims 1-5 of the '439 patent was mailed for the '1267 proceeding on January 21, 2010; the order was accompanied by a non-final rejection action.
4. A request for *ex parte* reexamination of claims 1-3 and 5 of the '439 patent was filed on February 12, 2010, by a third party requester, and the request was assigned control number 90/010,861 ("the '10861 proceeding").
5. An order granting reexamination of claims 1-5 of the '439 patent was mailed for the '10861 reexamination proceeding on March 18, 2010.
6. On March 19, 2010, the patent owner filed a response to the January 21, 2010 Office action in the '1267 proceeding, requesting reconsideration of the rejections of the original claims and adding new claims 6-39.
7. On April 15, 2010, the third party requester in the '1267 proceeding filed a paper titled "Third Party Requester's Comments to Patent Owner's Response of March 19, 2010, Pursuant to 37 C.F.R. § 1.947".
8. The time for filing a patent owner's statement pursuant to 37 CFR 1.530 in the '10861 *ex parte* reexamination proceeding expired after May 18, 2010.¹
9. On October 12, 2010, the Office, *sua sponte*, issued a decision merging the '1267 *inter partes* reexamination proceeding with the '10861 *ex parte* reexamination proceeding ("the merged proceeding").
10. On October 21, 2010, patent owner filed the instant petition requesting reconsideration of the October 12, 2010 merger decision.
11. On October 22, 2010, the Office issued an Action Closing Prosecution (37 CFR 1.949) ("ACP") for the merged proceeding in which claims 1-39 were rejected. Notably, the ACP stated that the sole reference cited in the request and order for the '10861 proceeding "is not relied upon in any ground of rejection in this Action Closing Prosecution."

¹ There is no provision for filing a patent owner's statement in an *inter partes* reexamination proceeding; instead, an Office action on the merits is issued prior to any input from the parties.

12. On November 4, 2010, third party requester filed an opposition petition to patent owner's October 21, 2010 petition to set aside merger. The November 4, 2010 third party requester opposition petition has also been considered for purposes of this decision.
13. Patent owner timely filed on November 19, 2010, a response to the October 22, 2010 ACP for the merged proceeding. The November 19, 2010 response included an amendment cancelling claim 6.
14. On December 17, 2010, third party requester timely filed in the merged proceeding comments pursuant to 37 CFR 1.951(b) after patent owner's November 19, 2010 response to ACP. Notably, third party requester did not comment on the examiner's decision to not rely upon the sole reference from the '10861 proceeding in any ground of rejection in the ACP.
15. The Office issued a Right of Appeal Notice (37 CFR 1.953) ("RAN") for the merged proceeding on February 25, 2011, in which claims 1-5 and 7-39 were rejected. Again, the examiner did not rely upon the sole reference from the '10861 proceeding in any ground of rejection in the RAN.
16. Patent owner timely filed on March 25, 2011, a Notice of Appeal for the merged proceeding in response to the February 25, 2011 RAN. Third party requester did not file a notice of cross appeal.
17. On May 25, 2011, patent owner filed an appellant's brief, together with a petition to waive the page limit set by 37 CFR 1.943(c) in the merged proceeding.
18. On June 17, 2011, the Office issued a decision on petition for the merged proceeding denying the May 25, 2011 patent owner petition for waiver of page limit and giving a period of one month to file a corrected brief.
19. On July 15, 2011, patent owner timely filed a corrected appellant's brief in the merged proceeding.
20. On August 12, 2011, third party requester timely filed a respondent's brief in the merged proceeding.

DECISION

I. Issues Raised

The October 21, 2010 patent owner petition raises the following issues: (1) the decision to merge the '1267 and '10861 reexamination proceedings allows third party requester "to participate in an *ex parte* reexamination in violation of 35 U.S.C. 302 and 37 CFR 1.501 *et seq.*;" and (2) merger of the '1267 and '10861 reexamination proceedings denies patent owner "its right

to request to interviews with the examiner and its *de facto* right to conduct further interviews with the examiner.”

II. Analysis

1. At the outset, it must be noted that the sole reference cited in the request and order for the ‘10861 proceeding has not been relied upon in any ground of rejection in either the October 22, 2010 Action Closing Prosecution or the February 25, 2011 RAN, and third party requester has neither commented on nor appealed the examiner’s position in this regard. According to the examiner at page 2 of the October 22, 2010 ACP, while the reference from the ‘10861 proceeding raised a substantial new question of patentability, it “does not present a better *prima facie* case for either anticipation or obviousness compared to the prior art [from the ‘1267 proceeding].” Therefore, the issue of improper participation by the third party requester of the ‘10861 *ex parte* proceeding has been rendered moot.

Even if the reference from the ‘10861 proceeding had been relied upon in a rejection in the merged proceeding, patent owner’s assertion that the October 12, 2010 merger decision “allows Requester as the third-party requester to participate in an *ex parte* reexamination in violation of 35 U.S.C. 302 and 37 CFR 1.501 *et seq.*” is incorrect.

When the Office decides to merge two reexamination proceedings, the merger still results in each requesting party participating only to the extent permitted by the statutes and regulations that govern the proceeding each requester initiated. Thus, in a merged *inter partes* and *ex parte* proceeding, the *ex parte* requester possesses no comment rights, and the *inter partes* requester possesses comment rights as established by 35 U.S.C. 314(b)(2) on all issues now present in the merged proceeding.² In the present merged proceeding, any comments submitted by third party requester is by virtue of the statutory right to comment set forth in 35 U.S.C. 314(b)(2). To deny third party requester the right to comment would be to deprive third party requester of a right bestowed by statute (35 U.S.C. 314(b)(2)). Accordingly, 35 U.S.C. 302 and 37 CFR 1.501 *et seq.* are not violated by the merger of *inter partes* and *ex parte* reexamination proceedings.

2. With respect to patent owner’s argument that the present merger has denied patent owner the right to request an interview, it must again be noted that the sole reference cited in the request and order for the ‘10861 proceeding has not been relied upon in any ground of rejection during the merged proceeding. Thus, the unavailability of an interview did not prejudice patent owner.

Even if the reference from the ‘10861 proceeding had been relied upon in a rejection during the merged proceeding, patent owner’s “right to request an interview” argument is without merit. No statutory or regulatory right to conduct an interview exists. While 37 CFR 1.133 and 1.560 provide the guidelines for conducting and making a record of interviews, 37 CFR 1.133(a) and 1.560 do not confer a right to an interview. *Inter partes* reexamination rule 37 CFR 1.955 states

² Pursuant to 35 U.S.C. 312, the Director has the right to interject issues into an *inter partes* reexamination for consideration by both the patent owner and the third party, including the interjection of issues from other co-pending or related proceedings.

that no interviews on the merits are permitted in an *inter partes* reexamination.³ The relevant sections of the MPEP provide guidance on the conduct of interviews to include denial of an interview.⁴ However, none of the relevant rules or MPEP sections regarding interviews before the Office creates a “right to request an interview.”

The Office acknowledges that interviews may be of value in developing and clarifying issues, hence the discretion that examiners have to grant an interview.⁵ Ultimately, however, the basis of any action taken by the Office must be done in writing, and patent owner must file a response in writing.⁶ The Office also acknowledges that the present merged proceeding removes the examiner’s discretion to grant an interview on the merits.⁷ However, the removal of examiner discretion to permit merits interviews safeguards the rights of all parties to the merged reexamination proceeding and promotes the conduct of all business before the Office on paper, thus ensuring that all determinations are made based upon the record.⁸

Merger represents the Office’s determination that consistent and timely resolution of all known issues of patentability in support of the statutory mandate of special dispatch outweighs any patent owner “expectancy” to conduct an interview on the merits as to issues raised in the *ex parte* proceeding. Patent owner was placed on notice by 37 CFR 1.989 and 37 CFR 1.955, which were adopted through full notice and comment rulemaking, that any expectancy to have an interview regarding issues raised in an *ex parte* proceeding would be curtailed upon merger with an *inter partes* proceeding. Therefore, no reasonable expectation of a right to an interview under the present circumstances can be asserted.

Finally, when a patent owner establishes the existence of an extraordinary circumstance in an *inter partes* reexamination proceeding, via petition for a waiver of 37 CFR 1.955 under 37 CFR 1.183 to conduct an interview, the Office may grant an interview. The Office has granted petitions for waiver of 37 CFR 1.955.⁹

For all of the reasons set forth above in this decision, patent owner’s October 21, 2010 petition is **dismissed**.

³ In the extraordinary circumstance where the *inter partes* requester has opted to not participate in the *inter partes* reexamination proceeding, a patent owner can petition for a waiver of 37 CFR 1.955 under 37 CFR 1.183 to conduct an interview.

⁴ See MPEP §§ 713 *et seq.*, 2281 and 2685.

⁵ “An interview should be had only when the nature of the case is such that the interview could serve to develop and clarify specific issues and lead to a mutual understanding between the examiner and the applicant, and thereby advance the prosecution of the application.” MPEP 713.01.

⁶ “All business with the Patent and Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. *The action of the Patent and Trademark Office will be based exclusively on the written record in the Office.* No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.” 37 CFR 1.2 (emphasis added).

⁷ See 37 CFR 1.955. See also MPEP 2685.

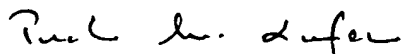
⁸ See 37 CFR 1.2 *infra* note 18.

⁹ See *inter partes* reexamination proceeding 95/000,199 (Petition Decision Oct. 28, 2009); *inter partes* reexamination proceeding 95/000,274 (Petition Decision Oct. 8, 2008); and *inter partes* reexamination proceeding 95/000,283 (Petition Decision Sep. 17, 2008).

The Office regrets the delay in recognizing the presence of the petition in the proceeding and the issuance of this decision at this late date.

CONCLUSION

1. The October 21, 2010 patent owner petition is dismissed.
2. *Inter partes* Reexamination Control No. 95/001,267 and *ex parte* Reexamination Control No. 90/010,861 remain merged as a single proceeding.
3. The examiner will proceed to issue an examiner's answer under 37 CFR 41.69 or take other appropriate action.
4. Any questions concerning this communication should be directed to Raul Tamayo, Legal Advisor, at 571-272-7728.



Pinchus M. Laufer
Senior Legal Advisor
Office of Patent Legal Administration

11-10-11



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,268	11/19/2009	6861155	038-0004RX	3705
27890	7590	05/13/2011	EXAMINER	
STEPTOE & JOHNSON LLP 1330 CONNECTICUT AVENUE, N.W. WASHINGTON, DC 20036			ART UNIT	PAPER NUMBER

DATE MAILED: 05/13/2011

Please find below and/or attached an Office communication concerning this application or proceeding.



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

WONG, CABELLO, LUTSCH, RUTHERFORD & BRUCCULERI, LLP
20333 SH 249 6TH STREET
HOUSTON, TX 77070

Date:

MAILED

MAY 13 2011

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001268

PATENT NO. : 6861155

TECHNOLOGY CENTER : 3999

ART UNIT : 3991

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

Decision on Petition for Extension of Time in Reexamination	Control No.: 95/001,268	MAILED MAY 13 2011
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CENTRAL REEXAMINATION UNIT

1. THIS IS A DECISION ON THE PETITION FILED May 6, 2011

2. THIS DECISION IS ISSUED PURSUANT TO:
 - A. ☐ 37 CFR 1.550(c) – The time for taking any action by a patent owner in an *ex parte* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.
 - B. ☒ 37 CFR 1.956 – The time for taking any action by a patent owner in an *inter partes* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.
The petition is before the Central Reexamination Unit for consideration.

3. FORMAL MATTERS


Patent owner requests that the period for responding to the Office action mailed on April 21, 2011, which sets a one-month period for filing a response thereto, be extended by an unknown amount of time.

 - A. ☒ Petition fee per 37 CFR §1.17(g):
 - i. ☒ Petition includes authorization to debit a deposit account.
 - ii. ☐ Petition includes authorization to charge a credit card account.
 - iii. ☐ Other: _____
 - B. ☒ Proper certificate of service was provided. (Not required in reexamination where patent owner is requester.)
 - C. ☒ Petition was timely filed.
 - D. ☒ Petition properly signed.

4. DECISION (See MPEP 2265 and 2665)
 - A. ☐ Granted or ☐ Granted-in-part for _____, because petitioner provided a factual accounting that established sufficient cause. (See 37 CFR 1.550(c) and 37 CFR 1.956).
☐ Other/comment: _____
 - B. ☒ Dismissed because:
 - i. ☐ Formal matters (See unchecked box(es) (A, B, C and/or D) in section 4 above).
 - ii. ☒ Petitioner failed to provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period.
 - iii. ☒ Petitioner failed to explain why, in spite of the action taken thus far, the requested additional time is needed.
 - iv. ☐ The statements provided fail to establish sufficient cause to warrant extension of the time for taking action (See attached).
 - v. ☐ The petition is moot.
 - vi. ☐ Other/comment: _____

5. CONCLUSION

Telephone inquiries with regard to this decision should be directed to Deborah Jones at 571-272-1535 in the Central Reexamination Unit.


 [Signature]

5/11/2011
 (Title)

DEBORAH D. JONES
 CRI/SPF-AI/3991



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,269	12/08/2009	6502135	77580-89	2038
23630	7590	08/13/2010	EXAMINER	
McDermott Will & Emery 600 13th Street, NW Washington, DC 20005-3096			ART UNIT	PAPER NUMBER

DATE MAILED: 08/13/2010

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
ROTHWELL, FIGG, ERNST & MANBECK, P.C.
1425 K STREET N.W.
SUITE 800
WASHINGTON, D.C.

Date: **MAILED**
AUG 13 2010
CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001269
PATENT NO. : 6502135
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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Toby H. Kusmer
McDermott Will & Emery
600 13th Street, NW
Washington DC 20005-3096

(For Patent Owner)

MAILED

AUG 13 2010

CENTRAL REEXAMINATION UNIT

William N. Hughet
Rothwell, Figg, Ernst & Manbeck, P.C.
1425 K Street NW
Suite 800
Washington, D.C. 20005

(For *Inter Partes* Requester)

In re Munger et al.
Inter partes Reexamination Proceeding
Control No. 95/001,269
Filed: December 8, 2009
For: U.S. Patent No. 6,502,135

:
:
: **DECISION**
:
: **DISMISSING**
:
: **PETITION**
:

This is a decision on the May 24, 2010 patent owner petition entitled, "PETITION UNDER 37 C.F.R. § 1.183 TO WAIVE 37 C.F.R. § 1.955".

The petition fee of \$400.00 pursuant to 37 C.F.R. § 1.17(f) for patent owner's petition under 37 C.F.R. § 1.183 was charged to patent owner's deposit account 50-1133, as authorized by the patent owner.

The patent owner petition is before the Office of Patent Legal Administration for consideration.

The petition is dismissed.

REVIEW OF FACTS

1. U.S. Patent No. 6,502,135 (the '135 patent) issued to Munger et al. on December 31, 2002, with 17 claims.
2. A civil litigation involving the '135 patent (commenced on February 15, 2007), captioned *Virnetx, Inc. v. Microsoft Corporation*, U.S. District Court, Texas Eastern, Case No. 6:07cv00080ELD.

3. On November 25, 2009, a request for *inter partes* reexamination of claims 1-10 and 12 of the '135 patent was deposited by a third party requester, Microsoft Corporation (a party to the concurrent civil litigation). A corrected request was filed December 8, 2009, which received a filing date and was assigned control no. 95/001,269 (the '1,269 proceeding).
4. On December 31, 2009, reexamination was ordered for claims 1-10 and 12 of the '135 patent.
5. On January 15, 2010, a first Office action was issued in the '1,269 proceeding.
6. On April 15, 2010, patent owner timely filed a response to the January 15, 2010 Office action.¹
7. On May 18, 2010, third party requester filed a paper entitled "THIRD PARTY REQUESTER'S NOTICE OF NON-PARTICIPATION," notifying the Office of third party requester's withdrawal from participation in the '1,269 proceeding.
8. On May 24, 2010, patent owner filed a petition paper entitled "'PETITION UNDER 37 C.F.R. § 1.183 TO WAIVE 37 C.F.R. § 1.955'".
9. On June 16, 2010, the Office issued an Action Closing Prosecution (ACP) confirming claims 1-10, 12 and finding new claim 18 patentable.

Relevant Statutes, Regulations and Procedures

37 CFR 1.183 provides:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 CFR 1.955 provides:

There will be no interviews in an *inter partes* reexamination proceeding which discuss the merits of the proceeding. [Emphasis Added]

¹ On February 22, 2010, patent owner petitioned for an extension of time, which was granted in part on February 25, 2010, extending the period for response to April 15, 2010.

Petition to Waive the 37 CFR 1.955 Prohibition of Interviews

In the May 24, 2010 petition under 37 CFR 1.183, patent owner requests waiver of the requirements of 37 CFR 1.955, prohibiting interviews on the merits in an *inter partes* reexamination proceeding, in view of third party requester's May 18, 2010 withdrawal from participation in the '1,269 proceeding.²

In patent owner's petition under 37 CFR 1.183, patent owner has requested "waiver of § 1.955 and requests an interview with the Examiner," which is taken as a request for a single interview.³ In support of its request for waiver of 37 CFR 1.955, patent owner states that because third party requester has withdrawn from participating in the '1,269 proceeding, only one party—the patent owner—will now participate in the '1,269 proceeding before Office."⁴ Patent owner asserts that because the third party requester will no longer participate in the present proceeding, waiver of 37 CFR 1.955 should be granted because the Office has granted such in other proceedings with a non-participating third party requester.⁵ Finally patent owner asserts that by allowing patent owner to discuss the merits of the proceeding in an interview, it will promote an expedited resolution of outstanding issues in keeping with the statutory special dispatch requirements.⁶ Accordingly, patent owner requests waiver of 37 CFR 1.955 and an interview with the examiner.

DECISION

37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party. The burden is on petitioner to set forth with specificity the facts that give rise to an extraordinary situation in which justice requires suspension of a rule.

A review of the *Notice of Final Rule Making, Rules to Implement Optional Inter Partes Reexamination Proceedings*, 65 FR 76755 (Dec. 7, 2000), 1242 *Off. Gaz. Pat. Office* 12 (Jan. 2, 2001) (final rule) reveals that the Notice of Proposed Rule Making proposed implementation of a regulation that would have permitted interviews in *inter partes* reexamination proceedings. In the final rule, however, the Office decided to preclude both *ex parte* and *inter partes* interviews in an *inter partes* reexamination proceeding, and accordingly published 37 CFR 1.955 in its present form.⁷ The Office concluded that, for a variety of reasons, "[n]o matter what the structure of the interview, the presence of a third party requester (or a separate interview with the requester) will complicate the reexamination proceeding and significantly delay it."⁸ Thus, the basis for the present 37 CFR 1.955 proscription of all and any interviews in an *inter partes* reexamination proceeding was that the presence of two (or more) parties in the proceeding would

² Petition under 37 CFR 1.183 at pages 1-2.

³ Petition under 37 CFR 1.183 at page 2.

⁴ *Id.* at pages 1-2.

⁵ *Id.* at page 2. See Reexamination Control No. 95/000,142 Decision dated April 17, 2007, wherein the Office granted a patent owner request for a waiver of 37 CFR 1.955 for a single interview. See also Reexamination Control No. 95/000,283 Decision dated September 17, 2008, wherein the Office granted a patent owner request for a waiver of 37 CFR 1.955 for a single interview.

⁶ *Id.*

⁷ 65 FR at 76768.

⁸ 65 FR at 76769.

interfere with the Office's ability to conduct an *inter partes* reexamination proceeding with special dispatch as mandated by 35 U.S.C. § 314.

In this instance, however, third party requester has stated on the record that it will not further participate in the '1,269 *inter partes* reexamination proceeding.⁹ Thus, only a single party (patent owner) will now participate in the '1,269 *inter partes* reexamination proceeding, and any interview that might be permitted in the proceeding.

In support of its request for waiver of 37 CFR 1.955 to conduct a single interview with the Office, patent owner makes the assertion that the Office has granted such a waiver request on the same facts of the present proceeding to that of *inter partes* reexamination control nos. 95/000,142 (the '142 proceeding)¹⁰ and 95/000,283 (the '283 proceeding), where 37 CFR 1.955 was waived and a single interview was granted.¹¹ Patent owner, cites only to the Office decisions in each proceeding and does not provide any of the facts and circumstances regarding each proceeding¹² incident with the granted decision, and makes no correlation of the facts between the present proceeding and either of the cited proceedings. The Office is not bound by prior decisions, as all matters are addressed and resolved on a case-by-case basis. Regarding the '142 proceeding, the proceeding has been vacated. Therefore, all Office issued papers in the proceeding are also vacated. Accordingly, the '142 proceeding's cited petition decision need not be further discussed. Regarding the '283 proceeding, an interview was granted in a merged *ex parte* and *inter partes* reexamination proceeding because the Office concluded that there was substantial evidence on the record that not only was there a notice of non-participation, but also that the now non-participating third party requester would not be prejudiced by the conduct of an *ex parte* interview on the merits by the patent owner.¹³

Patent owner has only established that the third party requester will not be participating. Patent owner has not established a lack of prejudice of the third party requester notwithstanding its lack of participation. However, petitioner has not attempted to show why an interview would advance the reexamination proceeding and not significantly delay it.

In view of the current lack of a showing of an extraordinary situation by patent owner in the present petition, in this instance, the '1,269 proceeding does NOT present an extraordinary situation which justifies waiver of 37 CFR 1.955 to further the interests justice. Thus, patent owner's petition under 37 CFR 1.183 is dismissed.

In order to complete its petition, patent owner may provide, via renewed petition, (1) A statement that to the best of patent owner's knowledge the third party requester would not be prejudiced

⁹ *Third Party Requester's Notice of Non-participation*, filed May 18, 2010 (stating "Microsoft Corporation ("the Requester"), hereby provides notice that it will not be filing Comments in response to the January 15, 2010 Office Action and the Patent Owner's April 15, 2010 Response. The Requester provides additional notice that it will not participate further in this *inter partes* reexamination.")

¹⁰ On September 11, 2009 the '142 proceeding was vacated and on November 19, 2009 the proceeding closed from public view.

¹¹ Petition under 37 CFR 1.183 at page 2.

¹² Patent owner cites to two papers in the '283 proceeding, however only the September 17, 2008 paper exists, the '283 proceeding does not have an October 6, 2008 paper.

¹³ *Inter partes* Reexamination Control. No. 95/000,283 petition decision dated September 17, 2008 at page 8.

notwithstanding its lack of participation; and (2) a summary of the current state of the proceeding, focusing upon the matters at issue in the proceeding for discussion in the interview, and showing that, given the nature of the matters at issue, an interview would advance the proceeding by enhancing the understanding of the relevant patentability issues and not significantly delay it. In the event patent owner files a renewed petition under 37 CFR 1.183 for waiver of 37 CFR 1.955 to complete the petition as to this particular interview request, no additional fee need be submitted; however, a separate petition paper and petition fee would need to be submitted for each interview request subsequent to the renewed request.

ADDITIONAL DISCUSSION

In the event that upon renewal patent owner's petition is granted, when the interview is requested, the patent owner must satisfy the following requirements prescribed for requesting and conducting an interview. See also MPEP 2281.

A. Preliminary Requirements

1. Promptly upon receipt of a decision granting waiver of 37 CFR 1.955, patent owner shall contact the examiner in charge of the proceeding to identify the issues that are sought to be discussed, to determine if an interview will be granted with respect to those issues (which the examiner is directed to consider based on criteria analogous to that of granting *ex parte* reexamination interviews), and to ascertain the examiner's desktop facsimile number.
2. At least three (3) working days prior to the interview, patent owner must file an informal written statement of the issues to be discussed at the interview, and an informal copy of any proposed claims to be discussed, unless examiner waives this requirement. The copy of these materials is to be submitted by facsimile transmission (FAX) directly to the examiner or hand-carried to the examiner so as to avoid the possibility of delay in matching the materials with the file. The informal copies that are considered by the examiner will be made of record in the reexamination proceeding as an attachment to the Interview Summary form PTOL-474 completed by the examiner after the interview.
3. Patent owner must serve a copy of the papers discussed in item (2) above upon the third party requester in accordance with 37 CFR 1.903, and include a copy of the certificate of service of such papers in the papers as filed in item (2) above.

B. Guidelines for Conducting the Interview

1. The interview must be conducted in the Office at such times, within Office hours as examiner may designate. The interviews will not be permitted at any other time or place, without the authority of the Director.
2. Patent owner must make every effort to conduct the interview in not more than one (1) hour. Patent owner may, however, show cause, at the interview, why more time is needed, and the examiner is free to extend the interview, at the examiner's sole discretion.

3. The interview should be attended by all conferees who signed any Office action that will be discussed, or their substitutes should attend if the conferees are not reasonably available.
4. At the conclusion of the interview, the examiner will prepare an interview summary, using form PTOL-474, the *Ex Parte* Interview Summary Form, and making appropriate modifications thereto. A copy of the interview summary should be given to patent owner at the conclusion of the interview. A copy of the interview summary form will also be mailed to third party requester, and the original will be made of record in the Image File Wrapper for the proceeding.

C. Prosecution after the Interview

1. Patent owner must file a complete written statement of the reasons presented at the interview as warranting favorable action, to avoid termination or limitation of the proceeding as appropriate under 37 CFR 1.957. The written statement must be filed either as a separate part of a response to an Office action outstanding at the time of the interview, or as a separate paper filed within one month from the date of the interview, whichever is later.
2. All papers filed by patent owner in the '1269 *inter partes* reexamination proceeding must continue to be served in accordance with 37 CFR 1.903, and service must be reflected by attaching a certificate of service, or consideration of the document may be refused.

CONCLUSION

1. Patent owner's May 24, 2010 petition is dismissed.
2. In order to complete its petition, patent owner may provide, via renewed petition, a request for a single interview that includes: (1) A lack of prejudice to the third party requester and (2) a summary of the current state of the proceeding, focusing upon the central matters at issue in the proceeding, and showing that, given the nature of the matters at issue, an interview would advance the proceeding and not significantly delay it.
3. Jurisdiction over the '1,269 *inter partes* reexamination proceeding is returned to the Central Reexamination Unit for action not inconsistent with this decision.
4. Any questions concerning this communication should be directed to Joseph F. Weiss, Jr., Legal Advisor, at (571) 272-7759.



Hiram H. Bernstein
Senior Legal Advisor
Office of Patent Legal Administration



UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
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Alexandria, VA 22313-1450

WILMERHALE/BOSTON
60 STATE STREET
BOSTON, MA 02109

(For Patent Owner)

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APR 06 2011

CENTRAL REEXAMINATION UNIT

OBLON, SPIVAK, McCELLAND,
MAIER & NEUSTATDT, LLP
1940 DUKE STREET
ALEXANDRIA, VA 22314

(For Third Party Requester)

Inter Partes Reexamination Proceeding
Control No. 95/001,272
Filed: December 1, 2009
For: U.S. Patent No. 7,321,221

: **DECISION**
: **DISMISSING**
: **PETITION**
:

This is a decision on the patent owner paper entitled "PETITION FOR INCREASE OF PAGE LIMIT FOR PATENT OWNER'S RESPONSE PURSUANT TO 37 C.F.R. 1.183 AND 1.943(b)," filed on March 14, 2011.

The patent owner petition is before the Office of Patent Legal Administration for consideration.

DECISION

Relevant Statutes, Regulations and Procedures

37 CFR 1.183 provides:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, sua sponte, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 CFR 1.943(b) provides:

Responses by the patent owner and written comments by the third party requester shall not exceed 50 pages in length, excluding amendments, appendices of claims, and reference materials such as prior art references.

Patent Owner's Petition under 37 CFR 1.183

In the instant petition under 37 CFR 1.183, patent owner requests waiver of 37 CFR 1.943(b), which limits patent owner responses to 50 pages in length. In particular, patent owner requests the page limit for patent owner's response to the January 20, 2011 non-final Office action be increased 75 pages in order to "address the Office Action rejecting all 19 claims raising numerous and complex issues" therein.¹

In support of its request for waiver of the rule, patent owner asserts that "the Request for *Inter Partes* Reexamination that serves, at least in large part, as a basis for the Office Action, spans 77 pages (not including, the expert declaration of 82 pages incorporated by reference in the Request or exhibits) and presents separate grounds of rejection for alleged obviousness that are said to find bases in six patents or publications."² Patent owner contends that "[p]rinciples of basic fairness and due process warrant that Patent Owner be given an equal number of pages to respond, i.e., a 190 page limit," allegedly the effective length of the Office action, but "is only requesting that the page limit be extended to 75 pages."³

Further in support of its request for waiver of the 50-page limit of 37 CFR 1.943(b), patent owner asserts that "[t]he increase in the page limit is further necessitated by the fact that the outstanding grounds of rejection are for alleged obviousness" and that "[g]iven the analytical standards set forth in *KSR International Co. v. Teleflex Inc.*, 127 S.Ct. 1727 (2007), Patent Owner needs adequate space to tell the complete story of the significant invention embodied in the patent claims subject of reexamination."⁴

Analysis and Findings

The instant petition under 37 CFR 1.183 has been fully considered. 37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party. The burden is on petitioner to set forth with specificity the facts that give rise to an extraordinary situation in which justice requires suspension of a rule. General requests, unsubstantiated by specific facts which justify an increase in the number of pages available for patent owner to respond to an Office action, are not sufficient to demonstrate an extraordinary situation in which justice requires suspension of 37 CFR 1.943(b).

As indicated above, patent owner seeks waiver of 37 CFR 1.943(b) to increase the page limit for patent owner's response to the outstanding Office action to 75 pages, which patent owner asserts

¹ Petition under 37 CFR 1.183 at 2.

² *Id.*

³ *Id.*

⁴ *Id.* at 3..

is less than the 190-page effective length of the Office action.⁵ First, it is to be noted, however, that the length of the Examiner's treatment of issues is not a *per se* indication of how many pages patent owner will need. In some instances, a long examiner discussion can be rebutted by simply showing a flaw in one or more points of the discussion, using a few sentences or paragraphs to do so. For example, while patent owner states "that 50 pages are insufficient for its response to an Office Action of such volume and depth," it is not clear exactly how many pages patent owner would need to develop a response to each of the rejections, or that 75 pages would be needed to sufficiently to develop a response to all of the rejections.⁶ Second, it is unclear how patent owner determined that 75 pages are needed for a complete response. Thus, in this instance, patent owner has provided arguments in support of why more pages are deemed necessary to complete the response, but patent owner has failed to provide a concrete basis for an accurate determination of how many additional pages are needed to complete the response.

A concrete showing which petitioner could have made in support of a request for waiver of the 50-page limit of 37 CFR 1.943(b) would be an attempt to draft a response in compliance with the 50-page limit followed by submission of the resulting drafted response that is in excess of 50 pages concurrently with a petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b). Such a submission can be evaluated for economizing, extraneous material, and arrangement, without repetition of information already of record. In this way, petitioner could have relied on the proposed response for justification that more pages (than are permitted by rule) are needed to complete the response and to set forth an accurate determination of exactly how many additional pages are needed to complete the response.

Patent owner may file a renewed petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b), accompanied by a response, as described immediately above. If the Office does not grant such a petition under 37 CFR 1.183 to the full extent of the suggested proposed response, patent owner would be given a period of 15 days within which to submit a replacement compliant response in accordance with the page limit set forth in the decision on that petition.

As to requester: If the Office does not grant such a petition under 37 CFR 1.183 to the full extent of the suggested proposed response, then the third party requester would then have 30 days from the date of service of any patent owner's rule-compliant response that is filed, to file a comments paper pursuant to 37 CFR 1.947.⁷ If the Office does grant such a petition under 37 CFR 1.183, the third party requester would have 30 days from the mailing date of a decision granting patent owner's petition under 37 CFR 1.183 and accepting the proposed response as page-length compliant, in which to file a comments paper pursuant to 37 CFR 1.947. *See* MPEP 2667(I)(A)(2).

⁵ On its face, the January 20, 2011 Office action is 31 pages long.

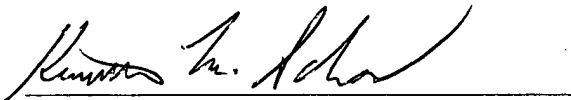
⁶ Petition under 37 CFR 1.183 at 2.

⁷ *See* MPEP 2667(I)(A)(2), which provides, in-part: "Where the length of the patent owner submission exceeds that permitted by 37 CFR 1.943, the submission is improper. Accordingly, pursuant to 37 CFR 1.957(d), a Notice will be mailed to the patent owner. The Notice will be issued by the examiner and will permit the patent owner to exercise one of the following two options: (A) Submit a re-drafted response that does not exceed the page limit set by 37 CFR 1.943; or (B) File a copy of the supplemental response with pages redacted to satisfy the 37 CFR 1.943 page limit requirement. ... If a response to the Notice is received, then under 37 CFR 1.947, the third party requester may once file written comments, limited to issues raised by the Office action or the patent owner's response to the Notice, within 30 days from the date of service of the patent owner's response to the Notice."

For the reasons set forth above, patent owner has not presented facts that demonstrate an extraordinary situation in which justice requires suspension of 37 CFR 1.943(b), and the March 14, 2011 petition under 37 CFR 1.183 is dismissed.

CONCLUSION

1. The patent owner March 14, 2011 petition under 37 CFR 1.183 is dismissed.
2. Any questions concerning this communication should be directed to Susy Tsang-Foster, Legal Advisor, at 571-272-7711.



Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,272	12/01/2009	7,321,221	1299600.00187US1	6771
23483	7590	12/12/2011	EXAMINER	
WILMERHALE/BOSTON 60 STATE STREET BOSTON, MA 02109			ART UNIT	PAPER NUMBER

DATE MAILED: 12/12/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Date: 12-12-11

ECKHARD H. KUESTERS

OBLON, SPIVAK, McCELLAND, MAIER & NEUSTATDT, LLP

1940 DUKE STREET

ALEXANDRIA, VA 22314

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001272

PATENT NO. : 7321221

TECHNOLOGY CENTER : 3999

ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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Monica Grewal **CENTRAL REEXAMINATION UNIT** (For Patent Owner)
WILMER CUTLER PICKERING :
HALE and DORR LLP :
60 State Street :
Boston, MA. 02109 :

Eckhart H. Kuesters :
OBLON, SPIVAK, McCLELLAND :
MAIER & NEUSTADT : (For Third Party
1940 Duke Street : Requester)
Alexandria, VA. 22314 :

:

In re: Bucker et al. :
Inter Partes Reexamination Proceeding : DECISION ON PETITION
Control No.: 95/001,272 :
For: U.S. Patent No.: 7,321,221 :

This is a decision on a petition filed by the patent owner: a petition filed on November 15, 2011, entitled "PETITION PURSUANT TO 37 C.F.R. § 1.181 TO REFUSE CONSIDERATION AND/OR STRIKE REQUESTOR'S COMMENTS AFTER ACTION CLOSING PROSECUTION".

The petition is before the Director of the Central Reexamination Unit. The petition is **granted**.

REVIEW OF RELEVANT FACTS

- U.S. Patent No. 7,321,221 issued on January 22, 2008.
- A request for *inter partes* reexamination was December 1, 2009 and assigned control no. 95/001,272.
- *Inter partes* reexamination was ordered on February 26, 2010.

- The reexaminations proceedings progressed and an Action Closing Prosecution (ACP) was mailed on July 22, 2011.
- Patent Owner's Response to an ACP was received by the Office and serviced to the Third Party Requestor on September 22, 2011.
- The Third Party Requestor's Comments responsive to the Patent Owners comments after an ACP were received and serviced to the Patent Owner on October 24, 2011.
- Patent Owner filed a Petition "petition" on November 15, 2011.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

37 C.F.R. § 1.181 Petition to the Director

(f) The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings. Any petition under this part not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided. This two-month period is not extendable.

DECISION

Patent owner ["petitioner"] argues in the petition that the comments filed by the third party requester on October 24, 2011 are improper and should be stricken from record as being served on the Patent Owner after the expiration of the inextensible 30-day period for filing such comments and therefore should be refused consideration and/or stricken from the record.

Petition

As a procedural matter, the petition is treated as a petition under 37 CFR § 1.181.

A paper such as a third party comments submission is entered into the record when it is filed. After the scanning period, the paper is available for viewing on public PAIR as a part of the reexamination record. As noted in the petition the Office issued an Action Closing Prosecution,

dated July 22, 2011, setting a 2-month deadline for the Patent Owner to respond. The Patent Owner on September 22, 2011 timely filed and served on the Requester a response to the Action Closing Prosecution. Pursuant to 37 C.F.R. § 1.947, which clearly states:

“Each time the patent owner files a response to an Office action on the merits pursuant to § 1.945, a third party requester may once file written comments within a period of 30 days from the date of service of the patent owner’s response. These comments shall be limited to issues raised by the Office action or the patent owner’s response. The time for submitting comments by the third party requester may not be extended. For the purpose of filing the written comments by the third party requester, the comments will be considered as having been received in the Office as of the date of deposit specified in the certificate under § 1.8.”

Thus, the 30-day deadline for filing the Requestor’s Comments was October 22, 2011, which was a Saturday, thus the Requestor’s Comments were due on Monday, October 24, 2011. The Requestor’s Comments were served on the Patent Owner via First Class U.S. Mail (See Exhibit 2 of Petition – Certificate of Service). However, the envelope containing the service copy of the Requestor’s Comments, received by the Patent Owner, bore a postmark of October 25, 2011 (See Exhibit 3 of Petition), one day after the inextensible 30-day period. Pursuant to 37 C.F.R. § 1.248(a)(4), which clearly states:

“Transmission by first class mail. When service is by mail the date of mailing will be regarded as the date of service.”

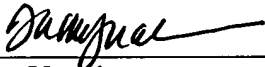
Therefore, the date of service of the Third Party Requestor’s comments is determined to be October 25, 2011, one day after the inextensible 30-day period. Pursuant to 37 C.F.R. § 1.903, which clearly states:

“The patent owner and the third party requester will be sent copies of Office actions issued during the inter partes reexamination proceeding. After filing of a request for inter partes reexamination by a third party requester, any document filed by either the patent owner or the third party requester must be served on every other party in the reexamination proceeding in the manner provided in § 1.248. Any document must reflect service or the document may be refused consideration by the Office. The failure of the patent owner or the third party requester to serve documents may result in their being refused consideration.”

Therefore, the Petition has been granted and the Third Party Requestor’s comments to the Action Closing Prosecution (ACP) will not be considered by the Office.

CONCLUSION

1. The petitions filed November 15, 2011, is **granted**.
2. The most-recent Office action, as listed in the statement of facts herein, remains outstanding and patent owner's response is due as set forth in that action.
3. Telephone inquiries related to this decision should be directed to Sudhanshu C. Pathak, Supervisory Patent Reexamination Examiner, at (571) 272-5509 or in his absence to the undersigned at (571) 272-0700.



Irem Yucel
Director, Central Reexamination Unit



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,272	12/01/2009	7,321,221	341716US20RX	6771
8791 7590 02/26/2010 BLAKELY SOKOLOFF TAYLOR & ZAFMAN LLP 1279 OAKMEAD PARKWAY SUNNYVALE, CA 94085-4040			EXAMINER DEB. ANJAN K	
			ART UNIT 3992	PAPER NUMBER
			MAIL DATE 2-29-12	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Date: 2-29-12

ECKHARD H. KUESTERS

OBLON, SPIVAK, McCELLAND, MAIER & NEUSTATDT, LLP

1940 DUKE STREET

ALEXANDRIA, VA 22314

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001272

PATENT NO. : 7321221

TECHNOLOGY CENTER : 3999

ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,272	12/01/2009	7,321,221	1299600.00187US1	6771
23483	7590	02/29/2012	EXAMINER	
WILMERHALE/BOSTON 60 STATE STREET BOSTON, MA 02109			ART UNIT	PAPER NUMBER

DATE MAILED: 02/29/2012

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CENTRAL REEXAMINATION UNIT

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SUNNYVALE, CA 94085-4040

(For Patent Owner)

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MAIER & NEUSTADT
1940 DUKE STREET
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60 STATE STREET
BOSTON, MA 02109

(Courtesy Copy)

Inter Partes Reexamination Proceeding
Control No. 95/001,272
Filed: December 1, 2009
For: U.S. Patent No. 7,321,221 B2

: **DECISION**
: **GRANTING**
: **PETITION**
:

This is a decision on the third party requester's petition paper entitled "REQUESTER'S PETITION UNDER 37 C.F.R. § 1.182 TO ACCEPT TIMELY FILED THIRD PARTY COMMENTS," filed on December 19, 2011. The petition is treated as a petition under 37 CFR 1.181(a) requesting reconsideration of the December 12, 2011 Office decision granting patent owner's November 15, 2011 petition to strike the third party requester's October 24, 2011 comments after action closing prosecution. This decision also treats the patent owner's opposition paper entitled "OPPOSITION TO REQUESTER'S PETITION TO ACCEPT TIMELY FILED THIRD PARTY COMMENTS," filed on January 3, 2012.

The third party requester petition for reconsideration and the patent owner opposition are before the Office of Patent Legal Administration for consideration.

For the reasons set forth below, the third party requester petition for reconsideration is **granted**.

The December 12, 2011 Office decision is withdrawn, and the third party requester's October 24, 2011 are entered into the record of the present proceeding.

DECISION

37 CFR 1.248 provides (emphasis added):

- (a) Service of papers must be on the attorney or agent of the party if there be such or on the party if there is no attorney or agent, and may be made in any of the following ways:
 - (1) By delivering a copy of the paper to the person served;
 - (2) By leaving a copy at the usual place of business of the person served with someone in his employment;
 - (3) When the person served has no usual place of business, by leaving a copy at the person's residence, with some person of suitable age and discretion who resides there;
 - (4) Transmission by first class mail. When service is by mail the **date of mailing will be regarded as the date of service**;
 - (5) Whenever it shall be satisfactorily shown to the Director that none of the above modes of obtaining or serving the paper is practicable, service may be by notice published in the *Official Gazette*.
- (b) Papers filed in the Patent and Trademark Office which are required to be served shall contain proof of service. Proof of service may appear on or be affixed to papers filed. Proof of service shall include the date and manner of service. In the case of personal service, proof of service shall also include the name of any person served, certified by the person who made service. Proof of service may be made by:
 - (1) An acknowledgement of service by or on behalf of the person served or
 - (2) A statement signed by the attorney or agent containing the information required by this section.
- (c) See § 41.106(e) of this title for service of papers in contested cases before the Board of Patent Appeals and Interferences.

Upon further consideration, the third party requester's October 24, 2011 comments were timely filed and properly served on the patent owner. The relevant rule, 37 CFR 1.248, states that when service is by mail, the date of mailing will be regarded as the date of service. The rule does not require the physical copy of the comments served on the patent owner be postmarked on October 24, 2011. The third party requester's certificate of service filed on October 24, 2011 states that a copy of its comments *was served* on patent owner via first class U.S. Mail. [Emphasis added.] The date on which a copy is deposited with the USPS is the date of mailing which, by rule, is regarded as the date of service. There is no basis in the record to challenge the veracity of the statement in the certificate of service. Accordingly, the date of service was October 24, 2011, and the comments were timely filed and served on the patent owner.

The third party requester's petition for reconsideration is granted to the extent that the December 12, 2011 decision is hereby withdrawn. The third party requester's October 24, 2011 comments are entered into the record of the present proceeding.

PATENT OWNER'S CORRESPONDENCE ADDRESS**37 CFR 1.33(c) provides (emphasis added):**

All notices, official letters, and other communications for the patent owner or **owners in a reexamination proceeding will be directed to the correspondence address.** Amendments and other papers filed in a reexamination proceeding on behalf of the patent owner must be signed by the patent owner, or if there is more than one owner by all the owners, or by an attorney or agent of record in the patent file, or by a registered attorney or agent not of record who acts in a representative capacity under the provisions of § 1.34. **Double correspondence with the patent owner or owners and the patent owner's attorney or agent, or with more than one attorney or agent, will not be undertaken.**

The correspondence address for the patent to be reexamined, or being reexamined is the correct address for all notices, official letters, and other communications for patent owners in reexamination proceedings.¹

In the instant case, the patent owner is called upon to clarify and coordinate the proper correspondence addresses in (1) the 7,321,221 B2 patent and (2) the 95/001,272 reexamination proceeding. Different patent owner addresses are of record for the patent and the reexamination proceeding. Although the patent owner filed a revocation of power of attorney with a new power of attorney and change of correspondence address in the 95/001,272 proceeding on February 9, 2011, neither is effective to change the correspondence address in the reexamination proceeding because no such transaction occurred in the 7,321,221 B2 patent.

Hence, the current **correspondence address of record for the patent file is the proper patent owner address for reexamination mailings pursuant to 37 CFR 1.33(c)** (*i.e.*, BLAKELY SOKOLOFF TAYLOR & ZAFMAN, LLP, 1279 OAKMEAD PARKWAY, SUNNYVALE, CA 94085-4040). Absent the filing of a proper change of correspondence address in the patent file, all **future correspondence in the 95/001,272 proceeding will be mailed to the current address of record for the patent owner** (*i.e.*, BLAKELY SOKOLOFF TAYLOR & ZAFMAN, LLP, 1279 OAKMEAD PARKWAY, SUNNYVALE, CA 94085-4040).

Note that the patent owner is not required to designate the same representative for the patent file and for the reexamination proceeding. In the reexamination proceeding, patent owner may appoint a practitioner of record under § 1.32, or authorize another practitioner to file a response under § 1.34, but the address for reception of correspondence from the Office must be the same as that in the patent file pursuant to § 1.33.

To remedy this situation, patent owner has the option of filing form PTO/SB/123 (for change of correspondence address only) or form PTO/SB/81A (for power of attorney and change of correspondence address) in the patent file to establish the appropriate correspondence address. Further, patent owner may re-file form PTO/SB/81B in the 95/001,272 proceeding, correctly identifying a statement under 37 CFR 3.73(b), in addition to taking appropriate action in the

¹ See MPEP 2622

patent file, as described above, to conform the correspondence address in the reexamination proceeding to that established in the patent.

CONCLUSION

1. The third party requester's petition for reconsideration is granted. The third party requester's October 24, 2011 comments are entered into the record of the present proceeding.
2. Parties are put on NOTICE that the correspondence address for the present reexamination proceeding is BLAKELY SOKOLOFF TAYLOR & ZAFMAN, LLP, 1279 OAKMEAD PARKWAY, SUNNYVALE, CA 94085-4040, pursuant to CFR 1.33(c). Patent owner should not expect any further courtesy copies.
3. Any inquiry concerning this communication should be directed to Susy Tsang-Foster, Legal Advisor, at (571) 272-7711 or, in her absence, to Pinchus M. Laufer, Senior Legal Advisor at (571) 272-7726.



Irem Yucel
Director, Central Reexamination Unit

2/24/2012



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,273	12/01/2009	6640086	143720069	6901
88488	7590	04/14/2011	EXAMINER	
Intellectual Property Law Office of David Lathrop No. 827 39120 Argonaut Way Fremont, CA 94538			ART UNIT	PAPER NUMBER

DATE MAILED: 04/14/2011

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PATENT -SEA

P.O. BOX 1247

SEATTLE, WA 98111-1247

Date:

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CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001273

PATENT NO. : 6640086

TECHNOLOGY CENTER : 3999

ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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Intellectual Property Law Office of David Lathrop
No. 827
39120 Argonaut Way
Fremont CA 94538

(For Patent Owner)

MAILED

APR 14 2011

CENTRAL REEXAMINATION UNIT

(For Requester)

PERKINS COIE LLP
PATENT-SEA
P.O. BOX 1247
SEATTLE, WA 98111-1247

In re: Wall
Reexamination Proceeding
Control No. 95/001,273
Request Deposited: December 1, 2009
For: U.S. Patent No. 6,640,086

:
: **DECISION**
: **DISMISSING**
: **PETITION**
:

The *inter partes* reexamination is before the Central Reexamination Unit to address the third party requester (3PR) paper of November 29, 2010 entitled "PETITION UNDER 37 C.F.R. §1.181 AND/OR §1.182 TO REOPEN PROSECUTION AND TO HAVE NEW OFFICE ACTION".

Petitioner requests relief under 37 CFR 1.181 and/or 37 CFR 1.182 and also requests alternative relief under 37 CFR 1.183.

37 CFR 1.4 states:

Since different matters may be considered by different branches or sections of the United States Patent and Trademark Office, each distinct subject, inquiry or order must be contained in a separate paper to avoid confusion and delay in answering papers dealing with different subjects.

Art Unit: 3992

In view of the fact that the petition improperly combines multiple, distinct matters considered by different branches of the USPTO in a single paper, the petition is **dismissed** under 37 CFR 1.4(c).

As to the merits of the request drawn to consideration of 3PR references and proposed rejections submitted on April 20, 2010, the petition is **dismissed as moot**. Petitioner requests that the examiner consider the art cited by 3PR on April 20, 2010 and also consider proposed rejections to patent owner's claims that were amended on March 22, 2010.

It is noted that the examiner considered the references with the Action Closing Prosecution mailed October 5, 2010.

It is also noted that the patent owner amendment of October 29, 2010 presents new independent claims 83, 86, 89, and 92, then cancels many claims and changes the dependency of others to be dependent on the new, independent claims. The examiner entered the amendment in the Right of Appeal Notice of April 11, 2011. The only original claims remaining are not subject to reexamination and the only claims subject to reexamination are newly presented independent claims 83, 86, 89, and 92 and claims dependent therefrom.

Since the rejections that petitioner now wants considered were never proposed to the claims currently of record, the consideration of those rejections is moot.

CONCLUSION

1. The Third Party Requester petition is **dismissed**.
2. Inquiries regarding this decision may be directed to Eric Keasel, Supervisory Patent Examiner, at (571) 272-4929.
3. This decision is not a final agency decision and is without prejudice to request reconsideration or higher-level review.



Eric Keasel
SPE, Central Reexamination Unit



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,274	12/01/2009	6928433	016788-000-0004	6990
37509	7590	09/29/2010	EXAMINER	
DECHERT LLP P.O. BOX 390460 MOUNTAIN VIEW, CA 94039-0460			ART UNIT	PAPER NUMBER

DATE MAILED: 09/29/2010

Please find below and/or attached an Office communication concerning this application or proceeding.



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
PILLSBURY WINTHROP SHAW PITTMAN LLP
P.O. BOX 10500
MCLEAN, VA 22102

Date:

MAILED

SEP 29 2010

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001274
PATENT NO. : 6928433
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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DECHERT LLP
P.O. BOX 390460
MOUNTAIN VIEW, CA 94039-0460

(For Patent Owner)

PILLSBURY WINTHROP SHAW PITTMAN LLP
P.O. BOX 10500
MCLEAN, VA 22102

(For Third Party Requester) **MAILED**

SEP 29 2010

CENTRAL REEXAMINATION UNIT

Inter Partes Reexamination Proceeding
Control No.: 95/001,274
Filed: December 1, 2009
For: U.S. Patent No. 6,928,433

**DECISION GRANTING
PETITION FOR WAIVER
OF 37 CFR 1.955 FOR
ONE-TIME INTERVIEW**

This is a decision on patent owner's "PETITION UNDER 37 C.F.R. § 1.183 FOR A ONE-TIME WAIVER OF 37 C.F.R. § 1.955," filed on July 8, 2010.

The patent owner petition is before the Office of Patent Legal Administration.

The petition fee of \$400 pursuant to 37 CFR 1.17(f) for the petition under 37 CFR 1.183 was charged to patent owner's deposit account on July 9, 2010, as authorized on page 3 of the petition.

The petition is granted to the extent set forth herein.

BACKGROUND

1. U.S. Patent No. 6,928,433 ("the '433 patent") issued to Goodman *et al.* on August 9, 2005.
2. A request for *inter partes* reexamination was filed by a third party requester on December 1, 2009, which request was assigned control no. 95/001,274 ("the '1274 proceeding").
3. Reexamination was ordered in the '1274 proceeding on February 26, 2010.
4. On March 29, 2010, the Office mailed an Office action on the merits in the '1274 proceeding.
5. On June 1, 2010, patent owner filed an "AMENDMENT AND RESPONSE UNDER 37 C.F.R. §§ 1.941, 1.943 and 1.945," responsive to the March 29, 2010 Office action ("the June 1, 2010 response submission").
4. On July 1, 2010, third party requester filed a paper entitled "NOTICE OF WITHDRAWAL OF THIRD PARTY REQUESTER" in the '1274 proceeding.

7. On July 8, 2010, patent owner filed the instant petition paper entitled "PETITION UNDER 37 C.F.R. § 1.183 FOR A ONE-TIME WAIVER OF 37 C.F.R. § 1.955."

DECISION

Relevant Statutes, Regulations and Practice

35 U.S.C. § 314 provides, in part:

(a) IN GENERAL.— Except as otherwise provided in this section, reexamination shall be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133. In any *inter partes* reexamination proceeding under this chapter, the patent owner shall be permitted to propose any amendment to the patent and a new claim or claims, except that no proposed amended or new claim enlarging the scope of the claims of the patent shall be permitted.

(c) SPECIAL DISPATCH.— Unless otherwise provided by the Director for good cause, all *inter partes* reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, shall be conducted with special dispatch within the Office.

37 CFR 1.955 provides:

There will be no interviews in an *inter partes* reexamination proceeding which discuss the merits of the proceeding.

Patent Owner's Petition under 37 CFR 1.183

The instant petition under 37 CFR 1.183 has been fully considered. In the instant petition, petitioner patent owner requests waiver of 37 CFR 1.955, which prohibits interviews in *inter partes* reexamination. In particular, petitioner requests that waiver be granted to allow the patent owner to conduct a single interview in the '1274 proceeding.¹

37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party. The burden is on petitioner to set forth with specificity the facts that give rise to an extraordinary situation in which justice requires suspension of a rule. In support of its request for waiver of 37 CFR 1.955, petitioner asserts that third party requester has withdrawn from, and will not further participate in, the '1274 proceeding in any way.² Patent owner also asserts that third party requester has received a license to the '433 patent and, therefore, "it is evident that the third party requester would not be prejudiced in any way if this petition is

¹ See July 8, 2010 petition under 37 CFR 1.183 at page 1.

² See *id.* at page 2.

granted.”³ Patent owner further asserts that the interview would more expeditiously resolve the ‘1274 proceeding by providing an opportunity to discuss patent owner’s June 2, 2010 response to the March 29, 2010 Office action and, in particular, two declarations under 37 CFR 1.131 that were submitted by patent owner with its June 1, 2010 response submission.⁴

A review of the *Notice of Final Rule Making, Rules to Implement Optional Inter Partes Reexamination Proceedings*, 65 FR 76755 (Dec. 7, 2000), 1242 *Off. Gaz. Pat. Office* 12 (Jan. 2, 2001) (final rule) reveals that the Notice of Proposed Rule Making had proposed implementation of a regulation that would have permitted interviews in *inter partes* reexamination proceedings. In the final rule, however, the Office decided to preclude both *ex parte* and *inter partes* interviews in an *inter partes* reexamination proceeding, and accordingly published 37 CFR 1.955 in its present form. The Office concluded that, for a variety of reasons, “[n]o matter what the structure of the interview, the presence of a third party requester (or a separate interview with the requester) will complicate the reexamination proceeding and significantly delay it.” Thus, the key basis for the present 37 CFR 1.955 proscription of all and any interviews in an *inter partes* reexamination proceeding was that the presence of two (or more) parties in the proceeding would interfere with the Office’s ability to conduct an *inter partes* reexamination proceeding with special dispatch as mandated by 35 U.S.C. § 314.

In this instance, however, third party requester has stated on the record that it will not further participate in the ‘1274 *inter partes* reexamination proceeding.⁵ Thus, only a single party (patent owner) will now participate in the ‘1274 proceeding, and any interview that might be permitted in the proceeding. Accordingly, petitioner asserts in the instant petition that “permitting an interview to be conducted in this reexamination proceeding will not hinder the ability of the Office to conduct the proceeding with special dispatch, but rather may well assist the Office in expeditiously resolving the outstanding issues in this proceeding.”⁶ In addition, patent owner has focused upon matters at issue in the proceeding to be discussed at the interview, in particular, two declarations under 37 CFR 1.131 that were submitted by patent owner with its June 1, 2010 response submission.

Based on the present facts and circumstances, it is found that permitting a single interview to be conducted at this point in the ‘1274 *inter partes* proceeding is not anticipated to potentially hinder the ability of the Office to conduct the ‘1274 proceeding with special dispatch, but rather may well assist the Office in expeditiously resolving the proceeding.⁷ Accordingly, in view of the particular facts and circumstances set forth herein, in this instance and at this point, the record in the ‘1274 proceeding is deemed to present an extraordinary situation which justifies

³ See *id.*

⁴ See *id.* (stating that patent owner believes the two declarations under 37 CFR 1.131 “are sufficient to remove most of the prior art references forming bases for rejections of the claims at issue.”)

⁵ See July 1, 2010 “NOTICE OF WITHDRAWAL OF THIRD PARTY REQUESTER” (stating that third party requester “hereby withdraws from the above-identified *inter partes* reexamination proceeding,” “will no longer participate in this reexamination proceeding in any way,” “specifically waives its right to participate in any interview with the examiner in the above-identified proceeding,” and “supports any petition later filed by the Patent Owner to waive the general prohibition under 37 C.F.R. § 1.955 of interviews discussing the merits of the above-identified reexamination proceeding.”)

⁶ July 8, 2010 petition under 37 CFR 1.183 at page 2.

⁷ The ‘1274 proceeding is ready for examiner action following patent owner’s June 1, 2010 response submission after the March 29, 2010 Office action.

waiver of 37 CFR 1.955 to further the interests of the patent owner, members of the public who may be interested in the outcome of the proceeding, and the Office. Thus, patent owner's petition under 37 CFR 1.183 is granted to the extent that 37 CFR 1.955 is waived such that a single interview will be permitted, subject to the examiner's approval. It is noted, however, that there are no established regulatory or practice guidelines to govern the manner in which an interview in an *inter partes* reexamination proceeding is to be conducted. Therefore, the waiver of 37 CFR 1.955 so as to permit an interview is granted only to the extent that patent owner satisfies the following preliminary requirements.

Requirements and Guidelines for Conducting Interview

A. Preliminary Requirements

1. Promptly, upon receipt of the present decision, patent owner must contact the examiner in charge of the proceeding to identify the issues that are sought to be discussed, to determine if an interview will be granted with respect to those issues (which the examiner is directed to consider based on criteria analogous to that of granting *ex parte* reexamination interviews), and to ascertain the examiner's desktop facsimile number.
2. At least three (3) working days prior to the interview, patent owner must file an informal written statement of the issues to be discussed at the interview, and an informal copy of any proposed claims to be discussed, unless examiner waives this requirement. The copy of these materials is to be submitted by facsimile transmission (FAX) directly to the examiner or hand-carried to the examiner so as to avoid the possibility of delay in matching the materials with the file. The informal copies that are considered by the examiner will be made of record in the reexamination proceeding – as an attachment to the Interview Summary form PTOL-474 (modified as needed for *inter partes* reexamination) completed by the examiner after the interview.
3. Patent owner must serve a copy of the papers discussed in item (2) above on the third party requester in accordance with 37 CFR 1.903, and include a copy of the certificate of service of such papers in the papers as filed in item (2) above.

B. Guidelines for Conducting the Interview

1. The interview must be conducted in the Office at such times, within Office hours as examiner may designate. The interview will not be permitted at any other time or place, without the authority of the Director.
2. Patent owner must make every effort to conduct the interview in not more than one (1) hour. Patent owner may, however, show cause, at the interview, why more time is needed, and the examiner is also free to extend the interview, at the examiner's sole discretion.
3. The interview should be attended by the conferees who signed the March 29, 2010 Office action, or their substitutes (if the conferees are not reasonably available).

4. At the conclusion of the interview, the examiner will prepare an interview summary, using form PTOL-474, the *Ex Parte* Interview Summary Form, and making appropriate modifications thereto, taking into account that the present proceeding is an *inter partes* reexamination proceeding. A copy of the interview summary form is to be given to patent owner at the conclusion of the interview. A copy of the interview summary form will also be mailed to third party requester, and the original of the form is to be made of record in the Image File Wrapper for the proceeding.

C. Prosecution after the Interview

1. Patent owner must file a complete written statement of the reasons presented at the interview as warranting favorable action, to avoid termination or limitation of the proceeding as appropriate under 37 CFR 1.957. The written statement must be filed as a separate paper filed within one month from the date of the interview.
2. All papers filed by patent owner in the '1274 *inter partes* reexamination proceeding must continue to be served in accordance with 37 CFR 1.903, and service must be reflected by attaching a certificate of service, or consideration of the document may be refused.

CONCLUSION

1. Patent owner's July 8, 2010 petition under 37 CFR 1.183 is granted to waive the provisions of 37 CFR 1.955, to the extent that a single interview will be permitted, upon approval by the examiner and compliance with the Preliminary Requirements, as set forth above.
2. The provisions of 37 CFR 1.955 are waived solely on the present facts and circumstances, and solely for the purposes of conducting one interview with respect to the March 29, 2010 Office action and the June 1, 2010 patent owner response submission.
3. Any future petition for waiver of 37 CFR 1.955 will not be granted absent a further strong showing of necessity, including an explanation of why the basis for any further interview could not have been addressed in the first interview.
4. Any questions concerning this communication should be directed to Nicole Dretar, Legal Advisor, Office of Patent Legal Administration, at (571) 272-7717.



Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,276	01/05/2010	6718415	31509.14	8456
58249	7590	04/18/2011	EXAMINER	
COOLEY LLP ATTN: Patent Group Suite 1100 777 - 6th Street, NW WASHINGTON, DC 20001			ART UNIT	PAPER NUMBER

DATE MAILED: 04/18/2011

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

DAVID L. McCOMBS

HAYNES AND BOONE, LLP

2323 VICTORY AVENUE

SUITE 700

DALLAS, TX 75219-767

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NUMBER 95/001,276.

PATENT NUMBER 6,718,415.

TECHNOLOGY CENTER CRU.

ART UNIT 3992.

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above-identified reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the *inter partes* reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an *ex parte* reexamination has been merged with the *inter partes* reexamination, no responsive submission by any *ex parte* third party requester is permitted.



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APR 18 2011

(For Patent Owner)

COOLEY LLP
ATTN: Patent Group
Suite 1100
777 - 6th Street, NW
WASHINGTON DC 20001

CENTRAL REEXAMINATION UNIT

(For Requester)

HAYNES AND BOONE, LLP
IP SECTION
2323 VICTORY AVENUE
SUITE 700
DALLAS, TX 75219

In re: Chu
Reexamination Proceeding
Control No. 95/001,276
Corrected Request Deposited: January 5, 2010
For: U.S. Patent No. 6,718,415

:
: **DECISION**
: **DISMISSING**
: **PETITIONS**
:

The *inter partes* reexamination is before the Central Reexamination Unit to address the October 6, 2010 patent owner paper entitled "PETITION UNDER 37 C.F.R. § 1.181 REQUESTING RETURN OF THIRD PARTY COMMENTS FILED AUGUST 23, 2010" and the October 14, 2010 third party requester paper entitled "PETITION UNDER 37 C.F.R. § 1.181 REQUESTING DENIAL OF THE PETITION FILED OCTOBER 6, 2010".

As the office has not yet issued an office action addressing the comments of August 23, 2010, both requests are **dismissed as premature**.

Inquiries regarding this decision may be directed to Eric Keasel, Supervisory Patent Examiner, at (571) 272-4929.

This decision is not a final agency decision and is without prejudice to request reconsideration or higher-level review.

Eric Keasel
SPE, Central Reexamination Unit, Art Unit 3992



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,276	01/05/2010	6718415	ACQI-010/11US 310578-2056	8456
58249	7590	07/15/2011	EXAMINER	
COOLEY LLP ATTN: Patent Group Suite 1100 777 - 6th Street, NW WASHINGTON, DC 20001			ART UNIT	PAPER NUMBER

DATE MAILED: 07/15/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Date: 7-15-11

David L. McCombs

HAYNES & BOONE, LLP, IP SECTION

2323 Victory Avenue, Suite 700

Dallas, TX 75219

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001276

PATENT NO. : 6718415

TECHNOLOGY CENTER : 3999

ART UNIT : 3993

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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CENTRAL REEXAMINATION UNIT

COOLEY LLP
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(For Patent Owner)

HAYNES AND BOONE, LLP
IP SECTION
2323 VICTORY AVENUE
SUITE 700
DALLAS, TX 75219

(For Third Party Requester)

Inter Partes Reexamination Proceeding
Control No. 95/001,276
Filed: January 5, 2010
For: U.S. Patent No. 6,718,415

:
: **DECISION**
: **DISMISSING**
: **PETITION**
:

This is a decision on the third party requester's petition under 37 CFR 1.183 requesting waiver of the page limit requirement of 37 CFR 1.943(b), filed on May 12, 2011. Third party requester timely filed comments under 37 CFR 1.947 concurrently with the petition.

The petition under 37 CFR 1.183 is before the Office of Patent Legal Administration.

For the reasons set forth below, third party requester's petition under 37 CFR 1.183 is **dismissed**.

DECISION

37 CFR 1.183 provides:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

In the present petition under 37 CFR 1.183, third party requester requests waiver of the requirement under 37 CFR 1.943(b) with respect to the 50-page limit for third party requester's

comments filed concurrently with the present petition and directed to the April 12, 2011 supplemental patent owner response.

On April 26, 2011, third party requester filed a paper entitled "Third-party Requester's Petition Requesting Denial of Entry of the Patent Owner's Supplemental Response, Filed April 12, 2011, to Office Action Mailed on August 4, 2010," which will be taken as a petition under 37 CFR 1.181 (the § 1.181 petition) challenging the entry of patent owner's April 12, 2011 supplemental response.

Since the requester's April 26, 2011 § 1.181 petition has not yet been decided, the instant requester petition under 37 CFR 1.183 is premature - if the requester's § 1.181 petition should be granted, then the present requester petition requesting waiver of the requirement of 37 CFR 1.943(b) would be moot.¹ Third party requester retains the option of seasonably filing a renewed petition under 37 CFR 1.183 requesting waiver of the requirement of 37 CFR 1.943(b) for its comments to the patent owner supplemental response should the decision on the § 1.181 petition be not to grant the petition. Until such time, the issue is not ripe for consideration by the Office under 37 CFR 1.183. When no further challenge under 37 CFR 1.181 is filed by the requester as to denial of the entry of the April 12, 2011 supplemental patent owner response, requester may renew the present petition under 37 CFR 1.183.

In view of the above, the petition under 37 CFR 1.183 is dismissed as premature.

CONCLUSION

1. The third party requester petition under 37 CFR 1.183 filed on May 12, 2011 is dismissed as being premature.
2. Telephone inquiries related to this decision should be directed to Susy Tsang-Foster, Legal Advisor, at (571) 272-7711.

/Kenneth M. Schor/

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

07-13-2011
Kenpet8/

¹ That is, if relief is granted under 37 CFR 1.181 to deny of entry of the patent owner supplemental response, then both the patent owner supplemental response and the comments in response thereto would be expunged from the record as improper papers.



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95/001,276	01/05/2010	6718415	ACQI-010/11US 310578-2056	8456
58249	7590	07/15/2011	EXAMINER	
COOLEY LLP ATTN: Patent Group Suite 1100 777 - 6th Street, NW WASHINGTON, DC 20001			ART UNIT	PAPER NUMBER

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Date: 7-15-11

David L. McCombs
HAYNES & BOONE, LLP, IP SECTION
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**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

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ART UNIT : 3993

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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CENTRAL REEXAMINATION UNIT

COOLEY LLP
ATTN: Patent Group
Suite 1100
777 – 6th Street, NW
WASHINGTON, D.C. 20001

(For Patent Owner)

HAYNES AND BOONE, LLP
IP SECTION
2323 VICTORY AVENUE
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DALLAS, TX 75219

(For Third Party Requester)

Inter Partes Reexamination Proceeding
Control No. 95/001,276
Filed: January 5, 2010
For: U.S. Patent No. 6,718,415

: **DECISION**
: **GRANTING-IN-PART**
: **PETITION AND**
: **EXPUNGING**
: **IMPROPER PAPER**

This is a decision on the third party requester's petition under 37 CFR 1.183 requesting waiver of the page limit requirement of 37 CFR 1.943(b), filed on August 23, 2010. Third party requester timely filed comments under 37 CFR 1.947 concurrently with the petition.

The petition under 37 CFR 1.183 is before the Office of Patent Legal Administration.

Third party requester's August 23, 2010 petition under 37 CFR 1.183 to waive the 37 CFR 1.943(b) limit as to the number of pages permitted in comments by third party requester in response to the July 23, 2010 patent owner response is granted to the extent that the page limit for comments by third party requester to the July 23, 2010 patent owner response is extended to not exceed 100 pages in length.

For the reasons set forth below, third party requester's comments submission filed on August 23, 2010 is an improper paper and is being expunged from the record without consideration.

DECISION

I. Relevant Regulations and Procedure

37 CFR 1.183 provides:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 CFR 1.943(b) provides:

Responses by the patent owner and written comments by the third party requester shall not exceed 50 pages in length, excluding amendments, appendices of claims, and reference materials such as prior art references.

MPEP § 2667(I), (TYPES OF PAPERS RETURNED WITH CENTRAL REEXAMINATION UNIT DIRECTOR OR REEXAMINATION LEGAL ADVISOR APPROVAL REQUIRED), provides in pertinent part:

Any affidavit or declaration (or a clearly defined portion thereof) that contains opinion(s) of the affiant/declarant, or argument(s) that the art either does or does not anticipate or render obvious the claims, or specific claim elements, of the patent under reexamination, is considered to be part of the comments submitted by the patent owner, or by the third party requester, and is subject to the page limit requirements of 37 CFR 1.943. Affidavits or declarations that are excluded from the page limit requirements include, for example, declarations attempting to swear behind (antedate) the filing date of a reference, or to establish the date of a printed publication, or declarations that provide comparative test data and an analysis of same. However, if the patent owner's affidavit or declaration includes any argument as to how an outstanding/proposed rejection is overcome, then the page(s) of the affidavit or declaration upon which the argument appears would be included against of the page limit count. Likewise, if a third party requester affidavit or declaration includes any argument as to how a rejection is supported, then the page(s) of the affidavit or declaration upon which the argument appears would be included against of the page limit count. Similarly, attached exhibits presenting data or drawings are not included against the page limit count, unless an exhibit or drawing includes argument as to how the outstanding rejection is overcome. Any page(s) of the exhibit or sheet(s) of drawings that include such argument would be included against the page limit count.

II. Third Party Requester's Petition under 37 CFR 1.183 Filed on August 23, 2010

In the August 23, 2010 petition under 37 CFR 1.183, third party requester requests waiver of the requirement under 37 CFR 1.943(b) with respect to the 50-page limit for third party requester's comments filed concurrently with the present petition, and requests that the page limit be extended to 475 pages.¹ In support of its request for waiver of the rule, third party requester argues that additional pages are needed to address the 21 newly presented claims, and that claim charts are provided to address each and every element of the new claims.²

¹ The August 23, 2010 petition at page 2.

² *Id.*

III. Analysis and Findings

The instant petition under 37 CFR 1.183 has been fully considered. In this instance, petitioner third party requester's August 23, 2010 third party requester written comments include 78 pages of remarks,³ which are subject to the 50 page regulatory limit. The third party requester comments are also accompanied by Exhibits AA-1, BB-1, CC-1, DD-1, EE-1, P, and Q. The first four exhibits are claim charts applying prior art to new claims 14-34. Exhibits P and Q are newly cited references. A discussion of the counting of pages for the Exhibits now follows:

A document is deemed to be subject to the 50-page length requirement when the document includes legal argument, i.e., arguments of counsel such as, e.g., arguments that the claims are patentable or unpatentable, or that are directed to how an outstanding or proposed rejection is overcome, or, in the case of a document filed by the requester, how an outstanding or proposed rejection is supported. There are no *per se* rules for determining whether a document, such as an affidavit or declaration, contains a legal argument that will cause the document to be subject to the page count. Each determination is made on a case-by-case basis. In determining whether a document such as an affidavit or declaration under 37 CFR 1.132, or any other document of a submission, includes legal argument, the Office analyzes whether the document is providing factual evidence, i.e., evidence of **technological** facts, or whether the document is merely an extension of the arguments of counsel. Factual evidence includes, for example, declarations that swear behind the filing date of a reference, that establish the date of a printed publication, that provide a technical explanation or technical definition of terms of art used by a reference, or that provide comparative test results and a scientific, or technological, analysis of the results (see, e.g., MPEP 716.02). If a document is limited to factual evidence, the document is not included in the page count. In addition, affidavits or declarations **limited to** establishing commercial success, long-felt need and failure of others, skepticism of experts, or copying, as per MPEP 716.03 -716.06, respectively, will not be included in the page count.

The five claim charts (attached as Exhibits AA-1, BB-1, CC-1, DD-1, and EE-1 and totaling 403 pages) are proposed rejections for the newly added claims, which count toward the page limit.

Exhibits P and Q are references and therefore do not count toward the page limit.

Accordingly, the August 23, 2010 third party requester comments submission includes *in toto* 481 pages in length as to pages counting toward the regulatory page limit.

In response to requester's argument that additional pages are needed for the claim charts to show where each and every element of the 13 new claims are taught in the prior art, the July 23, 2010 patent owner response at page 39 states that new claims 14-34 specify features similar to those of claims 5, 6, and 8-10. Specifically, the July 23, 2010 patent owner response amends claims 2-4, and 10, adds new claims 14-34, and cancels claims 1 and 7. Claims 2-4 were amended to depend

³ This decision is limited to the page-limit issue and the propriety of third party requester's written comments will be reviewed by the Central Reexamination Unit (CRU).

from claim 5 instead of from claim 1.⁴ Claim 10 was amended by adding the limitation “a serial communication hub controller adapted to transfer data between any two of the computer modules.”⁵ The patent owner response states that newly added independent claim 14 substantially corresponds to original claim 5,⁶ that new independent claim 22 substantially corresponds to original claim 8,⁷ and that new independent claim 30 specifies feature of original claim 1, along with 6 additional features.⁸

A review of the requester’s written comments and attached claim charts reveals a lack of economizing. Third party requester’s proposed rejections for the newly added claims are based on the same primary references (Quantumnet, CHATCOM, EVERSYS, ORIGIN2000 Manual, and Gallagher) that were applied to the claims in the previous office action. Each of the attached claim charts also includes rejections that apply a newly cited reference (IEEE 1355) as a secondary reference in combination with the same primary references of record. The claim charts show that 13 new claims are rejected using the IEEE 1355 reference as a secondary reference and these rejections span 69 pages of the 403 pages of the claim charts. The claim charts also show information being repeated from the IEEE 1355 reference to address these 13 new claims. Furthermore, the comments at pages 30-78 discuss at length how the prior art is applied to the new claims and repeats information in the claim charts. The claim charts are also similar to the claim charts filed with the request that are based on the same prior art references used as the primary reference. Therefore, the claims charts (Exhibits AA-1, BB-1, CC-1, DD-1, and EE-1) attached to the August 23, 2010 comments are repetitive and extraneous and repeat information already of record. The attached claim charts repeat the same information found in the chart charts filed with the request and in the August 23, 2010 comments.

In a balancing of the equities, the third party requester petition under 37 CFR 1.183 is **granted** to the extent that the page limit of 37 CFR 1.943(b) is waived as to the **50 pages** of the portions of requester’s written comments, which are included in the regulatory page count, that exceed the 50-page limit.

Accordingly, third party requester’s August 23, 2010 written comments submission that is effectively substantively 481 pages in length does not comply with the page limit of one-hundred (100) pages in length granted in this decision. The third party requester’s written comments submission lacks an entry right in the present proceeding. The August 23, 2010 written comments paper was entered (scanned) into the IFW before discovery of the defect in the paper, and as such, cannot be physically removed from the IFW. Therefore, the August 23, 2010 written comments paper is being expunged from the record by closing it and marking it “not public” in the IFW of the present reexamination proceeding.

⁴ The July 23, 2010 patent owner response at page 2.

⁵ *Id.* at 3.

⁶ *Id.* at page 9.

⁷ *Id.* at page 10.

⁸ *Id.* at page 11.

THIRD PARTY REQUESTER OPTIONS

For the above reasons, the August 23, 2010 comments submission submitted by the third party requester is improper.

Third party requester is given fifteen (15) days from the mailing date of this decision to file a replacement comments submission, which must be limited to 100 pages pursuant to the page limit waiver granted-in-part in this decision.

Any replacement comments submission filed in response to the notification must be strictly limited to (i.e., must not go beyond) the comments in the original (expunged) comments submission. No comments that add to those in the expunged paper will be considered for entry, and requester will not be given a further opportunity to file a second replacement for the August 23, 2010 comments submission.

If no replacement comments submission from the third party requester is timely received, the reexamination proceeding will be forwarded to the examiner for appropriate action, without entry of written comments by the third party requester.

CONCLUSION

1. Third party requester's August 23, 2010 petition under 37 CFR 1.183 is granted in-part, and the page limit of 37 CFR 1.943(b) is waived to the extent that third party requester's 37 CFR 1.947 comments submission filed in response to the July 23, 2010 patent owner response is not to exceed 100 pages in length, excluding appendices of claims and reference materials, such as prior art references. **This waiver is conditional on the submission being in at least 12 point font and at least one-and-a-half spaced, with appropriate margins.** Third party requester's written comments paper filed on August 23, 2010 is an improper paper, and therefore will NOT be made a part of the record of the 95/001,276 proceeding.
2. Since third party requester's comments submission and accompanying exhibits were scanned into the electronic Image File Wrapper (IFW) of the 95/001,276 proceeding, these papers are expunged by closing them in the 95/001,276 reexamination proceeding's IFW file and marking them as "non-public."
3. Third party requester has fifteen (15) days from the mailing date of this decision to file a redacted comments submission that meets the page limit granted in the present decision. The third party requester's responsive submission must be clearly labeled as either redacted or re-drafted written comments.
4. No copy of the third party requester's August 23, 2010 written comments will be maintained in the record, or elsewhere in the Office.

5. Telephone inquiries related to this decision should be directed to Susy Tsang-Foster, Legal Advisor, at (571) 272-7711.

/Kenneth M. Schor/

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

07-14-2011
Kenpet8/



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,276	01/05/2010	6718415	ACQI-010/11US 310578-2056	8456
58249	7590	02/09/2012	EXAMINER	
COOLEY LLP ATTN: Patent Group Suite 1100 777 - 6th Street, NW WASHINGTON, DC 20001			ART UNIT	PAPER NUMBER

DATE MAILED: 02/09/2012

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

David L. McCombs

HAYNES & BOONE, LLP, IP SECTION

2323 Victory Avenue, Suite 700

Dallas, TX 75219

Date:

MAILED

FEB 09 2012

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001276

PATENT NO. : 6718415

TECHNOLOGY CENTER : 3999

ART UNIT : 3993

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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(For Patent Owner)

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CENTRAL REEXAMINATION UNIT

HAYNES AND BOONE, LLP
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(For Third Party Requester)

In re *Chu*
Control No. 95/001,276
Filed: January 5, 2010
For: U.S. Patent No. 6,718,415

:
: **DECISION**
: **DISMISSING**
: **PETITIONS**

This decision is in response to Patent Owner's renewed petition, filed on May 12, 2011, under 37 CFR 1.182, which is treated as a petition under 37 CFR 1.181 to invoke supervisory authority to expunge the Requester's Comments of August 23, 2010. This decision also addresses the Requester's opposition petition dated May 18, 2011. The petitions are before the Director of the Central Reexamination Unit for decision.

The Patent Owner's petition, filed on May 12, 2011, and the Requester's opposition petition, filed on May 18, 2011, are dismissed as moot for the reasons expressed below.

STATEMENT OF FACTS RELEVANT TO THE DECISION

1. U.S. Patent No. 6,718,415 (the '415 patent) issued on April 6, 2004.
2. A completed request for reexamination of the '831 patent was filed on January 5, 2010. The request was assigned control No. 95/001,276 (the '276 proceeding).
3. On March 12, 2010, the Office ordered that the patent be reexamined.
4. On May 26, 2010, the Office mailed a first Office action in the '276 proceeding.
5. On July 23, 2010, the Patent Owner filed a response to the Office action.
6. On August 23, 2010, the Third Party Requester filed comments. The Requester also filed a petition under 37 CFR 1.183 requester waiver of the page limit in 37 CFR 1.943(b).
7. On October 6, 2010, the Patent Owner filed a petition under 37 CFR 1.181 requesting that the August 23, 2010 comments be expunged from the record of the '276 proceeding.
8. On October 14, 2010, the Requester filed an opposition petition to the Patent Owner's October 6, 2010 petition.
9. On April 18, 2011, the Office mailed a decision dismissing the October 6 and 14, 2010 petitions as premature.
10. On May 12, 2011, the Patent Owner filed the instant petition under 37 CFR 1.181 requesting that the Office expunge the comments filed by the Requester on August 23, 2010.
11. On May 18, 2011, the Requester filed an opposition petition to Patent Owner's May 12, 2011 petition.
12. On July 15, 2011, the Office mailed a decision on Requester's August 23, 2010 petition under 37 CFR 1.183. The decision stated that the Requester's comment submission, dated August 23, 2010, is an improper paper and is expunged from the record of the '276 proceeding. The Notice gave Requester 15 days to file replacement comments.

DECISION

As pointed out, the Patent Owner filed a May 12, 2011 renewed petition under 37 CFR 1.182 to expunge the Third Party Requester's August 23, 2010 comments. It is noted that a petition under 37 CFR 1.182 is not proper because the petition addresses issues that are properly raised under 37 CFR 1.181. Therefore, the petition is being addressed under 37 CFR 1.181. In other words, a

petition under 37 CFR 1.182 is not the proper means to seek relief for the issues raised in the May 12, 2011 petition. In summary, although the petition contains statements that relief sought is under 37 CFR 1.182, the petition is being addressed as a petition under 37 CFR 1.181.

As pointed out, the Patent Owner filed a May 12, 2011 petition requesting expungement of any Requester's comments filed on August 23, 2010. Patent Owner alleges that the August 23, 2010 comments were not in compliance with the requirements of 37 CFR 1.947. For this reason, Patent Owner asserts that any Requester's comments filed on August 23, 2010 should be expunged from the proceeding record.


On July 15, 2011, as discussed above, the Office mailed a petition decision that determined that the August 23, 2010 comments are improper papers and expunged the comments from the record. As the August 23, 2010 comments have been entered into the electronic Image File Wrapper (IFW) record, the comments are expunged from the record by closing the papers in the IFW record, and marking the papers nonpublic. See MPEP 2667.

As a result of the July 15, 2011 decision, the remedy of expungement of the August 23, 2010 comments is already given. In other words, the ultimate relief requested by the May 12, 2011 petition, and opposed by the Requester's May 18, 2011 petition, was given by the July 15, 2011 Office decision.

For these reasons, the Patent Owner's May 12, 2011 petition and Requester's May 18, 2011 opposition petition are moot, and hereby, dismissed.

CONCLUSION

1. The May 12, 2011 Patent Owner's petition is dismissed as moot.
2. The May 19, 2011 Requester's opposition petition is dismissed as moot.
2. Telephone inquiries related to this decision should be directed Sudhanshu Pathak, Supervisory Patent Examiner, at (571) 272-3770.



Irem Yucel, Director
Technology Center 1600



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,276	01/05/2010	6718415	ACQI-010/11US 310578-2056	8456
58249	7590	02/09/2012	EXAMINER	
COOLEY LLP ATTN: Patent Group Suite 1100 777 - 6th Street, NW WASHINGTON, DC 20001			ART UNIT	PAPER NUMBER

DATE MAILED: 02/09/2012

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

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MAILED
Date: **FEB 09 2012**
CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001276

PATENT NO. : 6718415

TECHNOLOGY CENTER : 3999

ART UNIT : 3993

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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(For Patent Owner)

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CENTRAL REEXAMINATION UNIT

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DALLAS, TX 75219

(For Third Party Requester)

In re *Chu*
Control No. 95/001,276
Filed: January 5, 2010
For: U.S. Patent No. 6,718,415

:
: **DECISION**
: **DISMISSING**
: **PETITIONS**

This decision is in response to Third Party Requester's petition, filed on April 26, 2011, under 37 CFR 1.182, which is treated as a petition under 37 CFR 1.181 to invoke supervisory authority to not enter Patent Owner's supplemental response of April 12, 2011. This decision also addresses the Patent Owner's petition, dated July 12, 2011, under 37 CFR 1.181 to expunge Requester's May 12, 2011 comments to Patent Owner's supplemental response. The petitions are before the Director of the Central Reexamination Unit for decision.

The Requester's petition, filed on April 26, 2011, and Patent Owner's petition, filed on July 12, 2011 are dismissed as premature for the reasons expressed below.

STATEMENT OF FACTS RELEVANT TO THE DECISION

1. U.S. Patent No. 6,718,415 (the '415 patent) issued on April 6, 2004.
2. A completed request for reexamination of the '831 patent was filed on January 5, 2010. The request was assigned control No. 95/001,276 (the '276 proceeding).
3. On March 12, 2010, the Office ordered that the patent be reexamined.
4. On May 26, 2010, the Office mailed a first Office action in the '276 proceeding.
5. On July 23, 2010, the Patent Owner filed a response to the Office action.
6. On August 23, 2010, the Third Party Requester filed comments. The Requester also filed a petition under 37 CFR 1.183 requester waiver of the page limit in 37 CFR 1.943(b).
7. On October 6, 2010, the Patent Owner filed a petition under 37 CFR 1.181 requesting that the August 23, 2010 comments be expunged from the record of the '276 proceeding.
8. On October 14, 2010, the Requester filed an opposition petition to the Patent Owner's October 6, 2010 petition.
9. On April 12, 2011, the Patent Owner filed a supplemental response to the May 26, 2010 Office action.
10. On April 18, 2011, the Office mailed a decision dismissing the October 6 and 14, 2010 petitions as premature.
11. On April 26, 2011, the Requester filed the instant petition requesting that the April 12, 2011 supplemental response not be entered into the record of the '276 proceeding.
12. On May 12, 2011, the Requester filed comments on the April 12, 2011 supplemental response.
13. On July 12, 2011, the Patent Owner filed the instant petition under 37 CFR 1.181 requesting that Requester's May 12, 2011 comments be expunged from the record.
14. To date, the examiner has not acted on the responses and comments filed.

DECISION

As pointed out, the Requester filed an April 26, 2011 petition under 37 CFR 1.182 to not enter the Patent Owner's April 12, 2011 supplemental response. It is noted that a petition under 37

CFR 1.182 is not proper because the petition addresses issues that are properly raised under 37 CFR 1.181. Therefore, the petition is being addressed under 37 CFR 1.181. In other words, a petition under 37 CFR 1.182 is not the proper means to seek relief for the issues raised in the May 12, 2011 petition. In summary, although the petition contains statements that relief sought is under 37 CFR 1.182, the petition is being addressed as a petition under 37 CFR 1.181.

As pointed out, Requester's petition requests that Patent Owner's April 12, 2011 supplemental response not be entered into the record. Requester asserts that the April 12, 2011 supplemental response fails to meet the requirements of 37 CFR 1.111(a)(2) for entry. In addition, the Patent Owner filed a July 12, 2011 petition requesting expungement of Requester's May 12, 2011 comments filed on the April 12, 2010 supplemental response. Patent Owner alleges that the May 12, 2011 comments were not in compliance with the requirements of 37 CFR 1.947. For these reason, Requester asserts that Patent Owner's April 12, 2011 supplemental response should not be entered and Patent Owner asserts that Requester's May 12, 2011 comments should be expunged from the proceeding record.

However, there has been no decision by the examiner if the Patent Owner's April 12, 2011 supplemental response or the Third Party Requester's comments of May 12, 2011 are entered into the record and are in compliance with Office rules and procedures. Accordingly, it is premature to invoke supervisory authority regarding entry of the April 12, 2011 supplemental response or the May 12, 2011 comments because the examiner has not made his or her decision. Thus, the Requester's April 26, 2011 petition and the Patent Owner's July 12, 2011 petition are premature and are accordingly dismissed.

CONCLUSION

1. The April 26, 2011 Requester's petition is dismissed as premature.
2. The July 12, 2011 Patent Owner's petition is dismissed as premature.
3. Telephone inquiries related to this decision should be directed Sudhanshu Pathak, Supervisory Patent Examiner, at (571) 272-3770.



Irem Yucel, Director
Technology Center 1600



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,278	12/07/2009	7332881	020529-9319	3148
27572	7590	10/21/2010	EXAMINER	
HARNES, DICKEY & PIERCE, P.L.C. P.O. BOX 828 BLOOMFIELD HILLS, MI 48303			ART UNIT	PAPER NUMBER

DATE MAILED: 10/21/2010

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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/001,278	12/07/2009	7332881	

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INTER PARTES REEXAMINATION COMMUNICATION

BELOW/ATTACHED YOU WILL FIND A COMMUNICATION FROM THE UNITED STATES PATENT AND TRADEMARK OFFICE OFFICIAL(S) IN CHARGE OF THE PRESENT REEXAMINATION PROCEEDING.

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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/001,278	12/07/2009	7332881	

MICHAEL BEST & FRIEDRICH LLP
100 WISCONSIN AVENUE
SUITE 300
MILWAUKEE, WI 53202

EXAMINER
ENGLISH, PETER

ART UNIT	PAPER
3993	

DATE MAILED:

***INTER PARTES* REEXAMINATION COMMUNICATION**

BELOW/ATTACHED YOU WILL FIND A COMMUNICATION FROM THE UNITED STATES PATENT AND TRADEMARK OFFICE OFFICIAL(S) IN CHARGE OF THE PRESENT REEXAMINATION PROCEEDING.

All correspondence relating to this *inter partes* reexamination proceeding should be directed to the **Central Reexamination Unit** at the mail, FAX, or hand-carry addresses given at the end of this communication.



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HARNESS, DICKEY & PIERCE, P.L.C.
P.O. BOX 828
BLOOMFIELD HILLS, MI 48303

(For Patent Owner)

MAILED

OCT 21 2010

CENTRAL REEXAMINATION UNIT

MICHAEL BEST & FRIEDRICH LLP
100 WISCONSIN AVENUE
SUITE 300
MILWAUKEE, WI 53202

(For Requester)

<i>In re Clark et al.</i>	:	
Reexamination Proceeding	:	DECISION ON PETITION
Control No.: 95/001,278	:	UNDER 37 CFR 1.181
Filed: December 7, 2009	:	
For: U.S. Patent No.: 7,332,881	:	

This is a decision on a petition filed by the patent owner on September 9, 2010. The petition is a request to the Director to exercise her discretion pursuant to 37 CFR 1.181 and enter the amendment filed June 1, 2010, which was filed in response to an Action Closing Prosecution (ACP).

The petition under 37 CFR 1.181 is before the Director of Technology Center 1600, who oversees the Central Reexamination Unit.

The petition under 37 CFR 1.181 to invoke the supervisory authority of the Director dated September 9, 2010 is denied with respect to entering the post-ACP amendment into the record of the *Inter Partes* reexamination proceeding 95/001,278.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 7,332,881 (hereinafter, the '881 patent) issued on February 19, 2008.
2. A request for *inter partes* reexamination, assigned control No. 95/001,278 (hereinafter, the '278 reexamination proceeding) was filed by a third party requester on December 7, 2009.
3. *Inter partes* reexamination was ordered for claims 32-38 in the '278 reexamination proceeding on January 14, 2010. Reexamination of claims 1-31 was not requested. On the same day, a non-final Office action, which rejected claims 32-38, was mailed.
4. The patent owner filed a response to the non-final Office action on March 15, 2010. The response included proposed amendments to independent patent claims 32 and 35.
5. The third party filed comments on April 14, 2010 to the patent owner's response. The comments included newly proposed rejections based on newly cited prior art.
6. On April 30, 2010, the Office issued an Action Closing Prosecution (ACP), which addressed the patent owner's response and the third party comments. The ACP withdrew previously adopted rejections and adopted some of the newly proposed rejections raised by the April 14, 2010 comments.
7. On June 1, 2010, patent owner filed remarks in response to the ACP (hereinafter, the post-ACP amendment). The response included additional proposed amendments to patent claims 32 and 35 and proposed new claims 39-46.
8. On June 25, 2010, the third party filed comments to the patent owner's response.
9. On August 9, 2010, the Office mailed a Right of Appeal Notice (RAN), which denied entry of the post-ACP amendment to the claims. See page 2 of the RAN.
10. On September 9, 2010, the patent owner filed the instant petition, requesting entry of the post-ACP amendment. The patent owner also filed a Notice of Appeal.
11. On October 11, 2010, the third party requester filed comments on the patent owner's petition dated September 9, 2010.

12. In concurrent litigation, a court ordered a motion to stay pending reexamination. See the January 12, 2010 order in E-Z-GO, et al. v. Club Car, Inc., U.S. District of Southern Georgia, 1:09CV119, filed October 1, 2009.

The patent owner (petitioner) states that the examiner erred in deciding not to enter the proposed post-ACP amendment because the ACP and RAN were issued prematurely. The petitioner also states that the proposed amendment overcomes all the rejections in the RAN and furthers prosecution. See, e.g., page 1 of the petition. The petitioner also states that the examiner's refusal to enter the post-ACP amendment is unfair because the rejections in the ACP were based on prior art not of record when the patent owner responded to the first Office action. See pages 3-7 of the petition.

In response to patent owner's arguments that the examiner erred in deciding not to enter the proposed post-ACP amendment, the director finds there are not good and sufficient reasons to enter the proposed amendment. First, 35 U.S.C. 314(c) requires that all *inter partes* reexamination proceedings to be acted upon with "special dispatch." The rules and procedures of the Office were established through notice and comment in order to achieve special dispatch in a reasonable manner. Office rules and procedures encourage examiners to look at the facts involved in a particular proceeding and to weigh the equities before issuing a right of appeal notice and/or an action closing prosecution. Furthermore, MPEP 2673 states that:

It should be kept in mind that a patent owner cannot, as a matter of right, amend claims rejected in the ACP, add new claims after an ACP, nor reinstate previously canceled claims. A showing under 37 CFR 1.116(b) is required and will be evaluated by the examiner for all proposed amendments after the ACP, except where an amendment merely cancels claims, adopts examiner's suggestions, removes issues for appeal, or in some other way requires only a cursory review by the examiner.

Where the entry of the proposed amendment (after the ACP) would result in any ground of rejection being withdrawn or any additional claim indicated as patentable, the proposed amendment generally raises new issues requiring more than cursory review by the examiner. The examiner would need to indicate new grounds for patentability for any claim newly found patentable and/or the reason why the rejection was withdrawn and would also need to deal with any third party requester's comments on the proposed amendment (made pursuant to 37 CFR 1.951(b) in response to owner's proposed amendment). Thus, the examiner is not required to enter the proposed amendment.

In view of the fact that the patent owner cannot continue the proceeding by refiling under 37 CFR 1.53(b) or 1.53(d) nor by filing a Request for Continued Examination under 37 CFR 1.114 and the patent owner cannot file an *inter partes* reexamination request (see MPEP § 2612), the examiner should consider the feasibility of entering a proposed amendment paper, where the entirety of the amendment would result *only* in an additional claim (or claims) being indicated as patentable. The examiner is encouraged to enter such an amendment unless the entry would

cause an "undue burden" on the examiner. Where the examiner does not enter the amendment, the examiner should explain the "undue burden."

Second, petitioner's arguments that the ACP was premature are not timely. 37 CFR 1.181(f) requires that a petition under 37 CFR 1.181 be filed within two months of the mailing date of the action or notice from which relief is requested. The ACP was mailed on April 30, 2010, which is more than two months from the filing of the petition (September 9, 2010). Therefore, arguments that the ACP was premature will not be specifically addressed because such arguments are not timely.

In regard to the petitioner's arguments that RAN is premature or that the post-ACP amendment was improperly denied entry, the record shows that there was a non-final Office action to which patent owner responded with amendments that were entered into the record. Specifically, proposed amendments to independent patent claims 32 and 35 were filed after the non-final Office action. These proposed amendments overcame the rejections made in the non-final Office action as evidenced by the fact that all the rejections made in the non-final Office action were withdrawn. See pages 11-16 of the ACP. More importantly, the ACP did not introduce any new grounds of rejection that was not necessitated by amendments to the claims. The RAN repeated the same grounds as the ACP, and therefore, did not introduce any new grounds of rejection. Therefore, the RAN was not premature. In addition, the RAN set forth specific reasons why the post-ACP amendment did not comply with 37 CFR 1.116 and 1.530, and therefore, was not entered into the proceeding record. See page 2 of the RAN. Specifically, the proposed amendment to claims 32 and 35 were not compliant with 37 CFR 1.530(d)-(j) because the markings to show the changes were not made relative to the original patent claims, the new text was not underlined, and deletions were shown by strikethrough instead of bracketed text. Furthermore, the proposed amendment introduced new issues that would require further consideration and did not simply issues for appeal. Therefore, the examiner explained the "undue burden" as stated in MPEP 2673. For these reasons, the examiner followed Office procedures and policies. Accordingly, the examiner did not abuse his discretion by the decision to not enter the post-ACP amendment.

In the petition, petitioner argues that the post-ACP amendment should be entered and prosecution reopened because the post-ACP amendment overcomes the prior art rejections and would not be an undue burden. The petition states that claims 32 and 35 were amended to only add an further limitation to the controller, which was already cited in the claims and proposed new claims 39-46 were within the scope of the "Examiner's prior art search regarding originally issued claims 32-38." The petitioner argues that there is not undue burden on the examiner. The petition also states that it is unfair to require that patent owner predict future rejections based upon references that were not of record when patent owner's March 15, 2010 amendment was filed. However, as discussed above, the record shows that the post-ACP amendment clearly does more than merely cancel claims, adopt examiner's suggestions, remove issues for appeal, or in some other way require only a cursory review by the examiner. In addition, the examiner

showed why entry of the amendment would be an undue burden as required by 37 CFR 1.116. See page 2 of the RAN. Specifically, the examiner explained how entry of the post-ACP amendment would raise new issues and how the post-ACP amendment did not comply with 37 CFR 1.116 and 1.530. Therefore, the record shows that the examiner properly determined that the proposed post-ACP amendment should not be entered.

In summary, the examiner appropriately applied Office policies and procedures in determining that the post-ACP amendment should not be entered, and issued a RAN in the interest of "special dispatch." As stated above, there is copending litigation that is stayed for this reexamination proceeding. Therefore, advancing prosecution with "special dispatch" is even more important in this proceeding. For the reasons set forth above, it is deemed that the examiner followed Office rules and procedures and did not abuse his discretion in deciding to not enter the post-ACP amendments. Accordingly, the patent owner's petition is denied.

Third Party Requester's Comments dated October 11, 2010

The comments dated October 11, 2010 are returned as an improper paper, and accordingly, it has not been considered. In other words, the October 11, 2010 comments do not have an entry right under the rules. Therefore, the October 11, 2010 comments will not be made of record in the reexamination proceeding, and it is being returned to the third party requester *without consideration of the substance of the comments*. As the paper has been entered into the electronic Image File Wrapper (IFW) record, the paper will be "returned" by closing the paper in the IFW, and marking the paper nonpublic to expunge it from the record. The present decision will, however, be made of record in the reexamination proceeding. See also MPEP 2267.

CONCLUSION

1. The petition under 37 CFR 1.181 for reconsideration of the entry of the post-ACP amendment and/or reopening of prosecution in the '278 reexamination proceeding is denied.
2. The October 11, 2010 comments are returned to the third party requester with this decision as not having a right of entry. No copy of the petition papers will be maintained in the electronic Image File Wrapper for the proceedings, or elsewhere in the Office.
3. Telephone inquiries related to this decision should be directed to Andy Kashnikow, Supervisory Patent Examiner, at (571) 272-4361.



Irem Yucel, Director
Technology Center 1600



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,281	02/03/2010	7,634,228	AFF.0004B7US	5149
21906	7590	01/12/2011	EXAMINER	
TROP, PRUNER & HU, P.C. 1616 S. VOSS ROAD, SUITE 750 HOUSTON, TX 77057-2631			ART UNIT	PAPER NUMBER

DATE MAILED: 01/12/2011

Please find below and/or attached an Office communication concerning this application or proceeding.



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
KENYON & KENYON LLP
ONE BROADWAY
NEW YORK, NY 10004

Date:

MAILED

JAN 12 2011

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001281
PATENT NO. : 7634228
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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(For Patent Owner)

MAILED

JAN 12 2011

KENYON & KENYON LLP
ONE BROADWAY
NEW YORK, NY 10004

CENTRAL REEXAMINATION UNIT
(For Third Party Requester)

Inter Partes Reexamination Proceeding
Control No. 95/001,281
Filed: February 3, 2010
For: U.S. Patent No. 7,634,228

: **DECISION**
: **DISMISSING**
: **PETITION**
:

This is a decision on patent owner's petition paper entitled "PETITION UNDER 37 C.F.R. § 1.183 TO WAIVE PAGE LIMIT REQUIREMENT FOR THE PATENT OWNER REPLY UNDER 37 C.F.R. § 1.943(b)," filed on November 2, 2010.

The patent owner petition is before the Office of Patent Legal Administration.

The petition fee of \$400.00 pursuant to 37 CFR 1.17(f) for the petition under 37 CFR 1.183 has been paid.

The patent owner petition under 37 CFR 1.183 is dismissed as moot, for the reasons set forth herein.

DECISION

I. Relevant Authority

37 CFR 1.183 provides:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be

imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 CFR 1.943(b) provides:

Responses by the patent owner and written comments by the third party requester shall not exceed 50 pages in length, excluding amendments, appendices of claims, and reference materials such as prior art references.

II. Patent Owner Petition Under 37 CFR 1.183

In the instant petition under 37 CFR 1.183, patent owner requests waiver of the requirement under 37 CFR 1.943(b) with respect to the 50-page limit for the November 2, 2010 patent owner response to the September 2, 2010 non-final Office action, and requests that the page limit be extended to 85 pages.¹

III. Analysis and Findings

The instant petition under 37 CFR 1.183 has been fully considered. In this instance, petitioner patent owner's November 2, 2010 response includes 23 pages of remarks, which are subject to the 50 page limit.

The patent owner response is also accompanied by the declarations of Paul Polansky under 37 CFR 1.132 and Russell White under 37 CFR 1.132.

A document is deemed to be subject to the 50-page length requirement when the document includes legal argument, i.e., arguments of counsel such as, e.g., arguments that the claims are patentable or unpatentable, or that are directed to how an outstanding or proposed rejection is overcome, or, in the case of a document filed by the requester, how an outstanding or proposed rejection is supported. There are no *per se* rules for determining whether a document, such as an affidavit or declaration, contains a legal argument that will cause the document to be subject to the page count. Each determination is made on a case-by-case basis. In determining whether a document such as an affidavit or declaration under 37 CFR 1.132, or any other document of a submission, includes legal argument, the Office analyzes whether the document is providing factual evidence, i.e., evidence of **technological** facts, or whether the document is merely an extension of the arguments of counsel. Factual evidence includes, for example, declarations that swear behind the filing date of a reference, that establish the date of a printed publication, that provide a technical explanation or technical definition of terms of art used by a reference, or that provide comparative test results and a scientific, or technological, analysis of the results (see, e.g., MPEP 716.02). If a document is limited to factual evidence, the document is not included in the page count. In addition, affidavits or declarations **limited to** establishing commercial

¹ Petition at page 1.

success, long-felt need and failure of others, skepticism of experts, or copying, as per MPEP 716.03 -716.06, respectively, will not be included in the page count.

The declaration of Polansky and the accompanying Appendices A-Z do not contain any legal arguments and therefore do not count toward the page limit.

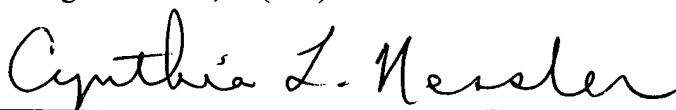
The declaration of White is accompanied by Exhibit D. The declaration of White and attached Exhibit D contain legal arguments. Attached Exhibit D is patent owner's infringement contentions and contains legal arguments regarding the priority date of the patent claims on pages 4, 6, 8, and 10, which count toward the page limit. In addition, on page 2 of the declaration, White states: "The following facts establish that the claims of the '288 patent are not obvious..." On page 7 of the declaration, White states: "For at least these reasons, the claims of the '288 patent are not obvious." The remaining pages of the White declaration are strictly drawn to evidence of commercial success, which do not count toward the page limit. Similarly, the claim chart of Exhibit E is not counted toward the page limit, because the claim chart, for example, is not comparing the limitations of the claims under reexamination with the teachings of a reference cited against the claims. Rather, the claim chart of Exhibit E is comparing the present invention to that of a device which patent owner alleges is infringing the claims of the '947 patent, and is provided as alleged evidence of commercial success. For this reason, the claim chart of Exhibit E is not included in the page count.

Accordingly, the November 2, 2010 patent owner response *in toto* is 29 pages in length.

For the reasons given above, the November 2, 2010 patent owner's response is deemed to be within the 50-page regulatory limit. Accordingly, the November 2, 2010 patent owner petition is **dismissed as moot**.

CONCLUSION

1. Patent owner's November 2, 2010 petition is **dismissed as moot**. Patent owner's response filed on November 2, 2010 is deemed to be page-length compliant.
2. Any questions concerning this communication should be directed to Susy Tsang-Foster, Legal Advisor, at (571) 272-7711.



Cynthia L. Nessler
Senior Legal Advisor
Office of Patent Legal Administration



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(For Patent Owner)

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APR 18 2011

(For Requester) **CENTRAL REEXAMINATION UNIT**

KENYON & KENYON LLP
ONE BROADWAY
NEW YORK, NY 10004

In re: White et alia
Reexamination Proceeding
Control No. 95/001,281
Corrected Request Deposited: February 3, 2010
For: U.S. Patent No. 7,634,228

:
: **DECISION**
: **DISMISSING**
: **PETITION**
:

The *inter partes* reexamination is before the Central Reexamination Unit to address the February 11, 2011 third party requester (3PR) paper entitled "PETITION BY VOLKSWAGEN GROUP OF AMERICA, INC. UNDER 37 C.F.R. § 1.182".

Initially, it is noted that 3PR filed comments on February 11, 2011 to the patent owner (PO) response and also filed a petition to waive the page limit. The page-limit waiver petition remains pending. Thus, the proceeding is not currently before the examiner for action.

3PR requests acceleration of the present *inter partes* reexamination proceeding as stated in MPEP 2686.04.

The Office is aware of the provisions of MPEP 2686.04. It is also noted that the next action may be an Action Closing Prosecution which sets a period of 30 days or one month (whichever is longer) to comment and/or propose amendments in accordance with MPEP 2671.02.

However, as the office has not yet issued the next office action, a petition requesting a specific period to be set is **dismissed as premature**.

Inquiries regarding this decision may be directed to Eric Keasel, Supervisory Patent Examiner, at (571) 272-4929.

Application/Control Number: 95/001,281

Page 2

Art Unit: 3992

This decision is not a final agency decision and is without prejudice to request reconsideration or higher-level review.

A handwritten signature in cursive script, reading "Eric Keasel", written over a horizontal line.

Eric Keasel

SPE, Central Reexamination Unit, Art Unit 3992



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CENTRAL REEXAMINATION UNIT

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(For Third Party Requester)

Inter Partes Reexamination Proceeding
Control No. 95/001,281
Filed: February 3, 2010
For: U.S. Patent No. 7,634,228

: **DECISION**
: **DISMISSING**
: **PETITION**
:

This is a decision on third party requester's petition paper entitled "PETITION UNDER 37 C.F.R. § 1.183 TO WAIVE THE PAGE LIMIT FOR REQUESTER'S RESPONSE UNDER 37 C.F.R. § 1.943(b)," filed on February 11, 2011.

The third party requester petition is before the Office of Patent Legal Administration.

The third party requester petition under 37 CFR 1.183 is dismissed, for the reasons set forth herein.


DECISION

On September 2, 2010, an Office action was issued for the present proceeding, and patent owner responded to that Office action on November 2, 2010. In addition, November 2, 2010 is the date of service of the patent owner's response which appears in patent owner's certificate of service that was filed as part of the response. On February 11, 2011, third party requester filed the instant petition under 37 CFR 1.183, requesting suspension of 37 CFR 1.943(b), which limits requester's comments to 50 pages in length. Third party requester's comments submission, for which the § 1.183 relief is requested, was however not filed until February 11, 2011 (the same date that the § 1.183 petition was filed). Third party requester's February 11, 2011 comments submission was untimely, because it was filed more than thirty days from the November 2, 2010 date of service of the patent owner's response. See 35 U.S.C. 314(b)(2) and 37 CFR 1.947.

The merits of the third party requester's petition under 37 CFR 1.183 are not being addressed because, based on the record of the instant proceeding, requester's comments submission of February 11, 2011 was untimely filed. Thus, even if the present petition would be found to present a favorable showing for 37 CFR 1.943(b) to be waived (to permit extra pages for requester's February 11, 2011 comments submission), requester's comments submission would still not be considered, because it was not timely filed. And thus, it has not been shown that extraordinary circumstances exist justifying entry of requester's February 11, 2011 comments submission in excess of the regulatory page limit.

CONCLUSION

1. Third party requester's petition under 37 CFR 1.183 is **dismissed**
2. Any questions concerning this communication should be directed to Susy Tsang-Foster, Legal Advisor, at (571) 272-7711.



Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

5/3/11
Kenpet8/IP/length



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,281	02/03/2010	7,634,228	AFF.0004B7US	5149
21906	7590	08/24/2011	EXAMINER	
TROP, PRUNER & HU, P.C. 1616 S. VOSS ROAD, SUITE 750 HOUSTON, TX 77057-2631			ART UNIT	PAPER NUMBER

DATE MAILED: 08/24/2011

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(For Patent Owner)

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AUG 24 2011

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CENTRAL REEXAMINATION UNIT
(For Third Party Requester)

In re White et alia
Reexamination Proceeding
Control No. 95/001,281
For: U.S. Patent No. 7,634,228

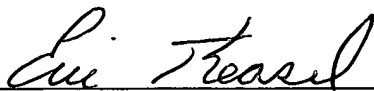
:
: **DECISION DISMISSING**
: **PETITION**
:

The *inter partes* reexamination is before the Central Reexamination Unit for consideration of a paper filed February 11, 2011 requesting "the shortening of the patent owner's response period for all further Office Actions to one month or thirty days, whichever is longer".

A review of the file indicates that an Action Closing Prosecution was mailed on August 18, 2011 setting a one-month period for response.

Accordingly, the petition is **dismissed** as either moot or unclear/undefined. To the extent that the subsequent action set a one-month period for response, the request to set a one-month period for response is moot. Alternatively, the request to shorten the period for all future responses is dismissed as "all future Office Actions" is not a clearly defined set. Furthermore, petitioner cites to the pending litigation as a basis for the shortened period for response. It is unclear if the litigation will be pending for "all future Office Actions".

This is not a final agency action. The decision is made without prejudice to a request for reconsideration or higher-level review.


Eric Keasel
SPE, AU 3992



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CENTRAL REEXAMINATION U

TROP, PRUNER & HU, P.C.
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(For Patent Owner)

KENYON & KENYON LLP
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(For Third Party Requester)

Inter Partes Reexamination Proceeding
Control No. 95/001,281
Filed: February 3, 2010
For: U.S. Patent No. 7,634,228

: **DECISION**
: **DENYING**
: **PETITION**
:

This is a decision on the third party requester petition entitled "PETITION UNDER 37 C.F.R. § 1.181 FOR RECONSIDERATION," filed on May 19, 2011.

The petition for reconsideration requests the following relief: (1) that the May 5, 2011 Office decision dismissing requester's February 11, 2011 petition be vacated, (2) that the requester's February 11, 2011 petition under 37 CFR 1.183 requesting waiver of the page limit under 37 CFR 1.943(b) be granted in its entirety, and (3) that the requester's February 11, 2011 comments submission be considered timely filed and entered for consideration by the examiner.

The petition for reconsideration is before the Office of Patent Legal Administration for consideration.

SUMMARY

The petition for reconsideration is granted only to the extent that the May 5, 2011 Office decision on requester's February 11, 2011 petition has been reconsidered, but is denied with respect to making any change therein. **The petition for reconsideration is denied as to the relief requested.** The February 11, 2011 comments submission will not be entered for consideration, because it was not timely filed. Accordingly, the merits of the February 11, 2011 petition requesting waiver of the requirement of 37 CFR 1.943(b) that its February 11, 2011 comments submission not exceed fifty pages in length will not be addressed.

The May 5, 2011 Office decision **properly dismissed** requester's February 11, 2011 petition and **properly refused consideration of** requester's February 11, 2011 comments submission.

BACKGROUND

- On December 15, 2009, U.S. Patent 7,634,228 (the '228 patent) issued to White et al., with claims 1-30.
- On February 3, 2010, a third party requester met the filing date requirements for a request for *inter partes* reexamination of claims 1-30 of the '228 patent that was assigned control number 95/001,281 (the '281 proceeding).
- On March 23, 2010, the United States Patent and Trademark Office ("the Office") mailed an order granting *inter partes* reexamination.
- On September 2, 2010, the Office mailed a non-final Office action.
- On November 2, 2010, patent owner timely filed a response to the September 2, 2010 non-final Office action. Concurrently with the response, patent owner filed a petition entitled "PETITION UNDER 37 C.F.R. § 1.183 TO WAIVE PAGE LIMIT REQUIREMENT FOR THE PATENT OWNER REPLY UNDER 37 C.F.R. § 1.943(b)."
- On January 12, 2011, the Office mailed a decision dismissing the patent owner's November 2, 2010 petition as moot and deemed patent owner's November 2, 2010 response to be page-length compliant.
- On February 11, 2011, requester filed comments directed to the November 2, 2010 patent owner response and to the September 2, 2010 non-final Office action. Concurrently with the comments submission, requester filed a petition entitled "PETITION UNDER 37 C.F.R. § 1.183 TO WAIVE THE PAGE LIMIT FOR REQUESTER'S RESPONSE UNDER 37 C.F.R. § 1.943(b)."
- On May 5, 2011, the Office mailed a decision dismissing the requester's February 11, 2011 petition for waiver of the regulatory page limit because the February 11, 2011 comments submission was not eligible for consideration since it was not timely filed (37 CFR 1.957(a)).
- On May 19, 2011, requester filed the instant petition entitled "Petition Under 37 C.F.R. § 1.181 for Reconsideration."

RELEVANT STATUTES, REGULATIONS, AND EXAMINING PROCEDURE**35 U.S.C. § 314(b)(2) states (emphasis added):**

Each time that the patent owner files a response to an action on the merits from the Patent and Trademark Office, the third-party requester shall have one opportunity to file written comments addressing issues raised by the action of the Office or the patent owner's response thereto, if those written comments are received by the Office **within 30 days after the date of service of the patent owner's response.**

37 CFR 1.183 states:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 CFR 1.943(b) provides:

Responses by the patent owner and written comments by the third party requester shall not exceed 50 pages in length, excluding amendments, appendices of claims, and reference materials such as prior art references.

37 CFR 1.947 states (emphasis added):

Each time the patent owner files a response to an Office action on the merits pursuant to § 1.945, a third party requester may **once file written comments within a period of 30 days from the date of service of the patent owner's response.** These comments shall be limited to issues raised by the Office action or the patent owner's response. The time for submitting comments by the third party requester may not be extended. For the purpose of filing the written comments by the third party requester, the comments will be considered as having been received in the Office as of the date of deposit specified in the certificate under § 1.8.

37 CFR 1.957(a) states:

If the third party requester files an untimely or inappropriate comment, notice of appeal or brief in an *inter partes* reexamination, the paper will be refused consideration.

The Manual of Patent Examining Procedure (MPEP) § 2667(I), provides in pertinent part:

Any affidavit or declaration (or a clearly defined portion thereof) that contains opinion(s) of the affiant/declarant, or argument(s) that the art either does or does not anticipate or render obvious the claims, or specific claim elements, of the patent under reexamination, is considered to be part of the comments submitted by the patent owner, or by the third party requester, and is subject to the page limit requirements of 37 CFR 1.943. Affidavits or declarations that are

excluded from the page limit requirements include, for example, declarations attempting to swear behind (antedate) the filing date of a reference, or to establish the date of a printed publication, or declarations that provide comparative test data and an analysis of same. However, if the patent owner's affidavit or declaration includes any argument as to how an outstanding/proposed rejection is overcome, then the page(s) of the affidavit or declaration upon which the argument appears would be included against of the page limit count. Likewise, if a third party requester affidavit or declaration includes any argument as to how a rejection is supported, then the page(s) of the affidavit or declaration upon which the argument appears would be included against of the page limit count. Similarly, attached exhibits presenting data or drawings are not included against the page limit count, unless an exhibit or drawing includes argument as to how the outstanding rejection is overcome. Any page(s) of the exhibit or sheet(s) of drawings that include such argument would be included against the page limit count.

The Manual of Patent Examining Procedure (MPEP), Section 2666.05 (I) states in pertinent part (emphasis added):

A third party requester may once file written comments on any patent owner response to an Office action, during the examination stage of an *inter partes* reexamination proceeding. The third party requester comments must be filed **within a period of 30 days from the date of service** of the patent owner's response on the third party requester. 37 CFR 1.947. The date that the Office receives the patent owner's response has no bearing on the time period for which the third party requester must file the comments.

If the third party requester comments are filed **after 30 days from the date of service** of the patent owner's response on the third party requester, the comments will not be considered. See 37 CFR 1.957(a).

The following special circumstance is to be noted. In unique circumstances, it may happen that a patent owner files a response to an Office action and **the page length of the response exceeds the page length set by 37 CFR 1.943(b)**. Accompanying the response is a petition under 37 CFR 1.183 requesting waiver of the 37 CFR 1.943(b) requirement. **Until such a 37 CFR 1.183 petition to waive the page length is granted, or a page length compliant response is filed (if the 37 CFR 1.183 petition is not granted), the patent owner response is incomplete.** Pursuant to MPEP § 2666.40, "[a]fter the owner completes the response, the examiner will wait two months from the date of service of the patent owner's completion of the response, and then take up the case for action, since the 30 days for the third party requester comments on the response as completed will have expired by that time. The third party requester may file comments on the response as completed ...The response as completed is treated as a new response on-the-merits to the Office action; thus, the third party requester is entitled to file comments and has 30 days to do so." Based on the above, at the time the **37 CFR 1.183 petition is granted, the patent owner response becomes complete** with its content being set in place, and **the requester has 30 days from the date of the decision granting the 37 CFR 1.183 petition to file a comment paper pursuant to 37 CFR 1.947.**

When the requester takes issue with the page length of the patent owner's response and there [sic] the patent owner has not filed a petition requesting waiver of the page length requirement,

the requester may file a petition to strike under 37 CFR 1.182 (with the appropriate fee) along with its comments on patent owner's response (which must be filed within 30 days from the date of service of the response). The 37 CFR 1.182 petition may request that (A) if the patent owner response is struck, then the accompanying comments should not be entered, and the requester's comment period be re-set to run 30 days from the date of service of a corrected patent owner response, and (B) if the petition to strike is denied/dismissed, then the comments accompanying the petition should be entered and that 37 CFR 1.943(b) be waived to the extent that entry of the accompanying comment paper is permitted.

DECISION ON PETITION UNDER 37 CFR 1.181

I. Requester's Petition for Reconsideration

Requester urges that the following point be reviewed:

Did the Office err by considering requester's February 11, 2011 comments submission to be untimely and dismissing the February 11, 2011 requester petition?

II. Findings and Analysis

A. The May 5, 2011 Decision Properly Determined that the Requester's February 11, 2011 Comments Submission Was Untimely

To support its arguments that its February 11, 2011 comments submission was timely, petitioner requester relies on the special circumstance provided for in MPEP 2666.05(I). However, the requester has misread this section of the MPEP. As discussed in MPEP 2666.05(I), the special circumstance occurs when a patent owner files a response to an Office action that exceeds the page length set by 37 CFR 1.943(b) and the response is accompanied by a petition under 37 CFR 1.183 requesting waiver of the 37 CFR 1.943(b) requirement. MPEP 2666.05(I) clearly states that "[u]ntil such a 37 CFR 1.183 petition to waive the page length is granted, or a page length compliant response is filed (if the 37 CFR 1.183 petition is not granted), the patent owner response is incomplete." Such accounts for the fact that requester obtains 30 days from the date of an Office decision granting page length waiver. In this instance, the November 2, 2010 patent owner response was complete. The January 12, 2011 Office decision **did not grant** the relief requested in the patent owner's November 2, 2010 petition for page limit waiver. Instead, the January 12, 2011 decision dismissed the patent owner's petition as moot, since the November 2, 2010 patent owner response was determined to be page length compliant; *i.e.*, the effective length of the patent owner response was within the 50 page limit required under 37 CFR 1.943(b). The special circumstance discussed in the MPEP does not cover the situation where the patent owner response, as filed, is page length compliant; the special circumstance only covers the situation when the patent owner response filed exceeds the page limit set forth in 37 CFR 1.943(b).

The statute provides that comments may be filed by the requester within a period of 30 days from the date of service of the patent owner's response on the requester. See 35 U.S.C. § 314(b)(2). If the patent owner response is proper (*i.e.*, the response is compliant with the requirements for a patent owner response in an *inter partes* reexamination), it is a response that

triggers the statutory 30 day period for submission of comments to run from the date of service of the patent owner response. Since the patent owner response was found to be complete, requester's comments were due within 30 days from the date of service of the patent owner's compliant response. The date of November 2, 2010 is the date of service of the patent owner's response as shown in the patent owner's certificate of service accompanying the patent owner response.

The requester's argument as to the special circumstance provided for in MPEP 2666.05(I)¹ is not persuasive as the patent owner's response is compliant as filed. To the extent that requester might have desired to contest the propriety of the January 12, 2011 Office decision finding the patent owner's November 2, 2010 response to be page length compliant, 37 CFR 1.181(f) requires that such petition be filed within two months of the mailing of the decision, and the 37 CFR 1.181(f) requirement is especially critical in reexamination, where the statute mandates that proceedings must be conducted by the Office with special dispatch (see 35 U.S.C. § 314(c)). Requester, however, to date has not filed such a petition. Given that the patent owner response was found to be page length compliant and requester did not timely contest that finding, requester's comments were due within the statutory 30 days from the date of service of the response.

Requester had no right to rely on the patent owner's assertion in the November 2, 2010 patent owner petition that the response exceeds the page length under 37 CFR 1.943(b). Although patent owner's response may have appeared to exceed the 50 page regulatory length by a party, the question of page length is decided by the Office.² And, the January 12, 2011 decision determined that patent owner's response was effectively 29 pages in length.³

Requester assumed the risk that patent owner's November 2, 2010 response would not be found to comply with the requirement of 37 CFR 1.943(b) and, thus, failed to timely file its comments. Requester did not file its comments and petition for waiver of the page limit requirement for its comments until 30 days after the mailing of the January 12, 2011 Office decision. The Office cannot now waive the statutory time period when the patent owner response, as filed, was found to be page length compliant - the Office may only waive a regulatory requirement which is not a requirement of the statute (see 37 CFR 1.183). Since the requirement for submission of the comments within 30 days of service of patent owner's compliant response is statutory (see 35 U.S.C. 315(b)(2)) the requested relief is not available.

To further highlight that requester's comments are due 30 days from the date of service of patent owner response and that requester should not wait to file its comments because it believes the patent owner response to be noncompliant, requester is directed to another section of MPEP 2666.05(I), which specifically discusses the situation where a requester has issue with the length

¹ Petition for reconsideration at pages 8-9.

² The guidelines for determining the page length of a response is set forth in MPEP 2667 and 37 CFR 1.943(b). 37 CFR 1.943(b) states that the page length of a response does not include amendments, appendices of claims and reference materials. Furthermore, MPEP 2667(I), reproduced above, explains the criteria in determining what portions of an affidavit or declaration, and any attached exhibits are counted toward the page limit. Although a response may facially exceed 50 pages, the response may comply with the 50-page limit set forth in 37 CFR 1.943(b) that does not include certain documents toward the page count.

³ See the January 12, 2011 Office decision at page 3.

of patent owner's response and patent owner has not filed a petition requesting waiver of the page length requirement. That section of the MPEP advises that "the requester may file a petition to strike under 37 CFR 1.182 (with the appropriate fee) along with its comments on patent owner's response (which must be filed within 30 days from the date of service of the response." The section therein also states the following:

The 37 CFR 1.182 petition may request that (A) if the patent owner response is struck, then the accompanying comments should not be entered, and the requester's comment period be re-set to run 30 days from the date of service of a corrected patent owner response, and (B) if the petition to strike is denied/dismissed, then the comments accompanying the petition should be entered and that 37 CFR 1.943(b) be waived to the extent that entry of the accompanying comment paper is permitted.

This guidance set forth in the MPEP is provided to ensure that the requester's comments are timely filed, in the event that the patent owner's response is found to be page length compliant. This situation discussed in the MPEP illustrates the point that requester should not wait for a decision on a petition regarding the propriety of a patent owner's response before filing its comments submission that is due 30 days from the date of service of a compliant patent owner response. In an instance where the response is proper and requester fails to timely file its comments within 30 days of the service of the patent owner response, entry of the comments is statutorily barred. That is what happened in this proceeding, where the November 2, 2010 patent owner response was found to be length-compliant.

It is noted that requester has attached Exhibit 3, which is a copy of its February 11, 2011 comments submission, to the present petition for reconsideration. The original February 11, 2011 comments are untimely filed for the reasons discussed above and in the May 5, 2011 decision. Accordingly, the copy of the February 11, 2011 comments submission attached to the present petition will not be considered by the examiner.

B. The May 5, 2011 Decision Properly Dismissed the Requester's February 11, 2011 Petition

The merits of the requester's February 11, 2011 petition under 37 CFR 1.183 are not being addressed, because, based on the record of the instant proceeding, requester's comments submission of February 11, 2011 was untimely filed, as discussed above.

Thus, even if the present petition would be found to present a favorable showing for waiver of 37 CFR 1.943(b) to permit extra pages for requester's February 11, 2011 comments submission, requester's comments submission would still not be considered, because it was not timely filed.

Therefore, it has not been shown that extraordinary circumstances exist justifying entry of requester's February 11, 2011 comments submission in excess of the regulatory page limit.

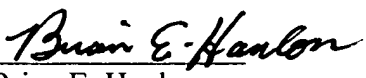
For all the reasons noted above, the requester's petition for reconsideration under 37 CFR 1.181 is denied.

CONCLUSION

1. Requester's present petition for reconsideration is granted to the extent that the prior decision has been reconsidered, but it is denied as to the underlying relief requested.
2. This decision is designated as a final agency action under 5 U.S.C. § 704.
3. The proceeding is being referred to the CRU for issuance of an Office action addressing solely the patent owner's November 2, 2010 response.
4. Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop
Commissioner for Patents
Post Office Box 1450
Alexandria, VA 22313-1450

5. Any questions concerning this communication should be directed to Susy Tsang-Foster, Legal Advisor, at (571) 272-7711 or, in her absence, to Kenneth M. Schor, Senior Legal Advisor at (571) 272-7710.


Brian E. Hanlon
Director
Office of Patent Legal Administration

9-13-11
Kenpet8/IP/...



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,284	12/18/2009	7009655	169AA-000400US	1850
83275	7590	04/01/2011	EXAMINER	
AMPACC Law Group, PLLC 6100 219th Street SW, Suite 580 Mountlake Terrace, WA 98043			ART UNIT	PAPER NUMBER

DATE MAILED: 04/01/2011

Please find below and/or attached an Office communication concerning this application or proceeding.



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
NOVAK DRUCE & QUIGG, LLP
(NDQ REEXAMINATION GROUP)
1000 LOUISIANA STREET, FIFTY-THIRD FLOOR
HOUSTON, TX 77002

Date:

MAILED

APR 01 2011

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001284
PATENT NO. : 7009655
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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AMPACC Law Group, PLLC
6100 219th Street SW, Suite 580
Mountlake Terrace WA 98043

(For Patent Owner) **MAILED**

APR 01 2011

NOVAK DRUCE & QUIGG, LLP
(NDQ REEXAMINATION GROUP)
1000 LOUISIANA STREET
FIFTY-THIRD FLOOR
HOUSTON, TX 77002

(For Requester) **CENTRAL REEXAMINATION UNIT**

In re: Huang
Reexamination Proceeding
Control No. 95/001,284
Request Deposited: December 18, 2009
For: U.S. Patent No. 7,009,655

DECISION

This is a decision on the December 7, 2010 patent owner paper entitled "PETITION TO NOT ENTER CLAIM AMENDMENT UNDER 37 C.F.R. §1.182" and the December 9, 2010 patent owner paper entitled "PETITION PURSUANT TO 37 C.F.R. §1.182 TO NOT ENTER THE CLAIM AMENDMENT PROPOSED IN PATENT OWNER'S RESPONSIVE COMMENTS SUBMITTED ON JULY 16, 2010."

After ACP, the patent owner submitted a response including a proposed amendment to the claims. The examiner did not enter the amendment in the RAN issued on February 14, 2011. Therefore, patent owner's request to not enter their proposed amendment is **dismissed as moot**.


CONCLUSION

1. Petitioner's request to not enter their amendment is **dismissed as moot**.

Art Unit: 3992

2. Inquiries regarding this decision may be directed to Eric Keasel, Supervisory Patent Examiner, at (571) 272-4929.

3. This decision is not a final agency decision and is without prejudice to request reconsideration or higher-level review.

A handwritten signature in cursive script, reading "Eric Keasel", written over a horizontal line.

Eric Keasel

SPE, AU 3992, Central Reexamination Unit



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,285	12/18/2009	7057083	007408.00062	2089
23455	7590	02/22/2012	EXAMINER	
EXXONMOBIL CHEMICAL COMPANY 5200 BAYWAY DRIVE P.O. BOX 2149 BAYTOWN, TX 77522-2149			ART UNIT	PAPER NUMBER

DATE MAILED: 02/22/2012

Please find below and/or attached an Office communication concerning this application or proceeding.



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Joseph M. Skerpon
BANNER & WITCOFF, LTD.
1100 13th Street, NW, Suite 1200
Washington, DC 20005-4051

Date:

MAILED

FEB 22 2012

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001285

PATENT NO. : 7057083

TECHNOLOGY CENTER : 3999

ART UNIT : 3991

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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CENTRAL REEXAMINATION UNIT

EXXONMOBIL CHEMICAL COMPANY
5200 Bayway Drive
P.O. Box 2149
Baytown, TX 77522-2149

For Patent Owner

Joseph M. Skerpon
Banner & Witcoff, LTD
1100 13th Street, NW, Suite 1200
Washington, DC 20005-4051

For Requester

Ex Parte Reexamination Proceeding
Control No. 95/001,285
Filed: December 18, 2009
For: US Patent No. 7,057,083

DECISION ON PETITION

This is a decision on the petition filed May 27, 2010 to request reconsideration of the petition decision of May 10, 2010 and to re-mail the Office action of March 3, 2010.

The petition is before the Assistant Deputy Commissioner for Patent Operations, who is acting in a capacity to oversee the Central Reexamination Unit, for decision.

The petition is dismissed for the reasons set forth below.

Review of Salient Facts

1. A request for reexamination of USPN 7,057,083 was deposited on December 18, 2009 and assigned Control Number 95/001,285.
2. On March 3, 2009, an order granting reexamination was mailed accompanied by a non-final Office action.
3. On April 28, 2010, a petition under 37 CFR 1.181 to restart the period for response to the Office action dated March 3, 2010 was filed. A petition for an extension of time was concurrently filed.
4. On May 10, 2010, both the petition under 37 CFR 1.181 and the request for an extension of time were dismissed.
5. On May 27, 2010, the present petition under 37 CFR 1.181 requesting review of the petition decision of May 10, 2010 was submitted.
6. On June 11, 2010, a response to the outstanding Office action was submitted.
7. On July 14, 2010, third party requester submitted a response.
8. On July 22, 2010, a decision *sua sponte* granting the request for an extension of time was issued.

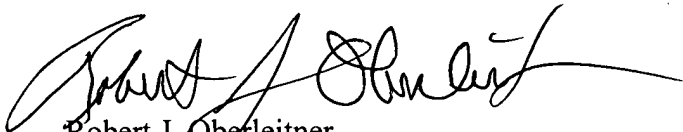
Decision

A review of the record reveals that the decision mailed July 22, 2010 granting a two-month extension of time provided the necessary time for Patent Owner to reply to the outstanding Office action. The decision clearly states the response filed by Patent Owner on June 11, 2010 and June 15, 2010 as well as the response and comments filed by requester on July 15, 2010 are timely and are entered. In light of the relief provided in the petition decision of July 22, 2010 the request to reconsider the petition decision of May 10, 2010 and to re-mail the Office action of March 3, 2010 is dismissed as moot.

Conclusion

1. The Patent Owner's petition to re-mail the Office action of March 3, 2009 and restart the period for response is **dismissed as moot** for the reasons set forth above.
2. The responses filed by Patent Owner on June 11, 2010 and June 15, 2010 are timely and are entered. The comments filed by requester on July 14, 2010 are also timely and are entered.

3. The proceeding has been forwarded to the examiner for further action.
4. Telephone inquiries with regard to this decision should be directed to Deborah Jones, Supervisory Patent Examiner, Art Unit 3991 in the Central Reexamination Unit.

A handwritten signature in black ink, appearing to read "Robert J. Oberleitner", with a long horizontal flourish extending to the right.

Robert J. Oberleitner,
Assistant Deputy Commissioner for Patent Operations and
Acting Director,
Central Reexamination Unit



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OBLON, SPIVAK, MCCLELLAND, MAIER
& NEUSTADT, L.L.P.
1940 DUKE STREET
ALEXANDRIA, VA 22314

MAILED (For Patent Owner)

DEC 01 2010

CENTRAL REEXAMINATION UNIT

(For Third Party Requester)

NOVAK DRUCE & QUIGG LLP
NDQ REEXAMINATION GROUP
1000 LOUISIANA STREET
FIFTY-THIRD FLOOR
HOUSTON, TX 77002

Inter Partes Reexamination Proceeding
Control No.: 95/001,286
Filed: December 21, 2009
For: U.S. Patent No. 7,441,196

:
: **DECISION**
: **DISMISSING**
: **PETITIONS**
:

This is a decision on patent owner's "PETITION FOR INTERVIEW UNDER 37 C.F.R. § 1.183," filed on August 30, 2010 and on patent owner's concurrently-filed "PETITION UNDER 37 C.F.R. § 1.182 FOR TRANSFER OF JURISDICTION TO THE OFFICE OF PATENT LEGAL ADMINISTRATION."

The patent owner petitions are before the Office of Patent Legal Administration.

The petition fee of \$400 pursuant to 37 CFR 1.17(f) for the petition under 37 CFR 1.183 was processed on August 31, 2010. The petition fee of \$400 pursuant to 37 CFR 1.17(f) for the petition under 37 CFR 1.182 was also processed on August 31, 2010.

The petitions are both dismissed for the reasons set forth herein.

BACKGROUND

1. On October 21, 2008, U.S. Patent No. 7,441,196 ("the '196 patent") issued to Gottfurcht *et al.*
2. On December 21, 2009, a request for *inter partes* reexamination was filed by a third party requester, which request was assigned control no. 95/001,286 ("the '1286 proceeding").
3. On February 2, 2010, the Office issued an order granting *inter partes* reexamination in the '1286 proceeding, with an accompanying Office action on the merits.
4. On April 12, 2010, patent owner filed a timely response to February 2, 2010 Office action.
5. On May 12, 2010, third party requester filed comments after patent owner's April 12, 2010 response.

6. On July 29, 2010, the Office mailed an Action Closing Prosecution (ACP).
7. On August 12, 2010, third party requester filed a paper entitled "THIRD PARTY REQUESTER NOTICE OF NON-PARTICIPATION; NOTICE OF LITIGATION SETTLEMENT" in the '1286 proceeding.
8. On August 30, 2010, patent owner filed a 37 CFR 1.951(a) comments submission after the July 29, 2010 ACP ("the § 1.951(a) submission.")
9. Concurrently, on August 30, 2010, patent owner filed the instant petition paper entitled "PETITION FOR INTERVIEW UNDER 37 C.F.R. § 1.183" ("the petition under 37 CFR 1.183"), concurrently with the instant "PETITION UNDER 37 C.F.R. § 1.182 FOR TRANSFER OF JURISDICTION TO THE OFFICE OF PATENT LEGAL ADMINISTRATION" ("the petition under 37 CFR 1.182").

DECISION

Relevant Statutes, Regulations and Practice

35 U.S.C. § 314 provides, in part:

(a) IN GENERAL.— Except as otherwise provided in this section, reexamination shall be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133. In any *inter partes* reexamination proceeding under this chapter, the patent owner shall be permitted to propose any amendment to the patent and a new claim or claims, except that no proposed amended or new claim enlarging the scope of the claims of the patent shall be permitted.

(c) SPECIAL DISPATCH.— Unless otherwise provided by the Director for good cause, all *inter partes* reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, shall be conducted with special dispatch within the Office.

37 CFR 1.955 provides:

There will be no interviews in an *inter partes* reexamination proceeding which discuss the merits of the proceeding.

Patent Owner's Petition under 37 CFR 1.183

The instant petition under 37 CFR 1.183 has been fully considered. In the instant petition, petitioner patent owner requests waiver of 37 CFR 1.955, which prohibits interviews in *inter partes* reexamination. In particular, petitioner requests that it be granted an examiner interview in the '1286 proceeding and asserts that such interview "will advance prosecution by providing an opportunity to exchange understandings with the examiner, in person, to resolve differences

in claim construction relative to the fair teachings of the prior art raised in the prosecution to date.”¹

37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party. The burden is on petitioner to set forth with specificity the facts that give rise to an extraordinary situation in which justice requires suspension of a rule. In support of its request for waiver of 37 CFR 1.955, petitioner asserts that: (1) third party requester has withdrawn from this *inter partes* reexamination of the '196 patent, (2) an interview would serve the interests of *special dispatch* by providing an opportunity to more quickly advance the proceeding to termination, and (3) an interview would allow the examiner and patent owner an opportunity to efficiently resolve their remaining differences via an in-person interview.²

In this instance, third party requester has stated on the record that it will not further participate in the '1286 *inter partes* reexamination proceeding.³ Thus, only a single party (patent owner) will now participate in the '1286 proceeding, and any interview that might be permitted in the proceeding. However, patent owner has not focused upon specific matters at issue in the proceeding to be discussed at the interview. As pointed out above, patent owner asserts that such interview “will advance prosecution by providing an opportunity to exchange understandings with the examiner, in person, to resolve differences in claim construction relative to the fair teachings of the prior art raised in the prosecution to date.” This, however, is a generic statement that does not focus on specific claim construction issues to be addressed at the interview, or any other specific issue. It merely indicates a basic desire to come to some understanding on claim construction that will make the claims patentable.

Should patent owner correct the matter identified immediately above, it may be found that permitting a single interview to be conducted at this point in the '1286 proceeding may well assist the Office in expeditiously resolving the proceeding.⁴ If patent owner chooses to present a petition to address the above-identified matter, patent owner is to immediately renew it, given the Office’s statutory requirement (35 U.S.C. § 314(c)) to conduct reexaminations with special dispatch. No fee would be required upon submission of any such renewed petition.

Patent Owner’s Petition under 37 CFR 1.182

Concurrently with the petition under 37 CFR 1.183, patent owner filed the instant petition under 37 CFR 1.182, requesting “that OPLA take jurisdiction of this proceeding prior to the CRU issuing a responsive communication to the Patent Holder’s August 30, 2010 response” and “that

¹ Petition under 37 CFR 1.183, at page 1.

² See *id.* at page 3.

³ See August 12, 2010 “THIRD PARTY REQUESTER NOTICE OF NON-PARTICIPATION; NOTICE OF LITIGATION SETTLEMENT” (stating that: “Third Party Requester has entered into a settlement agreement with Patent Owner and as such withdraws from continued active participation in the on-going above reexamination,” “Third Party Requester will make no further comment in or otherwise actively participate in the *inter partes* reexamination,” and “Third Party Requester, consistent with the above, requests to be excluded from further proceedings in the *inter partes* reexamination to the fullest extent allowed under the Patent Laws, Rules and operating procedures of the Patent Office.”)

⁴ The '1286 proceeding is ready for examiner action following patent owner’s August 30, 2010 § 1.951(a) submission.


OPLA retain such jurisdiction until the Director issues a decision on the petition seeking an in-person interview.”⁵ In this instance, the petition under 37 CFR 1.182 is limited to requesting that the Office of Patent Legal Administration (OPLA) take control of the present proceeding to prevent the Central Reexamination Unit (CRU) from taking any further action until OPLA decides the petition under 37 CFR 1.183. This is essentially a request to delay prosecution in this proceeding. Such a petition is contrary to the statutory mandate that *inter partes* reexamination proceedings be conducted with special dispatch in the Office (35 U.S.C. § 314(c)). Accordingly, the petition is dismissed. Any future petitions to this effect will likewise be summarily dismissed as being in conflict with the statute.⁶

In addition to the above, petitioner’s request that “OPLA retain such jurisdiction until the Director issues a decision on the petition seeking an in-person interview” is moot, because “a decision on the petition seeking an in-person interview” has now been rendered.

For all of the foregoing reasons, the petition under 37 CFR 1.182 is dismissed.

CONCLUSION

1. Patent owner’s August 30, 2010 petition under 37 CFR 1.183 to waive the provisions of 37 CFR 1.955 is dismissed.
2. Patent owner’s concurrently filed petition under 37 CFR 1.182 to transfer jurisdiction to OPLA is dismissed.
3. Any questions concerning this communication should be directed to Nicole Dretar, Legal Advisor, Office of Patent Legal Administration, at (571) 272-7717.



Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

11-15-2010
KenInterview/
Jurisdiction.../

⁵ Petition under 37 CFR 1.182, at page 3.

⁶ To the extent petitioner is relying on MPEP § 2686.04(III) as a basis for submitting the instant petition under 37 CFR 1.182 for OPLA to take jurisdiction of the proceeding, this reliance is misplaced as that section is directed to the situation where such petition is accompanied by a petition to suspend a reexamination proceeding. A petition to suspend a reexamination proceeding is a request for an extreme remedy, which request for suspension must be supported by a showing of “good cause.”



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,286	12/21/2009	Elliot 7441196	8157.018.196	4412
22850	7590	02/17/2011	EXAMINER	
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P. 1940 DUKE STREET ALEXANDRIA, VA 22314			ART UNIT	PAPER NUMBER

DATE MAILED: 02/17/2011

Please find below and/or attached an Office communication concerning this application or proceeding.



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Date: 2-17-11

Tracy W. Druce
NOVAK DRUCE & QUIGG, LLP
1000 Louisiana Street, 53rd Floor
Houston, TX 77002

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001286
PATENT NO. : 7441196
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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OBLON, SPIVAK, MCCLELLAND, MAIER
& NEUSTADT, L.L.P.
1940 DUKE STREET
ALEXANDRIA, VA 22314

MAILED

FEB 17 2011

CENTRAL REEXAMINATION UNIT

(For Patent Owner)

NOVAK DRUCE & QUIGG LLP
NDQ REEXAMINATION GROUP
1000 LOUISIANA STREET
FIFTY-THIRD FLOOR
HOUSTON, TX 77002

(For Third Party Requester)

Inter Partes Reexamination Proceeding
Control No.: 95/001,286
Filed: December 21, 2009
For: U.S. Patent No. 7,441,196

: **DECISION GRANTING**
: **RENEWED PETITION FOR**
: **WAIVER OF 37 CFR 1.955**
: **FOR ONE-TIME INTERVIEW**

This is a decision on patent owner's "RENEWED PETITION FOR INTERVIEW UNDER 37 C.F.R. § 1.183," filed on December 17, 2010.

The patent owner petition is before the Office of Patent Legal Administration.

The petition is granted to the extent set forth herein.

BACKGROUND

1. On October 21, 2008, U.S. Patent No. 7,441,196 ("the '196 patent") issued to Gottfurcht *et al.*
2. On December 21, 2009, a request for *inter partes* reexamination was filed by a third party requester, which request was assigned control no. 95/001,286 ("the '1286 proceeding").
3. On February 2, 2010, the Office issued an order granting *inter partes* reexamination in the '1286 proceeding, with an accompanying Office action on the merits.
4. On April 12, 2010, patent owner filed a timely response to February 2, 2010 Office action.
5. On May 12, 2010, third party requester filed comments after patent owner's April 12, 2010 response.
6. On July 29, 2010, the Office mailed an Action Closing Prosecution (ACP).

7. On August 12, 2010, third party requester filed a paper entitled "THIRD PARTY REQUESTER NOTICE OF NON-PARTICIPATION; NOTICE OF LITIGATION SETTLEMENT" in the '1286 proceeding.
8. On August 30, 2010, patent owner filed a 37 CFR 1.951(a) comments submission after the July 29, 2010 ACP ("the § 1.951(a) submission").
9. Concurrently, on August 30, 2010, patent owner filed a petition paper entitled "PETITION FOR INTERVIEW UNDER 37 C.F.R. § 1.183" ("the petition under 37 CFR 1.183"), as well as a "PETITION UNDER 37 C.F.R. § 1.182 FOR TRANSFER OF JURISDICTION TO THE OFFICE OF PATENT LEGAL ADMINISTRATION" ("the petition under 37 CFR 1.182").
10. On December 1, 2010 the Office mailed a decision dismissing patent owner's August 30, 2010 petitions under 37 CFR 1.183 and 37 CFR 1.182.
11. On December 17, 2010 patent owner filed the instant petition paper entitled "RENEWED PETITION FOR INTERVIEW UNDER 37.C.F.R. § 1.183" ("the renewed petition under 37 CFR 1.183").

DECISION

Patent Owner's Renewed Petition under 37 CFR 1.183

In the December 1, 2010 decision, the Office dismissed patent owner's August 30, 2010 request for a one-time interview in the '1286 proceeding, stating that "patent owner has not focused upon specific matters at issue in the proceeding to be discussed at the interview."¹ In the instant renewed petition under 37 CFR 1.183, requesting waiver of 37 CFR 1.955 for a one-time interview in the '1286 proceeding, petitioner identified specific matters at issue in the proceeding to be discussed at the interview. For example, petitioner asserts that "[a]t issue in the reexamination proceedings are several disputes as to the meaning of certain claim terms, such as (1) a 'simplified navigation interface'; (2) 'displaying the on-line content concurrently with one or more advertisements'; and (3) a 'second advertisement not displayed in a cell or matrix' (Claims 1, 9, 12, 14, 25, 28, 30, 43, 58, and 63)."² Further, petitioner asserts that the references relied upon to teach the "displaying on-line content concurrent with one or more advertisements" feature "have been explained as providing only a transformation of HTML content," and that "Patent Holder would like to conduct an interview to explain the meaning of these terms in view of the specification, and to correct the examiner's understanding of such terms as 'advertisement' and 'online' relative to asserted prior art Reformulating HTML and the CSS2 Specification."³

¹ December 1, 2010 decision at page 3.

² December 17, 2010 renewed petition under 37 CFR 1.183 at page 3.

³ *Id.*

In this instance, the third party requester has stated on the record that it will not further participate in the '1286 *inter partes* reexamination proceeding.⁴ Thus, only a single party (patent owner) will now participate in the '1286 proceeding, and any interview that might be permitted in the proceeding. Additionally, patent owner has focused upon specific matters at issue in the proceeding to be discussed at the interview, pointing to particular features to be discussed with respect to the meaning of certain claim terms in view of the specification and relative to the asserted prior art. Based on the present facts and circumstances, it is found that permitting a single interview to be conducted at this point in the '1286 *inter partes* proceeding is not anticipated to potentially hinder the ability of the Office to conduct the '1286 proceeding with special dispatch, but rather may well assist the Office in expeditiously resolving the proceeding.⁵

Accordingly, in view of the particular facts and circumstances set forth herein, in this instance and at this point, the record in the '1286 proceeding is deemed to present an extraordinary situation which justifies waiver of 37 CFR 1.955 to further the interests of the patent owner, members of the public who may be interested in the outcome of the proceeding, and the Office. Thus, patent owner's petition under 37 CFR 1.183 is granted to the extent that 37 CFR 1.955 is waived such that a single interview will be permitted, subject to the examiner's approval.

There are no established regulatory or practice guidelines to govern the manner in which an interview in an *inter partes* reexamination proceeding is to be conducted. Therefore, the waiver of 37 CFR 1.955 so as to permit an interview is granted only to the extent that patent owner satisfies the following preliminary requirements.

Requirements and Guidelines for Conducting Interview

A. Preliminary Requirements

1. Promptly, upon receipt of the present decision, patent owner must contact the examiner in charge of the proceeding to identify the issues that are sought to be discussed, to determine if an interview will be granted with respect to those issues (which determination the examiner is directed to make based on criteria analogous to that of granting *ex parte* reexamination interviews), and to ascertain the examiner's desktop facsimile number.
2. At least three (3) working days prior to the interview, patent owner must file an informal written statement of the issues to be discussed at the interview, and an informal copy of any proposed claims to be discussed, unless the examiner waives this requirement. The copy of these materials is to be submitted by facsimile transmission (FAX) directly to the examiner, or to be hand-carried to the examiner, so as to avoid the possibility of delay in matching the materials with the file. The informal copies that are considered by the examiner will be made of record in the reexamination proceeding – as an attachment to an Interview Summary form PTOL-474 (modified as needed for *inter partes* reexamination) to be completed by the examiner after the interview.

⁴ See August 12, 2010 "THIRD PARTY REQUESTER NOTICE OF NON-PARTICIPATION; NOTICE OF LITIGATION SETTLEMENT."

⁵ The '1286 proceeding is ready for examiner action following the August 30, 2010 patent owner 37 CFR 1.951(a) comments submission, responsive to the July 29, 2010 ACP.

3. Patent owner must serve a copy of the papers discussed in item (2) above on the third party requester in accordance with 37 CFR 1.903, and include a copy of the certificate of service of such papers in the papers as filed in item (2) above.

B. Guidelines for Conducting the Interview

1. The interview must be conducted in the Office at such times, within Office hours as examiner may designate. The interview will not be permitted at any other time or place, without the authority of the Director.
2. Patent owner must make every effort to conduct the interview in not more than one (1) hour. Patent owner may, however, show cause, at the interview, why more time is needed, and the examiner is also free to extend the interview, at the examiner's sole discretion.
3. The interview should be attended by the conferees who signed the July 29, 2010 ACP, or their substitutes if the conferees are not reasonably available.
4. At the conclusion of the interview, the examiner will prepare an interview summary, using form PTOL-474, the *Ex Parte* Interview Summary Form, and making appropriate modifications thereto, taking into account that the present proceeding is an *inter partes* reexamination proceeding. A copy of the interview summary form is to be given to patent owner at the conclusion of the interview. A copy of the interview summary form will also be mailed to third party requester, and the original of the form is to be made of record in the Image File Wrapper for the proceeding.

C. Prosecution after the Interview

1. Patent owner must file a complete written statement of the reasons presented at the interview as warranting favorable action, to avoid termination or limitation of the proceeding as appropriate under 37 CFR 1.957. The written statement must be filed as a separate paper filed within one month from the date of the interview or with the response to the outstanding Office action (whichever is later).
2. All papers filed by patent owner in the '1286 *inter partes* reexamination proceeding must continue to be served in accordance with 37 CFR 1.903, and service must be reflected by attaching a certificate of service, or consideration of the document may be refused.

CONCLUSION

1. Patent owner's December 17, 2010 renewed petition under 37 CFR 1.183 is granted to waive the provisions of 37 CFR 1.955, to the extent that a single interview will be permitted, upon approval by the examiner and compliance with the Preliminary Requirements, as set forth above.

2. The provisions of 37 CFR 1.955 are waived solely on the present facts and circumstances, and solely for the purposes of conducting one interview with respect to the July 29, 2010 ACP and the August 30, 2010 patent owner 37 CFR 1.951(a) comments submission.
3. Any future petition for waiver of 37 CFR 1.955 will not be granted absent a further strong showing of necessity, including an explanation of why the basis for any further interview could not have been addressed in the first interview.
4. Any questions concerning this communication should be directed to Nicole Dretar Haines, Legal Advisor, Office of Patent Legal Administration, at (571) 272-7717.



Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

02-15-11



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,287	12/21/2009	7020845	8157.018.845	4456
22850	7590	12/01/2010	EXAMINER	
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P. 1940 DUKE STREET ALEXANDRIA, VA 22314			ART UNIT	PAPER NUMBER

DATE MAILED: 12/01/2010

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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/001,287	12/21/09	7020845	81573018.845

NOVAK DRUCE & QUIGG, LLP
(NDQ REEXAMINATION GROUP)
1000 LOUISIANA STREET, FIFTY-THIRD FLOOR
HOUSTON, TX 77002

EXAMINER
NALVEN, ANDREW L.

ART UNIT	PAPER
3992	

DATE MAILED:
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DEC 01 2010

**INTER PARTES REEXAMINATION
COMMUNICATION**

CENTRAL REEXAMINATION UNIT

BELOW/ATTACHED YOU WILL FIND A COMMUNICATION FROM THE UNITED STATES PATENT AND TRADEMARK OFFICE OFFICIAL(S) IN CHARGE OF THE PRESENT REEXAMINATION PROCEEDING.

All correspondence relating to this *inter partes* reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of this communication.



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OBLON, SPIVAK, MCCLELLAND, MAIER
& NEUSTADT, L.L.P.
1940 DUKE STREET
ALEXANDRIA, VA 22314

(For Patent Owner)

NOVAK DRUCE & QUIGG LLP
NDQ REEXAMINATION GROUP
1000 LOUISIANA STREET
FIFTY-THIRD FLOOR
HOUSTON, TX 77002

(For Third Party Requester)

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DEC 01 2010

CENTRAL REEXAMINATION UNIT

Inter Partes Reexamination Proceeding
Control No.: 95/001,287
Filed: December 21, 2009
For: U.S. Patent No. 7,020,845

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**DECISION
DISMISSING
PETITIONS**

This is a decision on patent owner's "PETITION FOR INTERVIEW UNDER 37 C.F.R. § 1.183," filed on August 30, 2010 and on patent owner's concurrently-filed "PETITION UNDER 37 C.F.R. § 1.182 FOR TRANSFER OF JURISDICTION TO THE OFFICE OF PATENT LEGAL ADMINISTRATION."

The patent owner petitions are before the Office of Patent Legal Administration.

The petition fee of \$400 pursuant to 37 CFR 1.17(f) for the petition under 37 CFR 1.183 was processed on August 31, 2010. The petition fee of \$400 pursuant to 37 CFR 1.17(f) for the petition under 37 CFR 1.182 was also processed on August 31, 2010.

The petitions are both dismissed for the reasons set forth herein.

BACKGROUND

1. On March 28, 2006, U.S. Patent No. 7,020,845 ("the '845 patent") issued to Gottfurcht *et al.*
2. On December 21, 2009, a request for *inter partes* reexamination was filed by a third party requester, which request was assigned control no. 95/001,287 ("the '1287 proceeding").
3. On February 2, 2010, the Office issued an order granting *inter partes* reexamination in the '1287 proceeding, with an accompanying Office action on the merits.
4. On April 12, 2010, patent owner filed a timely response to February 2, 2010 Office action.
5. On May 12, 2010, third party requester filed comments after patent owner's April 12, 2010 response.

6. On July 29, 2010, the Office mailed an Action Closing Prosecution (ACP).
7. On August 12, 2010, third party requester filed a paper entitled "THIRD PARTY REQUESTER NOTICE OF NON-PARTICIPATION; NOTICE OF LITIGATION SETTLEMENT" in the '1287 proceeding.
8. On August 30, 2010, patent owner filed a 37 CFR 1.951(a) comments submission after the July 29, 2010 ACP ("the § 1.951(a) submission.")
9. Concurrently, on August 30, 2010, patent owner filed the instant petition paper entitled "PETITION FOR INTERVIEW UNDER 37 C.F.R. § 1.183" ("the petition under 37 CFR 1.183"), concurrently with the instant "PETITION UNDER 37 C.F.R. § 1.182 FOR TRANSFER OF JURISDICTION TO THE OFFICE OF PATENT LEGAL ADMINISTRATION" ("the petition under 37 CFR 1.182").

DECISION

Relevant Statutes, Regulations and Practice

35 U.S.C. § 314 provides, in part:

(a) IN GENERAL.— Except as otherwise provided in this section, reexamination shall be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133. In any *inter partes* reexamination proceeding under this chapter, the patent owner shall be permitted to propose any amendment to the patent and a new claim or claims, except that no proposed amended or new claim enlarging the scope of the claims of the patent shall be permitted.

(c) SPECIAL DISPATCH.— Unless otherwise provided by the Director for good cause, all *inter partes* reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, shall be conducted with special dispatch within the Office.

37 CFR 1.955 provides:

There will be no interviews in an *inter partes* reexamination proceeding which discuss the merits of the proceeding.

Patent Owner's Petition under 37 CFR 1.183

The instant petition under 37 CFR 1.183 has been fully considered. In the instant petition, petitioner patent owner requests waiver of 37 CFR 1.955, which prohibits interviews in *inter partes* reexamination. In particular, petitioner requests that it be granted an examiner interview in the '1287 proceeding and asserts that such interview "will advance prosecution by providing an opportunity to exchange understandings with the examiner, in person, to resolve differences

in claim construction relative to the fair teachings of the prior art raised in the prosecution to date.”¹

37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party. The burden is on petitioner to set forth with specificity the facts that give rise to an extraordinary situation in which justice requires suspension of a rule. In support of its request for waiver of 37 CFR 1.955, petitioner asserts that: (1) third party requester has withdrawn from this *inter partes* reexamination of the ‘845 patent, (2) an interview would serve the interests of *special dispatch* by providing an opportunity to more quickly advance the proceeding to termination, and (3) an interview would allow the examiner and patent owner an opportunity to efficiently resolve their remaining differences via an in-person interview.²

In this instance, third party requester has stated on the record that it will not further participate in the ‘1287 *inter partes* reexamination proceeding.³ Thus, only a single party (patent owner) will now participate in the ‘1287 proceeding, and any interview that might be permitted in the proceeding. However, patent owner has not focused upon specific matters at issue in the proceeding to be discussed at the interview. As pointed out above, patent owner asserts that such interview “will advance prosecution by providing an opportunity to exchange understandings with the examiner, in person, to resolve differences in claim construction relative to the fair teachings of the prior art raised in the prosecution to date.” This, however, is a generic statement that does not focus on specific claim construction issues to be addressed at the interview, or any other specific issue. It merely indicates a basic desire to come to some understanding on claim construction that will make the claims patentable.

Should patent owner correct the matter identified immediately above, it may be found that permitting a single interview to be conducted at this point in the ‘1287 proceeding may well assist the Office in expeditiously resolving the proceeding.⁴ If patent owner chooses to present a petition to address the above-identified matter, patent owner is to immediately renew it, given the Office’s statutory requirement (35 U.S.C. § 314(c)) to conduct reexaminations with special dispatch. No fee would be required upon submission of any such renewed petition.

Patent Owner’s Petition under 37 CFR 1.182

Concurrently with the petition under 37 CFR 1.183, patent owner filed the instant petition under 37 CFR 1.182, requesting “that OPLA take jurisdiction of this proceeding prior to the CRU issuing a responsive communication to the Patent Holder’s August 30, 2010 response” and “that

¹ Petition under 37 CFR 1.183, at page 1.

² See *id.* at page 3.

³ See August 12, 2010 “THIRD PARTY REQUESTER NOTICE OF NON-PARTICIPATION; NOTICE OF LITIGATION SETTLEMENT” (stating that: “Third Party Requester has entered into a settlement agreement with Patent Owner and as such withdraws from continued active participation in the on-going above reexamination,” “Third Party Requester will make no further comment in or otherwise actively participate in the *inter partes* reexamination,” and “Third Party Requester, consistent with the above, requests to be excluded from further proceedings in the *inter partes* reexamination to the fullest extent allowed under the Patent Laws, Rules and operating procedures of the Patent Office.”)

⁴ The ‘1287 proceeding is ready for examiner action following patent owner’s August 30, 2010 § 1.951(a) submission.

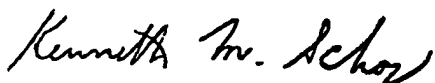
OPLA retain such jurisdiction until the Director issues a decision on the petition seeking an in-person interview.”⁵ In this instance, the petition under 37 CFR 1.182 is limited to requesting that the Office of Patent Legal Administration (OPLA) take control of the present proceeding to prevent the Central Reexamination Unit (CRU) from taking any further action until OPLA decides the petition under 37 CFR 1.183. This is essentially a request to delay prosecution in this proceeding. Such a petition is contrary to the statutory mandate that *inter partes* reexamination proceedings be conducted with special dispatch in the Office (35 U.S.C. § 314(c)). Accordingly, the petition is dismissed. Any future petitions to this effect will likewise be summarily dismissed as being in conflict with the statute.⁶

In addition to the above, petitioner’s request that “OPLA retain such jurisdiction until the Director issues a decision on the petition seeking an in-person interview” is moot, because “a decision on the petition seeking an in-person interview” has now been rendered.

For all of the foregoing reasons, the petition under 37 CFR 1.182 is dismissed.

CONCLUSION

1. Patent owner’s August 30, 2010 petition under 37 CFR 1.183 to waive the provisions of 37 CFR 1.955 is dismissed.
2. Patent owner’s concurrently filed petition under 37 CFR 1.182 to transfer jurisdiction to OPLA is dismissed.
3. Any questions concerning this communication should be directed to Nicole Dretar, Legal Advisor, Office of Patent Legal Administration, at (571) 272-7717.



Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

11-15-2010
KenInterview/
Jurisdiction.../

⁵ Petition under 37 CFR 1.182, at page 3.

⁶ To the extent petitioner is relying on MPEP § 2686.04(III) as a basis for submitting the instant petition under 37 CFR 1.182 for OPLA to take jurisdiction of the proceeding, this reliance is misplaced as that section is directed to the situation where such petition is accompanied by a petition to suspend a reexamination proceeding. A petition to suspend a reexamination proceeding is a request for an extreme remedy, which request for suspension must be supported by a showing of “good cause.”



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,292	12/31/2009	6,654,505 B2	048522-0004	9037
22922	7590	10/12/2010	EXAMINER	
REINHART BOERNER VAN DEUREN S.C. ATTN: LINDA KASULKE, DOCKET COORDINATOR 1000 NORTH WATER STREET SUITE 2100 MILWAUKEE, WI 53202			ART UNIT	PAPER NUMBER

DATE MAILED: 10/12/2010

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Date:

VINSON & ELKINS, L.L.P.

FIRST CITY TOWER

1001 FANNIN STREET, SUITE 2500

HOUSTON, TX 77002-6760

MAILED

OCT 12 2010

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001292

PATENT NO. : 6654505

TECHNOLOGY CENTER : 3999

ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

**Decision on Petition for Extension
of Time in Reexamination**

Control No.: 95/001,292

1. THIS IS A DECISION ON THE PETITION FILED October 5, 2010.

2. THIS DECISION IS ISSUED PURSUANT TO:

- A. ☐ 37 CFR 1.550(c) – The time for taking any action by a patent owner in an *ex parte* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.
- B. ☒ 37 CFR 1.956 – The time for taking any action by a patent owner in an *inter partes* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.

The petition is before the Central Reexamination Unit for consideration.

3. FORMAL MATTERS

Patent owner requests that the period for responding to the Office action mailed on September 20, 2010, which sets a one-month period for filing a response thereto, be extended by two (2) months.

- A. ☒ Petition fee per 37 CFR §1.17(g):
- i. ☒ Petition includes authorization to debit a deposit account.
- ii. ☐ Petition includes authorization to charge a credit card account.
- iii. ☐ Other: _____.
- B. ☒ Proper certificate of service was provided. (Not required in reexamination where patent owner is requester.)
- C. ☒ Petition was timely filed.
- D. ☒ Petition properly signed.

4. DECISION (See MPEP 2265 and 2665)

- A. ☐ Granted or ☐ Granted-in-part for _____, because petitioner provided a factual accounting that established sufficient cause. (See 37 CFR 1.550(c) and 37 CFR 1.956).
- ☐ Other/comment: _____.
- B. ☒ Dismissed because:
- i. ☐ Formal matters (See unchecked box(es) (A, B, C and/or D) in section 4 above).
- ii. ☒ Petitioner failed to provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period.
- iii. ☒ Petitioner failed to explain why, in spite of the action taken thus far, the requested additional time is needed.
- iv. ☐ The statements provided fail to establish sufficient cause to warrant extension of the time for taking action (See attached).
- v. ☐ The petition is moot.
- vi. ☐ Other/comment: _____.

5. CONCLUSION Response to the ACP mailed September 20, 2010 is due on October 20, 2010.

Telephone inquiries with regard to this decision should be directed to Deborah Jones at 571-272-1535. In his/her absence, calls may be directed to _____ in the Central Reexamination Unit.

/Deborah Jones/ SPE, CRU AU 3991

[Signature]

(Title)



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REINHART BOERNER VAN DEUREN S.C.
ATTN: LINDA KASULKE, DOCKET COORDINATOR
1000 NORTH WATER STREET, STE. 2100
MILWAUKEE WI 53202

(For Patent Owner)

(For Requester)

LIFE TECHNOLOGIES CORPORATION
C/O INTELLEVATE
P.O. BOX 52050
MINNEAPOLIS, MN 55402

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DEC 20 2010
OFFICE OF PETITIONS

In re Bridgham et al.	:	
Reexamination Proceeding	:	DECISION ON PETITION
Control Number: 95/001,292	:	
Filed: 12/31/2009	:	
For: U.S. Patent No. 6,654,505	:	
Attorney Docket Number:	:	
048522-0004	:	

This is a decision on the patent owner's petition under 37 C.F.R. § 1.182, filed on October 21, 2010, requesting that a certificate of correction correcting claims of priority be issued in the above-referenced patent which is the subject of the reexamination.

The petition is before the Office of Patent Legal Administration for a decision.

The petition is **dismissed** for the reasons stated.

Petitioner requests that a certificate of correction correcting claims of priority be issued in U.S. Patent No. 6,654,505, of which the subject proceeding is a reexamination.

The petition is dismissed as premature, because if a Reexamination Certificate is issued in the subject reexamination proceeding, it will correct the claims of priority as requested by petitioner. In this regard, it is noted that a Decision Granting Petition Under 37 CFR 1.78(a)(3) was mailed

on June 30, 2010, granting a petition to accept an unintentionally delayed claim of benefit in the subject reexamination proceeding. Accordingly, any Reexamination Certificate issued in the subject re-examination proceeding will correctly state the benefit claims.

The petition is further dismissed as improper, because a request to issue a certificate of correction in U.S. Patent No. 6,654,505 must be filed in that patent, not in the subject reexamination proceeding. In this regard, 37 CFR 1.4(b) states that since each file must be complete in itself, a separate copy of every paper to be filed in a patent, patent file, or other proceeding must be furnished for each file to which the paper pertains. Accordingly, a request for a certificate of correction in the above-referenced patent must be filed under that patent and application number.

Accordingly, the petition is **dismissed**.

Telephone inquiries related to this decision only should be directed to Senior Petitions Attorney Douglas I. Wood at 571-272-3231.

Inquiries regarding petition status or general petition information are handled by the Office of Petitions staff at 571-272-3282.



Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner
For Patent Examination Policy



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,294	04/05/2010	7534584	2781-128	1914
22504	7590	03/14/2011	EXAMINER	
DAVIS WRIGHT TREMAINE, LLP/Seattle 1201 Third Avenue, Suite 2200 SEATTLE, WA 98101-3045			ART UNIT	PAPER NUMBER

DATE MAILED: 03/14/2011

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1425 K STREET, N.W.
SUITE 800
WASHINGTON, DC 20005

Date:

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MAR 14 2011

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001294
PATENT NO. : 7534584
TECHNOLOGY CENTER : 3999
ART UNIT : 3991

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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MAR 14 2011

DAVIS WRIGHT TREMAINE, LLP/Seattle
1201 Third Avenue, Suite 2200
SEATTLE, WA 98101-3045

(For Patent Owner)

CENTRAL REEXAMINATION UNIT

ROTHWELL, FIGG, ERNST & MANBECK, P.C.
1425 K STREET, N.W.
SUITE 800
WASHINGTON, DC 20005

(For Third Party Requester)

Inter Partes Reexamination Proceeding
Control No. 95/001,294
Filed: April 5, 2010
For: U.S. Patent No. 7,534,584

:
: **DECISION**
: **GRANTING**
: **PETITION**

This is a decision on patent owner's petition paper entitled "PETITION FOR SUSPENSION OF RULES UNDER 37 C.F.R. § 1.183," filed on February 16, 2011. The patent owner petition requests waiver of 37 CFR 1.943(b) that patent owner's January 31, 2011 submission not exceed fifty (50) pages in length.

The patent owner petition is before the Office of Patent Legal Administration.

The patent owner's petition under 37 CFR 1.183 is granted to the extent that the page limit for patent owner's comments is extended to not exceed 188 pages in length.

DECISION

I. Relevant Authority

37 CFR 1.183 provides:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be

imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 CFR 1.943(b) provides:

Responses by the patent owner and written comments by the third party requester shall not exceed 50 pages in length, excluding amendments, appendices of claims, and reference materials such as prior art references.

II. Patent Owner Petition Under 37 CFR 1.183

In the instant petition under 37 CFR 1.183, patent owner requests waiver of the requirement under 37 CFR 1.943(b) with respect to the 50-page limit, and requests that its January 31, 2011 comments “be allowed to stand”.¹

In support of its request for waiver of the rule, patent owner argues that additional pages are needed to address the examiner’s 67-page ACP, which incorporated by reference all relevant sections from the 126-page request for each asserted ground of rejection, and to address comments previously submitted (presumably, on August 25, 2010) by the third party requester.²

III. Analysis and Findings

The instant petition under 37 CFR 1.183 has been fully considered. In this instance, petitioner patent owner’s January 31, 2011 comments to the ACP include 134 pages of remarks, which are subject to the 50 page limit.

The patent owner comments are also accompanied by Exhibits A-D, and 4 declarations under 37 CFR 1.132.

A document is deemed to be subject to the 50-page length requirement when the document includes legal argument, i.e., arguments of counsel such as, e.g., arguments that the claims are patentable or unpatentable, or that are directed to how an outstanding or proposed rejection is overcome, or, in the case of a document filed by the requester, how an outstanding or proposed rejection is supported. There are no *per se* rules for determining whether a document, such as an affidavit or declaration, contains a legal argument that will cause the document to be subject to the page count. Each determination is made on a case-by-case basis. In determining whether a document such as an affidavit or declaration under 37 CFR 1.132, or any other document of a submission, includes legal argument, the Office analyzes whether the document is providing factual evidence, i.e., evidence of **technological** facts, or whether the document is merely an extension of the arguments of counsel. Factual evidence includes, for example, declarations that swear behind the filing date of a reference, that establish the date of a printed publication, that provide a technical explanation or technical definition of terms of art used by a reference, or that provide comparative test results and a scientific, or technological, analysis of the results (see,

¹ Petition at page 2.

² *Id.*

e.g., MPEP 716.02). If a document is limited to factual evidence, the document is not included in the page count. In addition, affidavits or declarations **limited to** establishing commercial success, long-felt need and failure of others, skepticism of experts, or copying, as per MPEP 716.03 -716.06, respectively, will not be included in the page count.

Exhibits A-D, which illustrate how the prior art relates to the presently claimed invention and are relied upon in the patent owner's comments, are an extension of patent owner's legal arguments; therefore, the 4 pages of these exhibits count toward the regulatory page limit.

It is acknowledged that patent owner filed a supplemental response on February 3, 2011 to provide a signed copy of the Warren Mirtsching declaration previously filed with the January 31, 2011 comments. The declaration of Warren Mirtsching is free of legal argument.

The declaration of James Byron contains legal arguments on 2 pages. Examples of legal arguments in the Byron declaration, which are not exhaustive, that count toward the page limit are:

On pages 4-5, paragraph 10, declarant Byron states: "While this is understandable, this merely illustrates not only the novelty and non-obviousness of the method, but also the importance and promise of the method, and in no way detracts from the validity of U.S. Patent 7,534,584."

The 22-page declaration of Dr. Mansour Samadpour, entitled "Declaration of Mansour Samadpour under 37 C.F.R. § 1.132", is replete with legal arguments. For this reason, the entirety of the declaration is counted toward the page limit. Examples of legal arguments in the Samadpour declaration, which are not exhaustive, that count toward the page limit are:

On page 13, in paragraph 26, declarant Samadpour states: "Moreover, since Jarvis purports only to deal with a only a narrow, theoretical, mathematical issue akin to coin tossing analysis, a person or [sic] ordinary skill in the art would not seek to combine his teachings with that of Price, Sillicker or Gabis in order to achieve some different result."

On page 15, in paragraph 29, declarant Samadpour states: "Thus, I conclude that the ACP presents an improper equivalence between . . . as is required in the patent claims."

On page 16, in paragraph 30, declarant Samadpour states: "However, in a manner which is non-obvious . . ."

On page 17, in paragraph 33, ". . . I would like to bring to the attention of the Examiner that conception of the invention was non-obvious."

The 26-page (second) declaration of Dr. Mansour Samadpour, entitled "Declaration of Mansour Samadpour to Rebut the Declaration of Dr. Bailey under 37 C.F.R. § 1.132" is replete with arguments that are an extension of the arguments of counsel. For this reason, the entirety of the

declaration is counted toward the page limit. Examples of such arguments in the second Samadpour declaration, which are not exhaustive, that count toward the page limit are:

On page 5, declarant Samadpour states: "As the title of the chapter implies it is not an enabling reference." Also on page 5, declarant Samadpour states: "Dr. Bailey relies on a series of misrepresentations of the references cited to make his case."

On page 7, declarant Samadpour states: "In my opinion Dr. Bailey is misleading the Examiner . . ."

On pages 8 and 10, declarant Samadpour states: "Dr. Bailey elects to use selective portions of the reference in an attempt to present his case and misdirect the Examiner."

On pages 18 and 19, declarant Samadpour states: "This is another circular argument . . . This is purely for the purpose of confusing the Examiner . . . Again Dr. Bailey misleads the Examiner . . ."

On page 23, declarant Samadpour states: "To make this extrapolation is simply an effort to cause confusion and mask the difference between patent '584 and the prior art."

Statements such as those above do not provide the Office with factual evidence.

Accordingly, the January 31, 2011 patent owner comments, as supplemented by the February 3, 2011 patent owner response, *in toto* are 188 pages in length.

37 CFR 1.183 permits waiver of the page limitation requirement of the regulations in an extraordinary situation when justice requires. Under the facts and circumstances currently of record in the present reexamination proceeding, including the length of the ACP and the pages incorporated by reference in the ACP, the instant patent owner petition is deemed to establish that a waiver of 37 CFR 1.943(b) to the extent of permitting patent owner's submission to run 188 pages in length is appropriate in the interest of justice.

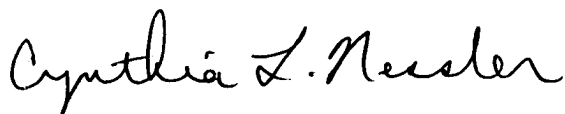
Accordingly, the patent owner's petition under 37 CFR 1.183 is **granted** to the extent that the page limit of 37 CFR 1.943(b) is waived to the extent of permitting the patent owner's submission to exceed the page limit by up to 138 pages. This waiver makes the patent owner's January 31, 2011 comments, as supplemented on February 3, 2011, page-length compliant.

CONCLUSION

1. The patent owner's February 16, 2011 petition under 37 CFR 1.183 is granted, and the page limit of 37 CFR 1.943(b) is waived to the extent that patent owner's January 31, 2011 submission not exceed 188 pages in length. This waiver makes the January 31, 2011 patent

owner comments after the ACP, as supplemented on February 3, 2011, page-length compliant.

2. The present proceeding is being forwarded to the Central Reexamination Unit (CRU) for consideration of the third party requester's petition under 37 CFR 1.181, filed on February 11, 2011.
3. Telephone inquiries related to the present decision should be directed to the Susy Tsang-Foster, Legal Advisor, at 571-272-7711.



Cynthia L. Nessler
Senior Legal Advisor
Office of Patent Legal Administration

3/14/11
Kenpet8/



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,294	04/05/2010	7534584	2781-128	1914
22504	7590	04/14/2011	EXAMINER	
DAVIS WRIGHT TREMAINE, LLP/Seattle 1201 Third Avenue, Suite 2200 SEATTLE, WA 98101-3045			ART UNIT	PAPER NUMBER

DATE MAILED: 04/14/2011

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WASHINGTON, DC 20005

Date: **MAILED**

APR 14 2011

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001294
PATENT NO. : 7534584
TECHNOLOGY CENTER : 3999
ART UNIT : 3991

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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DAVIS WRIGHT TREMAINE, LLP/Seattle
1201 Third Avenue, Suite 2200
SEATTLE, WA 98101-3045

(For Patent Owner)

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APR 14 2011

CENTRAL REEXAMINATION UNIT

ROTHWELL, FIGG, ERNST & MANBECK, P.C.
1425 K STREET, N.W.
SUITE 800
WASHINGTON, DC 20005

(For Third Party Requester)

Inter Partes Reexamination Proceeding
Control No. 95/001,294
Filed: April 5, 2010
For: U.S. Patent No. 7,534,584

:
: **DECISION**
: **DISMISSING**
: **PETITION**

This decision is in response to third party requester's petition, filed on February 11, 2011, which requests that the director order the examiner to issue a notice of noncompliance regarding patent owner's response to the Action Closing Prosecution. The petition state that the examiner erred in not issuing a notice of noncompliance because the response exceeds the page limits set in 37 CFR 1.943.

The petition is before the Director of TC 1600, who oversees the Central Reexamination Unit, for decision.

The third party requester's petition is **DISMISSED** for the reasons explained below.

STATEMENT OF RELEVANT FACTS

1. U.S. Patent No. 7,534,584 (the '584 patent) issued on May 19, 2009.
2. A request for reexamination of the '584 patent was filed on April 5, 2010. The request was assigned control No. 95/001,294 (the '294 reexamination proceeding).
3. On May 26, 2010, the Office ordered that the patent be reexamined, finding that requester had raised a substantial new question of patentability as to claims 1-33 of the '584 patent. On the same day, the Office mailed an Office action.
4. Prosecution advanced, and on December 17, 2010, the Office mailed an Action Closing Prosecution (ACP).
5. On January 31, 2011, the patent owner's response was timely filed.
6. On February 3, 2011, the patent owner filed a supplemental response.
7. On February 11, 2011, the third party requester filed the instant petition under 37 CFR 1.181 requesting that the director order the examiner to issue a notice of noncompliance regarding patent owner's response to the ACP.
8. On February 16, 2011, the patent owner filed a petition under 37 CFR 1.183 requesting waiver of the page-length requirements of 37 CFR 1.943(b).
9. On March 3, 2011, the third party requester filed comments.
10. On March 14, 2011, the Office granted the patent owner's petition under 37 CFR 1.183.

DECISION

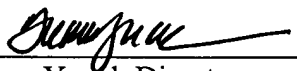
The third party requester (petitioner) states that they are seeking the director to order the examiner to issue a notice of noncompliance regarding patent owner's response to the ACP. The petition states that the examiner erred in not issuing a notice of noncompliance because the response exceeds the page limits set in 37 CFR 1.943(b).

As stated above, the Office granted the patent owner's petition to waive the requirements of 37 CFR 1.943(b) for their response to the ACP. Specifically, the March 14, 2011 decision stated that the patent owner's petition under 37 CFR 1.183 is granted to the extent that the page limit of 37 CFR 1.943(b) is waived to the extent of permitting the patent owner's submission to exceed the page limit by up to 138 pages. This waiver makes the patent owner's January 31, 2011 comments, as supplemented on February 3, 2011, page-length compliant.

Therefore, the Office has deemed the patent owner's response to the ACP page-length compliant. In light of this decision, third party requester's petition that requests the director to order the examiner to issue a notice of noncompliance for the patent owner's response is hereby dismissed.

CONCLUSION

1. The third party requester's petition, filed February 11, 20011, is DISMISSED for the reason discussed above.
2. Telephone inquiries related to this decision should be directed to Supervisory Patent Examiner Deborah Jones, at (571) 272-1535.



Irem Yucel, Director
Technology Center 1600



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,295	01/14/2010	7509178	5567-2	2137
23117	7590	01/06/2012	EXAMINER	
NIXON & VANDERHYE, PC 901 NORTH GLEBE ROAD, 11TH FLOOR ARLINGTON, VA 22203			ART UNIT	PAPER NUMBER

DATE MAILED: 01/06/2012

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Date:

Tracy W. Druce
NOVAK DRUCE & QUIGG, LLP, WELLS FARGO PLAZA
1000 Louisiana St., 53rd Floor
Houston, TX 77002

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001295
PATENT NO. : 7509178
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

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901 NORTH GLEBE ROAD, 11TH FLOOR
ARLINGTON VA 22203

(For Patent Owner)

MAILED

JAN 06 2012

CENTRAL REEXAMINATION UNIT

TRACY W. DRUCE
NOVAK DRUCE & QUIGG, LLP
WELLS FARGO PLAZA
1000 LOUISIANA ST., 53RD FLOOR
HOUSTON, TX 7702

(For *Inter Partes* Requester)

Inter Partes Reexamination Proceeding
Control No. 95/001,295
Filed: January 14, 2010
For: U.S. Patent No. 7,509,178

:
: **DECISION**
: **ON**
: **PETITION**
:

This is a decision on the patent owner papers entitled "PATENT OWNER'S PETITION UNDER 37 C.F.R. §1.183 TO WAIVE RULE 41.66 (TIME FOR FILING APPEAL BRIEF)," filed on January 3, 2012.

The petition is before the Office of Patent Legal Administration.

The petition is granted to the extent set forth herein.

BACKGROUND

1. On March 24, 2009, United States Patent No. 7,509,178 ("the '178 patent") issued to Logan *et al.*
2. On June 25, 2009, patent owner filed a complaint for infringement of the '178 patent against Apple Inc. in federal district court. The case being litigated is styled as *Personal Audio LLC v. Apple Inc., et al.* No. 9:09-cv-00111 (E.D. Texas, filed June 25, 2009). (the "concurrent litigation")
3. On January 14, 2010, a request for *inter partes* reexamination of the '178 patent was filed by third party requester, Apple, Inc., and was assigned Reexamination Control No. 95/001,295 ("the '1295 proceeding").
4. On April 8, 2010, the Office issued an order granting *inter partes* reexamination in the '468 proceeding. The order stated that an Office action would issue in due course.
5. On April 16, 2010, the Office issued a non-final Office action in the '1295 proceeding.

6. On July 8, 2011, a jury verdict was rendered in the concurrent litigation finding the claims at issue not to be anticipated or obvious over the references cited.
7. On August 30, 2011, the district court issued a final judgment in accordance with the July 8, 2011 jury verdict in the concurrent litigation.
8. Also on August 30, 2011, patent owner filed a notice of appeal to the Court of Appeals for the Federal Circuit (CAFC) of the district court's final judgment in the concurrent litigation.
9. Prosecution advanced until, on October 5, 2011, a Right of Appeal Notice (RAN) was issued by the Office.
10. On October 20, 2011, third party requester filed a notice of appeal to CAFC of the district court's August 30, 2011 final judgment in the concurrent litigation.
11. On November 4, 2011, patent owner filed a notice of appeal in the '1295 proceeding.
12. On November 7, 2011, third party requester filed a notice of appeal in the '1295 proceeding.
13. On December 27, 2011, patent owner and third party requester jointly filed a motion to dismiss by Dismissal Agreement with the CAFC.
14. Also on December 27, 2011, patent owner filed a petition to terminate the '1295 proceeding.
15. On January 3, 2012, patent owner filed the present petition entitled "PATENT OWNER'S PETITION UNDER 37 C.F.R. §1.183 TO WAIVE RULE 41.66 (TIME FOR FILING APPEAL BRIEF),"
16. On January 5, 2012, the CAFC granted the December 27, 2012 joint motion to dismiss, issued as a mandate.
17. Also on January 5, 2012, both patent owner and third party requester were contacted by the Office with regard to the resolution of the December 27, 2012 joint motion to dismiss.
18. Additionally, on January 5, 2012, patent owner filed a supplemental submission in support of the petition to terminate.
19. This decision addresses the patent owner's petition under 37 CFR 1.183 requesting waiver of the rule and granting of an extension of time to file an appeal brief in an *inter partes* reexamination proceeding.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

37 CFR § 1.183 states:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 CFR § 41.37 states, in pertinent part:

(a)(1) Appellant must file a brief under this section within two months from the date of filing the notice of appeal under § 41.31.

(e) The time periods set forth in this section **are extendable under** the provisions of § 1.136 of this title for patent applications and **§ 1.550(c) of this title for ex parte reexamination proceedings.** (Emphasis added)

37 C.F.R. § 41.61(b) states:

(1) Within fourteen days of service of a requester's notice of appeal under paragraph (a)(2) of this section and upon payment of the fee set forth in § 41.20(b)(1), an owner who has not filed a notice of appeal may file a notice of cross appeal with respect to the final rejection of any claim of the patent.

(2) Within fourteen days of service of an owner's notice of appeal under paragraph (a)(1) of this section and upon payment of the fee set forth in § 41.20 (b)(1), a requester who has not filed a notice of appeal may file a notice of cross appeal with respect to any final decision favorable to the patentability, including any final determination not to make a proposed rejection, of any original, proposed amended, or new claim of the patent.

37 CFR § 41.66 states, in pertinent part:

(a) An appellant's brief must be filed no later than two months from the latest filing date of the last-filed notice of appeal or cross appeal or, if any party to the proceeding is entitled to file an appeal or cross appeal but fails to timely do so, no later than two months from the expiration of the time for filing (by the last party entitled to do so) such notice of appeal or cross appeal. **The time for filing an appellant's brief or an amended appellant's brief may not be extended.** (Emphasis added)

DECISION

Patent owner's petition for an extension of time was filed on January 3, 2012, subsequent to the patent owner filing of a Notice of Appeal on November 4, 2011, the third party requester's filing

of a notice of cross appeal on November 7, 2011, and patent owner's December 27, 2011 request to terminate the proceeding based upon the final judgment obtained from the concurrent litigation. Patent owner filed the instant petition under 37 C.F.R. § 1.183 for consideration of a waiver of the prohibition of an extension of time for filing an appeal brief and the granting of an extension of time to file an appeal brief. Under 37 C.F.R. § 41.66(a), the time for filing an appellant's brief may not be extended.

The time for filing an appellant's brief is two months from the latest filing date of the last-filed Notice of appeal or cross-appeal, pursuant to 37 C.F.R. § 41.66(a). In the present proceeding, a Notice of Appeal (cross appeal) was filed by the third party requester on November 7, 2011. Therefore, the time for patent owner petitioner to file an Appeal Brief is due to expire on January 7, 2012. The outstanding petition under 37 C.F.R. § 1.183 is currently under consideration by the Office.

In this instance, patent owner has filed a petition for extension of time to obtain the results of (a decision on) petition to terminate filed under 37 CFR § 1.182. A decision on the § 1.182 petition has yet to be rendered. In the event patent owner were to file an Appellant's Brief to keep the proceeding pending, in this case, that filing would cause an unnecessary expenditure of resources by the Central Reexamination Unit (CRU) to consider a brief that may become moot, should the petition under § 1.182 be granted.

In a telephone conversation between Senior Legal Advisor Cynthia Nessler and Mr. Robert Faris of Nixon & Vanderhyde on January 5, 2012, the Office was informed that the CAFC ordered a dismissal of the underlying litigation on even date with the telephone conversation. Mr. Faris was informed that a copy of the CAFC's dismissal was required in order to favorably consider the request for extension of time. Mr. Faris agreed to submit 1) a copy of the court's order dismissing the appeal as soon as it becomes available and 2) a copy of the current CAFC docket report reflecting that the order was rendered by the court on January 5, 2012, which was also received by the Office on even date. A courtesy call was made to third party requester's counsel, Mr. Andrew Weaver of Novak, Druce and Quigg on January 5, 2012, informing counsel of the above telephone conversation.

Under the current facts and circumstances of the present proceeding, an extension of time under 37 C.F.R. § 1.183 is granted to the extent that patent owner petitioner's time period to submit an Appellant's Brief is extended to run 30 days from the due date; i.e., to February 7, 2012. In the interests of equity and uniformity, third party requester's time period to submit an appeal Brief is *sua sponte* extended to run 30 days from the due date; i.e., to February 7, 2011.

If the petition to terminate under § 1.182 is not yet decided at the point where the time for patent owner to file an Appellant's Brief becomes less than two weeks prior to the deadline as extended, then patent owner may file a petition for an additional extension of time. In that event, patent owner is advised to contact Joseph Weiss at the phone number given below in the contact information, to inform the Office that the petition for an additional extension of time is being filed, in order to expedite its review.

CONCLUSION

1. The patent owner petition for an extension of time to file an appeal brief filed January 3, 2012 are **granted**.
2. The time for filing both the patent owner and third party requester Appellant's Briefs is extended to run **30 days** from the due date; i.e., through February 7, 2012.
3. Telephone inquiries related to this decision should be directed Joseph F. Weiss, Jr., Legal Advisor, Office of Patent Legal Administration, at (571) 272-7759.

/Kenneth M. Schor/

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

1-5-12



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UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,295	01/14/2010	7509178	5567-2	2137
23117	7590	01/26/2012	EXAMINER	
NIXON & VANDERHYE, PC 901 NORTH GLEBE ROAD, 11TH FLOOR ARLINGTON, VA 22203			ART UNIT	PAPER NUMBER

DATE MAILED: 01/26/2012

Please find below and/or attached an Office communication concerning this application or proceeding.



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Date:

Tracy W. Druce

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1000 Louisiana St., 53rd Floor

Houston, TX 77002

MAILED

JAN 26 2012

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001295

PATENT NO. : 7509178

TECHNOLOGY CENTER : 3999

ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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JAN 26 2012

CENTRAL REEXAMINATION UNIT

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(For Patent Owner)

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(For *Inter Partes* Requester)

Inter Partes Reexamination Proceeding
Control No. 95/001,295
Filed: January 14, 2010
For: U.S. Patent No. 7,509,178

:
: **DECISION**
: **ON**
: **PETITION**
:

This is a decision on the patent owner papers entitled "PATENT OWNER'S PETITION UNDER 37 C.F.R. 1.183 FOR AN ADDITIONAL EXTENSION OF TIME (TO FILE AN APPELLANT'S BRIEF)," filed on January 25, 2012.

The petition is before the Office of Patent Legal Administration.

The petition is granted to the extent set forth herein.

BACKGROUND

1. On March 24, 2009, United States Patent No. 7,509,178 ("the '178 patent") issued to Logan *et al.*
2. On June 25, 2009, patent owner filed a complaint for infringement of the '178 patent against Apple Inc. in federal district court. The case being litigated is styled as *Personal Audio LLC v. Apple Inc., et al.* No. 9:09-cv-00111 (E.D. Texas, filed June 25, 2009). (the "concurrent litigation")
3. On January 14, 2010, a request for *inter partes* reexamination of the '178 patent was filed by third party requester, Apple, Inc., and was assigned Reexamination Control No. 95/001,295 ("the '1295 proceeding").
4. On April 8, 2010, the Office issued an order granting *inter partes* reexamination in the '468 proceeding. The order stated that an Office action would issue in due course.
5. On April 16, 2010, the Office issued a non-final Office action in the '1295 proceeding.

6. On July 8, 2011, a jury verdict was rendered in the concurrent litigation finding the claims at issue not to be anticipated or obvious over the references cited.
7. On August 30, 2011, the district court issued a judgment in accordance with the July 8, 2011 jury verdict in the concurrent litigation.
8. The '1295 proceeding progressed until, on October 5, 2011, a Right of Appeal Notice (RAN) was issued by the Office.
9. On October 20, 2011, third party requester filed a notice of appeal to the Court of Appeals for the Federal Circuit (CAFC) of the district court's August 30, 2011 judgment in the concurrent litigation.
10. On November 4, 2011, patent owner filed a notice of appeal in the '1295 proceeding.
11. On November 7, 2011, third party requester filed a notice of appeal in the '1295 proceeding.
12. On December 27, 2011, patent owner and third party requester jointly filed a motion to dismiss the CAFC appeal, by Dismissal Agreement with the CAFC.
13. Also on December 27, 2011, patent owner filed a petition to terminate the '1295 proceeding.
14. On January 3, 2012, patent owner filed a petition entitled "PATENT OWNER'S PETITION UNDER 37 C.F.R. §1.183 TO WAIVE RULE 41.66 (TIME FOR FILING APPEAL BRIEF),"
15. On January 5, 2012, the CAFC granted the December 27, 2012 joint motion to dismiss, issued as a mandate.
16. Also on January 5, 2012, both patent owner and third party requester were contacted by the Office with regard to the resolution of the December 27, 2012 joint motion to dismiss.
17. Additionally, on January 5, 2012, patent owner filed a supplemental submission in support of the petition to terminate.
18. On January 6, 2012, the Office granted petitioner's request for an extension of time, granting a 30 day extension of time, and indicating the possibility of additional extensions of time if necessary.
19. On January 9, 2012, patent owner filed a second supplemental submission in support of the petition to terminate, which includes a copy of the CAFC order granting the parties' joint motion to dismiss the related, concurrent litigation of the '178 patent.
20. On January 25, 2012, patent owner filed the present petition, "PETITION UNDER 37 C.F.R. §1.182 REQUESTING SECOND WAIVER OF THE PROHIBITION OF AN EXTENSION OF TIME FOR FILING AN APPEAL BRIEF," requesting a second extension of time.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

37 CFR § 1.183 states:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 CFR § 41.37 states, in pertinent part:

(a)(1) Appellant must file a brief under this section within two months from the date of filing the notice of appeal under § 41.31.

(e) The time periods set forth in this section **are extendable under** the provisions of § 1.136 of this title for patent applications and **§ 1.550(c) of this title for ex parte reexamination proceedings**. (Emphasis added)

37 C.F.R. § 41.61(b) states:

(1) Within fourteen days of service of a requester's notice of appeal under paragraph (a)(2) of this section and upon payment of the fee set forth in § 41.20(b)(1), an owner who has not filed a notice of appeal may file a notice of cross appeal with respect to the final rejection of any claim of the patent.

(2) Within fourteen days of service of an owner's notice of appeal under paragraph (a)(1) of this section and upon payment of the fee set forth in § 41.20 (b)(1), a requester who has not filed a notice of appeal may file a notice of cross appeal with respect to any final decision favorable to the patentability, including any final determination not to make a proposed rejection, of any original, proposed amended, or new claim of the patent.

37 CFR § 41.66 states, in pertinent part:

(a) An appellant's brief must be filed no later than two months from the latest filing date of the last-filed notice of appeal or cross appeal or, if any party to the proceeding is entitled to file an appeal or cross appeal but fails to timely do so, no later than two months from the expiration of the time for filing (by the last party entitled to do so) such notice of appeal or cross appeal. **The time for filing an appellant's brief or an amended appellant's brief may not be extended.** (Emphasis added)

DECISION

Patent owner's petition for a second extension of time was filed on January 25, 2012, subsequent to the patent owner filing of a Notice of Appeal on November 4, 2011, the third party requester's

filing of a notice of cross appeal on November 7, 2011, and patent owner's December 27, 2011 request to terminate the proceeding based upon the final judgment obtained from the concurrent litigation. Patent owner filed the instant petition under 37 C.F.R. § 1.183 for consideration of a waiver of the prohibition of an extension of time for filing an appeal brief and the granting of an extension of time to file an appeal brief. Under 37 C.F.R. § 41.66(a), the time for filing an appellant's brief may not be extended.

The time for filing an appellant's brief is two months from the latest filing date of the last-filed Notice of appeal or cross-appeal, pursuant to 37 C.F.R. § 41.66(a). In the present proceeding, a Notice of Appeal (cross appeal) was filed by the third party requester on November 7, 2011. Therefore, the original time for patent owner petitioner to file an Appeal Brief expired on January 7, 2012. The extended time period for patent owner petitioner to file an appeal brief is due to expire on February 7, 2012. Under 37 C.F.R. § 41.66(a), the time for filing the appellant's brief may not be extended.

In this instance, patent owner has filed a petition for extension of time to obtain the results of (a decision on) a petition to terminate filed under 37 C.F.R. § 1.182. A decision on the § 1.182 petition has yet to be rendered. The outstanding petition under 37 C.F.R. § 1.182 is currently under consideration by the Office. In the event patent owner was to file an Appellant's Brief to keep the proceeding pending, in this case, that filing would cause an unnecessary expenditure of resources by the Central Reexamination Unit (CRU) to consider a brief that may become moot, should the petition under § 1.182 be granted.

In a telephone conversation between Senior Legal Advisor Cynthia Nessler and Mr. Robert Faris of Nixon & Vanderhyde on January 5, 2012, the Office was informed that the CAFC ordered a dismissal of the underlying litigation on even date with the telephone conversation. Mr. Faris was informed that a copy of the CAFC's dismissal was required in order to favorably consider the request for extension of time. Mr. Faris agreed to submit 1) a copy of the court's order dismissing the appeal as soon as it becomes available and 2) a copy of the current CAFC docket report reflecting that the order was rendered by the court on January 5, 2012. On January 5, 2012, Mr. Faris submitted a copy of the current CAFC docket report reflecting that the order was rendered by the court on even date. On January 9, 2012, Mr. Faris submitted a copy of the court's order dismissing the appeal. A courtesy call was made to third party requester's counsel, Mr. Andrew Weaver of Novak, Druce and Quigg on January 5, 2012, informing counsel of the above telephone conversation.

Under the current facts and circumstances of the present proceeding, an extension of time under 37 C.F.R. § 1.183 is granted to the extent that patent owner petitioner's time period to submit an Appellant's Brief is extended to run 30 days from the previously extended due date; i.e., to March 7, 2012. In the interests of equity and uniformity, third party requester's time period to submit an appeal Brief is *sua sponte* extended to run 30 days from the previously extended due date; i.e., to March 7, 2012.

If the petition to terminate under § 1.182 is not yet decided at the point where the time for patent owner to file an Appellant's Brief becomes less than two weeks prior to the deadline as extended, then patent owner may file a petition for an additional extension of time. In that event,

patent owner is advised to contact Joseph Weiss at the phone number given below in the contact information, to inform the Office that the petition for an additional extension of time is being filed, in order to expedite its review.

CONCLUSION

1. The patent owner petition for waiver and an extension of time to file an appeal brief filed January 25, 2012 is **granted**.
2. The time for filing both the patent owner and third party requester Appellant's Briefs is extended to run **30 days** from the previously extended due date; i.e., through March 7, 2012.
3. Telephone inquiries related to this decision should be directed Joseph F. Weiss, Jr., Legal Advisor, Office of Patent Legal Administration, at (571) 272-7759.

/Kenneth M. Schor/

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

1-25-12



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,295	01/14/2010	7509178	5567-2	2137
23117	7590	02/22/2012	EXAMINER	
NIXON & VANDERHYE, PC 901 NORTH GLEBE ROAD, 11TH FLOOR ARLINGTON, VA 22203			ART UNIT	PAPER NUMBER

DATE MAILED: 02/22/2012

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Date:

MAILED

FEB 22 2012

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001295

PATENT NO. : 7509178

TECHNOLOGY CENTER : 3999

ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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(For Patent Owner)

MAILED

FEB 22 2012

Novak, Druce, & Quigg, LLP
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1000 Louisiana Street
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Houston, TX 77002

(For Requester)

CENTRAL REEXAMINATION UNIT

In re Logan et al
Inter Partes Reexamination Proceeding
Control No. 95/001,295
Filed: January 14, 2010
For: U.S. Patent No.: 7,509,178

**DECISION GRANTING
PETITION TO TERMINATE
AND DISMISSING AS MOOT
REMAINING PETITIONS**

This is a decision on the following petition and supplemental papers:

- Patent owner's December 27, 2011 petition entitled "Patent Owner's Petition to Terminate *Inter Partes* Reexamination Proceeding Under 35 U.S.C. 317(b) & 37 C.F.R. 1.182" (patent owner's December 27, 2011 petition to terminate);
- Patent owner's January 5, 2012 paper entitled "Supplemental Submission in Support of Petition" (patent owner's January 5, 2012 supplement); and
- Patent owner's January 9, 2012 paper entitled "Second Supplemental Submission in Support of Petition" (patent owner's January 9, 2012 supplement).

This decision also addresses the following petitions and opposition papers:

- Patent owner's September 9, 2011 petition entitled "Patent Owner's Petition to Suspend *Inter Partes* Reexamination" (patent owner's September 9, 2011 petition to suspend);
- Requester's October 7, 2011 opposition paper entitled "Third Party Requester's Opposition Under 37 CFR § 1.182 and 1.183 to Patent Owner's Petition to Suspend" (requester's October 7, 2011 opposition);
- Patent owner's November 4, 2011 petition entitled "Petitioner's Petition to Continue *Inter Partes* Reexamination for Entry and Consideration of April 27, 2011 Alernoth Declaration and Related Evidence cited in Petitioner's August 2011 Information

- Requester's December 6, 2011 opposition paper entitled "Third Party Requester's Opposition Under 37 CFR § 1.182 and 1.183 to Patent Owner's Petition to Continue Reexamination" (requester's December 6, 2011 opposition).

Patent owner's December 27, 2011 petition to terminate, patent owner's January 5, 2012 and January 9, 2012 supplements, patent owner's September 9, 2011 petition to suspend, patent owner's November 4, 2011 petition to reopen prosecution, requester's October 7, 2011 and December 6, 2011 opposition papers, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

SUMMARY

Patent owner's petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding 95/001,295, filed on December 27, 2011, is **granted**.

Inter partes reexamination proceeding 95/000,472 is hereby **terminated**.

Patent owner's September 9, 2011 petition to suspend, and patent owner's November 4, 2011 petition to reopen prosecution, are **dismissed as moot**.

DECISION

The patent owner argues that termination of *inter partes* reexamination proceeding control number 95/001,295 (the '1295 proceeding) is required by 35 U.S.C. 317(b), which provides, in pertinent part (emphasis added):

Once a **final decision** has been entered against a party in a civil action arising in whole or in part under section 1338 of title 28, that the party has not sustained its burden of proving the invalidity of any patent claim in suit . . . then . . . an *inter partes* reexamination requested by that party or its privies on the basis of . . . issues [which that party or its privies raised or could have raised in such civil action] may not thereafter be maintained by the Office . . .

The Office analyzes whether a reexamination proceeding must be terminated pursuant to 35 U.S.C. 317(b) by determining:

1. Whether the third party requester was a party to the litigation;
2. Whether the decision is final, i.e., after all appeals;
3. Whether the court decided that the requester/party had not sustained its burden of proving the invalidity of any claim in suit of the patent, which claim is also under reexamination; and
4. Whether the issues raised in the reexamination proceeding are the same as issues that were raised, or are issues that could have been raised, by the requester in the civil action.

The patent owner informs the Office that the patent under reexamination, U.S. Patent 7,509,178 (the '178 patent), was the subject of a civil action in district court, i.e., *Personal Audio, LLC v. Apple, Inc.*, Civil Action No. 9:09CV111 (E.D. Tex.). The patent owner submits a copy of the jury verdict dated July 8, 2011, and a copy of the final judgment of the district court dated

August 30, 2011, showing that the requester/defendant Apple did not sustain its burden of proving the invalidity of the asserted claims, i.e., independent claims 1 and 14, and dependent claims 6 and 13, of the '178 patent. Claims 1 and 14 are the only independent claims recited in the '178 patent. The patent owner correctly argues that, while all of the patent claims, i.e., claims 1-29, are subject to reexamination in the present proceeding, a rejection of the dependent claims over prior art cannot be maintained by the Office where, as here, the independent claims have been found to be not invalid by the court. The patent owner also provides a copy of an order by the Federal Circuit, dated January 5, 2012, granting the parties' joint motion to voluntarily dismiss the appeals from the final judgment of the district court to the Federal Circuit. Thus, the patent owner has provided sufficient evidence that (1) the requester Apple was a party to the litigation, (2) the district court's decision was final, and (3) the court determined that the requester/defendant had not sustained its burden of proving the invalidity of all of the independent claims of the patent under reexamination. For these reasons, the above-described elements 1-3 have been shown to be satisfied.

Regarding element 4, the patent owner has submitted a redacted copy of a court document entitled "Defendant's Invalidity Contentions", which includes all of the prior art references which were cited by the requester in its request for reexamination, and which were applied by the examiner in the present proceeding. This document, in addition to the other evidence submitted by the patent owner with the present petition, provide sufficient evidence that the prior art, and any other issues present in the '1295 reexamination proceeding, were either raised or could have been raised by the defendant/requester in the copending litigation. Thus, element 4 has been shown to be satisfied.

For the reasons given above, patent owner's December 27, 2011 petition under 37 CFR 1.182 to terminate the present *inter partes* reexamination proceeding is **granted**.

Inter partes reexamination proceeding control no. 95/001,295 (the '1295 proceeding) is hereby **terminated**.

Because the present proceeding is being terminated, patent owner's September 9, 2011 petition to suspend, and patent owner's November 4, 2011 petition to reopen prosecution, are **dismissed as moot**.

The '1295 *inter partes* reexamination proceeding is being referred to the Central Reexamination Unit (CRU) for conclusion of that proceeding. The CRU will mail the present decision, and process the reexamination file to update the Image File Wrapper (IFW) records for this proceeding. The file will be assigned an 822 status. A copy of the PALM "Application Number Information" screen and the "Contents" screen will be printed, the printed copy will be annotated by adding the comment "PROCEEDING CONCLUDED," and the annotated copy will then be scanned into Image File Wrapper (IFW) using the miscellaneous letter document code.

CONCLUSION

- Patent owner's December 27, 2011 petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding control number 95/001,295 is **granted**.

- The prosecution of the '1295 *inter partes* reexamination proceeding is hereby **terminated** and will be concluded.
- Patent owner's September 9, 2011 petition to suspend, and patent owner's November 4, 2011 petition to reopen prosecution, are **dismissed as moot**.
- Any inquiry concerning this communication should be directed to Cynthia Nessler, Senior Legal Advisor, at (571) 272-7724.



Brian E. Hanlon
Director
Office of Patent Legal Administration



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,299	01/21/2010	6549759	8934.009.RXUS00	1299

21967 7590 08/04/2010

HUNTON & WILLIAMS LLP
INTELLECTUAL PROPERTY DEPARTMENT
1900 K STREET, N.W.
SUITE 1200
WASHINGTON, DC 20006-1109

EXAMINER

ART UNIT	PAPER NUMBER
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DATE MAILED: 08/04/2010

Please find below and/or attached an Office communication concerning this application or proceeding.



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
NOVAK DRUCE & QUIGG, LLP (NDQ REEXAMINATION GROUP)
1000 LOUISIANA STREET
FIFTY-THIRD FLOOR
HOUSTON, TX 77002

Date:

MAILED

AUG 04 2010

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001299
PATENT NO. : 6549759
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

DAVID M. O'DELL

HAYNES AND BOONE, LLP

2323 VICTORY AVENUE, SUITE 700

DALLAS, TX 75219

Date:

MAILED

AUG 04 2010

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001299

PATENT NO. : 6549759

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UNITED STATES PATENT AND TRADEMARK OFFICE

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Alexandria, VA 22313-1450
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Donald J. Quigg
Novak Druce & Quigg, LLP
1000 Louisiana Street
Wells Fargo Plaza, 53rd Floor
Houston, TX 77022

(For Requester Broadcom)

MAILED

AUG 04 2010

David M. O'Dell
Haynes and Boone, LLP
2323 Victory Avenue, Suite 700
Dallas Texas 75219

(For Requester Intellectual Property Department)

Thomas E. Anderson
Hunton & Williams, LLP
Intellectual Property Department
1900 K Street, N.W., Suite 1200
Washington, DC 20006-1109

(For Patent Owner)

In re Arviv, et al
Reexamination Proceeding
Control No.: 95/001,299
Original Request Deposited: January 21, 2010,
For: U.S. Patent No.: 6,549,759
Title: Asymmetric Adaptive Modulation in a
Wireless Communication System

: DECISION
: ON § 1.182
: PETITION AND
: DECISION VACATING
: REEXAMINATION
: FILING DATE

This is a decision addressing a June 29, 2010 patent owner petition under § 1.182 entitled "Petition to Clarify Third-Party Requester Status," seeking clarification as to the requesters for the instant reexamination.

The patent owner § 1.182 petition is before the Office of Patent Legal Administration for consideration and is granted. A review of the request for reexamination finds it to be defective and the January 21, 2010 filing date assigned to the instant reexamination is vacated.

Since the filing date is vacated, the following are also vacated:

1. The February 26, 2010 order granting reexamination and accompanying Office action,
2. The patent owner response of May 17, 2010, and May 28, 2010 supplement, that respond to the February 26, 2010 Office action,
3. The June 16, 2010 third party comment to the patent owner response, and
4. All outstanding petitions.

In order to obtain a filing date for the request papers, the requester must, within **One (1) month** of the mailing of this decision, file a response to this decision which remedies the defect set forth in this decision and makes the request papers compliant with the requirements of 37 CFR 1.915.

FEE

The § 1.182 petition fee of \$400.00 pursuant to § 1.17(f) will be charged to deposit account No. 50-0206 as authorized on page 1 of the petition.

BACKGROUND

1. U.S. Patent No. 6,549,759 (the '759 patent) was issued on April 15, 2003.
2. On January 21, 2010, a request for *inter partes* reexamination of the '759 patent was filed.¹ The request stated:

Pursuant to 37 C.F.R. § 1.915(b)(8), the Real Parties in Interest, Broadcom Corporation and Intel Corporation (herein 'Requestors' (sic)), hereby respectfully request reexamination pursuant to 35 U.S.C. §§ 311 *et seq* and 37 C.F.R. § 1.902 of²

The request was assigned Control No. 95/001,299 (the '1,299 reexamination proceeding).

3. On February 26, 2010, the Office issued an Order granting *inter partes* reexamination for the '1,299 reexamination proceeding. The Order was accompanied by an Office action, which Office action has been responded to on May 17, 2010 by the patent owner, supplemented on May 28, 2010. Third party comments to the patent owner response were submitted on June 16, 2010. The following petitions are outstanding:
 - a. May 26, 2010 petition by third party requester that service by patent owner of May 17, 2010 papers was improper, supplemented on June 4, 2010, and a June 15, 2010 patent owner petition reply thereto.
 - b. June 16, 2010 petition by third party requester to waive page limits.
4. On June 29, 2010 patent owner filed the instant petition under 37 CFR 1.182 to clarify the requesters of the instant reexamination. The instant patent being reexamined is identified as the subject of litigation in *Wi-LAN, Inc. v. Acer Inc. et al*, Case No. 2:07-CV-473 (E.D. Tex.) filed on October 31, 2007, "involving as parties the patent owner Wi-LAN and both Intel and Broadcom."³ The record does not reveal that an opposition to the instant patent owner petition under 37 CFR 1.182 has been filed by the requester.

¹ While para. 13 of the Request form was not checked, page 8 of the request states that the requesters certify that the estoppel provisions of § 1.907 do not prohibit the filing of the instant reexamination.

² At page 1.

³ Petition, bridge of pages 2 and 3.

**SECTION 1.182 PETITION BY PATENT OWNER FOR
CLARIFICATION OF REQUESTERS**

Patent owner petitioner points out that the request for reexamination identifies two parties requesting reexamination: Broadcom Corporation (Broadcom), and Intel Corporation (Intel).⁴ Notwithstanding such identification, the request is signed with the following information appearing on the signature page:

/Tracy W. Druce/

Novak Druce & Quigg, LLP
Attorneys for Third Party Requestor (sic): Broadcom Corporation
Donald J. Quigg
Reg. No. 16,030
Tracy W. Druce
Reg. No. 35,493

NOVAK DRUCE & QUIGG, LLP
1000 Louisiana Ave.
Wells Fargo Plaza
53rd Floor
Houston, Texas 77002
P: 713-571-3400
F: 713-456-2836

Attorneys for Third Party Requestor (sic): Intel Corporation
David M. O'Dell
Registration No. 42,044
HAYNES AND BOONE, LLP
2323 Victory Avenue, Suite 700
Dallas, Texas 75219
Telephone: 972/739-8635
Facsimile: 214/200-0853
Attorney Docket No. 33142.41

While Mr. Druce has signed the Request for Reexamination on behalf of Broadcom, the Request for Reexamination appears to indicate that Mr. Druce does not represent identified requester Intel. Specifically, the signature page on the Request for Reexamination states that Mr. O'Dell is the representative of Intel. However, Mr. O'Dell has not signed the Request for Reexamination. Thus, only one of the stated requesters signed the request. Petitioner, in effect, asks for clarification as to whether Intel is a requester. Patent owner petitioner states that such clarification is deemed necessary to determine (1) whether Intel has a right to provide comments in this reexamination proceeding, (2) whether Intel can proceed independently of third party requester Broadcom in this reexamination proceeding and (3) whether estoppels pursuant to 35 U.S.C. 315(c) and 317(c) would be applicable to Intel.

⁴ Background, para. 2.

DECISION ON PATENT OWNER § 1.182 PETITION

Preliminarily, it is noted that the matter raised in the petition is one directed solely at whether Intel is a requester of the reexamination. There is no issue raised as to the real parties in interest. The reexamination request states that the real parties in interest are Broadcom and Intel.⁵ A requester need not have a power of attorney from any party that a requester believes to be a real party in interest to name that party as a real party in interest.⁶ Accordingly, whether Intel would be subject to statutory estoppels is not in issue. Moreover, while a requester can provide comments to be submitted in the reexamination, each joint requester may not proceed independently, no more so than individual joint inventors may proceed independently of each other. The issue is therefore whether Mr. Duce was authorized to act on behalf of the entire entity (Broadcom and Intel) requesting reexamination.

As petitioner correctly notes, § 1.915(c) requires that a practitioner filing a request for reexamination on behalf of another party must have a power of attorney from that party, which power is of record, or the practitioner must be acting in a representative capacity where a power of attorney exists externally of the reexamination record. The Office will not engage in conjecture as to the existence of a power of attorney or other authority (MPEP 324, *e.g.*, an appropriate officer) on behalf of the party signing for each named requester. Either (1) there exists a power of attorney of record on behalf of the party signing the request for reexamination by each identified requester or other authority of record where a practitioner is not signing, or (2) a practitioner signing the request for reexamination by providing a registration number thereby establishing that the party signing the request for reexamination is acting in a representative capacity for the identified requesters. In the instant circumstances, where a practitioner who is signing the request for reexamination on behalf of identified requesters utilizes a registration number, it is incumbent upon patent owner petitioner who is challenging the third party request for reexamination to establish by objective evidence that the practitioner signing the request for reexamination and presenting a registration number is not at least acting in a representative capacity on behalf of all the parties that the request for reexamination is being filed on behalf of.

In the instant circumstances, the request for reexamination itself has provided information contrary to the normal presumption attaching to the presence of a registration number. As can be seen from a review of the execution (signature) page of the request for reexamination, the party signing, Novak Duce, only represents Broadcom and not Intel in regard to the request for reexamination:

(1) The identification of Duce as the attorney for Broadcom in the signature block without including Intel indicates a representation of Broadcom, but not a representation of Intel; and

(2) The separate identification on the signature page of David M. O'Dell as the attorney for Intel indicates that Duce does not represent Intel.

⁵ Request Transmittal Form, para. 2.a and the Request at page 6.

⁶ For example, a second real party in interest may have contributed financially to producing a request for reexamination, but may not wish to grant a first real party in interest who is the actual requester, and a possible competitor, a power of attorney on its behalf. Lack of such power by the requester should not prevent the requester from identification of all real parties in interest to avoid circumventing statutory estoppels. That is not to say, that the requester should not be required to provide notice to any party the requester intends to name as a real party in interest to put that real party in interest on notice as to statutory estoppels it may be subject to.

The request for reexamination specifically states that the request is being made on behalf of Intel (as well as Broadcom),⁷ yet the request also appears to establish that the practitioner signing the request for reexamination was not acting on behalf of Intel.

Accordingly the patent owner § 1.182 petition is granted.

REEXAMINATION FILING DATE IS VACATED

As set forth above, the practitioner filing (signing) a request for reexamination on behalf of another must have a power of attorney on behalf of that party either as part of the file record, or external to the file record where the practitioner supplies a registration number to signify acting in a representative capacity. Where such power of attorney is lacking, compliance with § 1.915(c) is lacking. Section 1.919(a) requires the filing date to be dependent upon the date there is compliance with all the requirements of § 1.915. In this instance, the record reveals that attorney that requested reexamination had power of attorney for one of the joint requesters but not for the other joint requester. Accordingly, the January 1, 2010 filing date assigned to the instant reexamination is vacated, based on a lack of compliance with § 1.915(c).

REQUESTER'S RECOURSE

I. Requester Broadcom has the following options to respond to this identification of defect in the request paper by providing a corrected request for *inter partes* reexamination as required by § 1.915:

A. Solely on behalf of Broadcom continuing to name Intel as a real party in interest, and providing notice to Intel that it is so named and that Intel has Fifteen (15) days from the date of such notice⁸ to submit a paper disputing that it is a real party in interest. The Office will not, at this juncture, decide any dispute as to any estoppel issue that may attach, until a second request for *inter partes* reexamination request is filed.

B. On behalf of both Broadcom and Intel where the practitioner actually filing the request has a power of attorney on behalf of both requesters (or there are joint requesters). This may be shown by practitioner's use of a registration number without any statement regarding representation, or by a power of attorney from each that is made of record in the file. In these situations, a notice to Intel that it has been identified as a real party in interest would not be required.

II. In order to obtain a filing date for the corrected request paper, the requester must, within one (1) month of the mailing date of this decision, file a response to this decision which makes the request papers filing date compliant.

The response may be mailed to the Central Reexamination Unit (CRU), attn: "Box *Inter Partes* Reexam" at the USPTO address indicated below, or hand-carried to the CRU at the address indicated below.

⁷ Request form, para 2.a. and the request itself, page 6.

⁸ Fifteen days is deemed to be sufficient time, as Intel is already on notice that it has previously been named as a real party in interest, e.g., the § 1.182 petition, which states that the request for reexamination has named Intel is a real party in interest on page 1, has been served on Intel.

The requester has one opportunity to make the request papers filing date compliant. If the response to this decision (1) fails to cure the defect identified in this decision, (2) adds a new defect, or (3) adds a new ground for requesting reexamination, then processing of the request papers will be terminated, and the request papers will either be discarded or treated as a prior art citation under 37 CFR 1.501, at the Office's option.

If the request papers are made filing date compliant, the date of the receipt of the response will be the filing date of the reexamination proceeding and the Office will take appropriate action in regard to issuing an order for reexamination and a related Office action.

ADDITIONAL PAPERS OF RECORD

In view of the present vacatur of the filing date for the present proceeding, the following papers are also vacated:

1. The February 26, 2010 order granting reexamination and accompanying office action,
2. The patent owner response of May 17, 2010, and May 28, 2010 supplement, that respond to the February 26, 2010 Office action,
3. The June 16, 2010 third party comments to the patent owner response, and
4. all outstanding petitions.

SYNOPSIS

There is clear evidence in the file record that the requester did not have a power of attorney from one of the two parties reexamination was requested on behalf of. Consequently, the filing date of the instant reexamination cannot be maintained and is vacated.

CONCLUSION

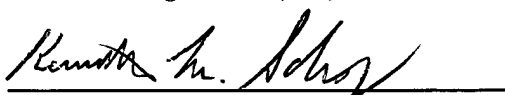
1. The \$400 § 1.182 petition fee pursuant to § 1.17(f) will be charged to Deposit Account No. 50-0206.
2. The June 29, 2010 petition is granted and the filing date of the reexamination is vacated along with other papers filed in the course of the reexamination.
3. Requester(s) may within one (1) month of the mail date of this decision, file a compliant corrected request for *inter partes* reexamination on behalf of those parties for which reexamination is being requested.
4. Should requester timely file a compliant corrected request for *inter partes* reexamination, the Central Reexamination Unit may, at that point, immediately issue a paper ratifying the order and Office action that have been vacated by this decision.
5. Any response to this Decision should be directed to:

By Mail: Mail Stop "Inter Partes Reexam"
Attn: Central Reexamination Unit
Commissioner for Patents
P.O. Box 1450
Alexandria VA 22313-1450

By Hand: Customer Service Window
Attn: Central Reexamination Unit
Randolph Building, Lobby Level
401 Dulany Street
Alexandria VA 22314

It is strongly suggested that any such response be followed up by a telephone call to the Central Reexamination Unit at (571) 272-7705, as soon as possible, to ensure receipt and processing.

6. Telephone inquiries related to this decision and order should be directed to Hiram H. Bernstein, Senior Legal Advisor, at (571) 272-7707, or, in his absence, to the undersigned, at (571) 272-7710.



Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

8-3-10
Kenreex/FD/IPreex/petition

APPENDIX OF RELEVANT STATUTORY, REGULATORY AND PRACTICE PROVISIONS

35 U.S.C. §§ 311(a) and (b) provide:

(a) **IN GENERAL.**— Any third-party requester at any time may file a request for inter partes reexamination by the Office of a patent on the basis of any prior art cited under the provisions of section 301.

(b) **REQUIREMENTS.**— The request shall—

(1) be in writing, include the identity of the real party in interest, and be accompanied by payment of an inter partes reexamination fee established by the Director under section 41; and

(2) set forth the pertinency and manner of applying cited prior art to every claim for which reexamination is requested.

35 U.S.C. § 315(c) provides:

CIVIL ACTION.— A third-party requester whose request for an inter partes reexamination results in an order under section 313 is estopped from asserting at a later time, in any civil action arising in whole or in part under section 1338 of title 28, the invalidity of any claim finally determined to be valid and patentable on any ground which the third-party requester raised or could have raised during the inter partes reexamination proceedings. This subsection does not prevent the assertion of invalidity based on newly discovered prior art unavailable to the third-party requester and the Patent and Trademark Office at the time of the inter partes reexamination proceedings.

35 U.S.C. § 317 provides:

(a) **ORDER FOR REEXAMINATION.**— Notwithstanding any provision of this chapter, once an order for inter partes reexamination of a patent has been issued under section 313, neither the third-party requester nor its privies may file a subsequent request for inter partes reexamination of the patent until an inter partes reexamination certificate is issued and published under section 316, unless authorized by the Director.

(b) **FINAL DECISION.**— Once a final decision has been entered against a party in a civil action arising in whole or in part under section 1338 of title 28, that the party has not sustained its burden of proving the invalidity of any patent claim in suit or if a final decision in an inter partes reexamination proceeding instituted by a third-party requester is favorable to the patentability of any original or proposed amended or new claim of the patent, then neither that party nor its privies may thereafter request an inter partes reexamination of any such patent claim on the basis of issues which that party or its privies raised or could have raised in such civil action or inter partes reexamination proceeding, and an inter partes reexamination requested by that party or its privies on the basis of such issues may not thereafter be maintained by the Office, notwithstanding any other provision of this chapter. This subsection does not prevent the assertion of invalidity based on newly discovered prior art unavailable to the third-party requester and the Patent and Trademark Office at the time of the inter partes reexamination proceedings.

37 CFR 1.915(c) provides:

(c) If an *inter partes* request is filed by an attorney or agent identifying another party on whose behalf the request is being filed, the attorney or agent must have a power of attorney from that party or be acting in a representative capacity pursuant to § 1.34.

37 CFR 1.919(a) provides:

(a) The filing date of a request for *inter partes* reexamination is the date on which the request satisfies all the requirements for the request set forth in § 1.915.



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,299	08/24/2010	6549759	8934.009.RXUS00	1299
21967	7590	02/23/2011	EXAMINER	
HUNTON & WILLIAMS LLP INTELLECTUAL PROPERTY DEPARTMENT 1900 K STREET, N.W. SUITE 1200 WASHINGTON, DC 20006-1109			ART UNIT	PAPER NUMBER

DATE MAILED: 02/23/2011

Please find below and/or attached an Office communication concerning this application or proceeding.



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Date:

NOVAK DRUCE & QUIGG
1000 LOUISIANA STREET
WELLS FARGO PLAZA, 53RD FLOOR
HOUSTON, TX 77022

MAILED

FEB 23 2011

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001299

PATENT NO. : 6549759

TECHNOLOGY CENTER : 3999

ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

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If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Thomas Anderson
Hunton & Williams LLP
1900 K. Street, N.W.
Washington, D.C. 20006-1109

(For Patent Owner)

MAILED
FEB 23 2011

CENTRAL REEXAMINATION UNIT

Tracy W. Druce
Novak Druce & Quigg, LLP
1000 Louisiana Street
Wells Fargo Plaza, Fifty Third Floor
Houston, TX 77002

(For Third Party Requester)

Inter Partes Reexamination Proceeding
Control No. 95/001,299
Filed: August 24, 2010
For: U.S. Patent No. 6,549,759

: **DECISION DISMISSING REQUESTS**
: **TO WAIVE SERVICE,**
: **DISMISSING PETITIONS TO EXPUNGE**
: **AND RETURNING IMPROPER PAPERS**

This is a decision addressing the following submissions:

- (1) Jan. 7, 2011 Petition Under 37 CFR 1.183 to Waive the Requirement to Serve Documents to Third Party Requesters Under 37 CFR 1.550(f);
- (2) Jan. 7, 2011 Petition Under 37 CFR 1.59(b) to Expunge Copy of Papers in Reexamination File;
- (3) Jan. 7, 2011 Confidential Information Disclosure Statement;
- (4) Feb. 8, 2011 Petition Under 37 CFR 1.183 to Waive the Requirement to Serve Documents to Third Party Requesters Under 37 CFR 1.550(f);
- (5) Feb. 8, 2011 Petition Under 37 CFR 1.59(b) to Expunge Copy of Papers in Reexamination File; and
- (6) Feb. 8, 2011 Confidential Supplemental Information Disclosure Statement.

As identified above, patent owner has submitted two Confidential Information Disclosure Statements submitting information that has been designated as confidential during the concurrent litigation, with accompanying petitions to waive service on the third party requesters and to expunge the confidential information under 37 CFR 1.59(b).

The U.S. Patent & Trademark Office (the Office) will not accept information that has been designated by a court as confidential or subject to a protective order, or is a third party's confidential information, **absent express permission from the court or third party that the information may be submitted to the Office and may become part of the file open to the**

public.¹ Although provisions are provided for expunging confidential information by petition, as noted in MPEP § 724.04(c), if any portion or all of the submitted information is found to be material to patentability, the petition to expunge will be denied and the information will thereafter become a permanent part of the reexamination file and open to the public. The Office will not accept confidential information that may be later opened to the public without permission from a court or the owner of that information.

Patent owner has provided no evidence that the court or owner of the confidential information has granted permission to open the information to the public. Therefore, both Confidential Information Disclosure Statements are improper filings and will not be entered into the record. Patent owner may make arrangements to pick up the information within thirty (30) days of this decision as noted below or the information will be destroyed. The Patent Office cannot ensure that the confidentiality will be safeguarded during destruction.

The petitions to expunge the information are dismissed as moot, since the information will not be entered into the record or considered by the examiner. Further as noted in MPEP § 724.03 (emphasis added):

The types of materials or information contemplated for submission under MPEP § 724.02 include information "material to patentability" but **does not include information favorable to patentability**. Thus, any trade secret, proprietary, and/or protective order materials which are required to be submitted on behalf of a patent applicant under 37 CFR 1.56 or patent owner under 37 CFR 1.555 can be submitted in accordance with MPEP § 724.02. Neither 37 CFR 1.56 nor 1.555 require the disclosure of information favorable to patentability, e.g., evidence of commercial success of the invention (see 42 Fed. Reg. 5590). Such information should not be submitted in accordance with MPEP § 724.02. If any trade secret, proprietary, and/or protective order materials are submitted in amendments, arguments in favor of patentability, or affidavits under 37 CFR 1.131 or 1.132, they will be made of record in the file and will not be given any special status.

Patent owner indicates in the petitions to expunge that the information is not material to patentability, but does not indicate why the information is required to be submitted under 37 CFR 1.555 and thus be afforded the protection under MPEP § 724, i.e., maintaining the material in confidence. Thus, even if the information is resubmitted with the appropriate certification or consent to waive the confidentiality, a showing would need to be provided why the submission should be afforded the confidentiality protections of MPEP § 724.

The petitions to waive service are dismissed as moot, since the information will not be entered into the record or considered by the examiner. It is further noted that it is not possible to waive the requirement for service as it is a statutory requirement under 35 U.S.C. § 314(b)(1). 35 U.S.C. 314(b)(1) provides: "With the exception of the inter partes reexamination request, any document filed by either the patent owner or the third-party requester shall be served on the other

¹ The party submitting the information is to provide either:


A certification that the party filing the information in the reexamination proceeding has, prior to filing the information, informed the court of its intention to submit the information to the Office in a proceeding that will open the information to unlimited public access, if found to be material to patentability, and that the court has approved such submission, or

A copy of the consent by the entity whose information is being submitted waiving the confidentiality and protection of the protective order for the information.

party.” 37 CFR 1.183 is clear that it applies only to a “requirement of the regulations in this part which is not a requirement of the statutes, and it should be equally clear that a requirement of the statute cannot be waived.

To arrange for pick up of the returned papers, telephone inquiries are to be directed to Manuel Saldana at (571) 272-7740.

Telephone inquiries with regard to the substance of the decision should be directed to Caroline D. Dennison, Senior Legal Advisor, at (571) 272-7729.

A handwritten signature in cursive script, appearing to read "Kenneth M. Schor", is written over a horizontal line.

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

2-23-11
Kenpet8/IP
Kenpet8/expunge_seal/



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,299	08/24/2010	6549759	8934.009.RXUS00	1299
21967	7590	03/17/2011	EXAMINER	
HUNTON & WILLIAMS LLP INTELLECTUAL PROPERTY DEPARTMENT 1900 K STREET, N.W. SUITE 1200 WASHINGTON, DC 20006-1109			ART UNIT	PAPER NUMBER

DATE MAILED: 03/17/2011

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HOUSTON, TX 77022

Date: **MAILED**

MAR 17 2009

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001299

PATENT NO. : 6549759

TECHNOLOGY CENTER : 3999

ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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(For Patent Owner)

PROCOPIO, CORY, HARGREAVES & SAVITCH LLP
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SUITE 2200
SAN DIEGO CA 92101

MAILED

MAR 17 2011

(For Requester) CENTRAL REEXAMINATION UNIT

NOVAK DRUCE & QUIGG, LLP
(NDQ REEXAMINATION GROUP)
1000 LOUISIANA STREET
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HOUSTON, TX 77002

(Courtesy Copy)

HUNTON & WILLIAMS LLP
INTELLECTUAL PROPERTY DEPARTMENT
1900 K STREET, N.W.
SUITE 1200
WASHINGTON DC 20006-1109

In re: Arviv et alia
Reexamination Proceeding
Control No. 95/001,299
Corrected Request Deposited: August 24, 2010
For: U.S. Patent No. 6,549,759

:
: **DECISION**
: **DISMISSING**
: **PETITION**
:

The *inter partes* reexamination is before the Central Reexamination Unit to address the January 13, 2011 patent owner paper entitled "Petition Requesting Full Opportunity to Submit Amendment/Response as to New Claims 28-167" requesting that the examiner not close prosecution in the next office action.

As the office has not yet issued the next office action, the request is **dismissed as premature**. However, it should be noted that the examiner will follow the guidance in the MPEP as to making the next office a non-final office action or an action closing prosecution.

CONCLUSION

1. The Patent Owner petition is **dismissed as premature**.
2. Inquiries regarding this decision may be directed to Eric Keasel, Supervisory Patent Examiner, at (571) 272-4929.
3. This decision is not a final agency decision and is without prejudice to request reconsideration or higher-level review.

A handwritten signature in cursive script, reading "Eric Keasel", written over a horizontal line.

Eric Keasel

SPE, Central Reexamination Unit, Art Unit 3992



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,299	08/24/2010	6549759	8934.009.RXUS00	1299
21967	7590	04/04/2011	EXAMINER	
HUNTON & WILLIAMS LLP INTELLECTUAL PROPERTY DEPARTMENT 1900 K STREET, N.W. SUITE 1200 WASHINGTON, DC 20006-1109			ART UNIT	PAPER NUMBER

DATE MAILED: 04/04/2011

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Date:

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APR 04 2011

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001299

PATENT NO. : 6549759

TECHNOLOGY CENTER : 3999

ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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CENTRAL REEXAMINATION UNIT
(For Third Party Requester)

In re Eli Arviv *et al.*
Inter Partes Reexamination Proceeding
Control No. 95/001,299
Filed: August 24, 2010
For: U.S. Patent No. 6,549,759

:
: **DECISION**
: **GRANTING IN-PART**
: **PETITION**
:

This is a decision on third party requester's petition entitled "PETITION UNDER 37 C.F.R. § 1.183 TO WAIVE THE PROVISIONS OF 37 C.F.R. § 1.943(b) TO INCREASE THE NUMBER OF PAGES PERMITTED FOR REQUESTER'S WRITTEN COMMENTS BEYOND THE 50-PAGE LIMITATION," filed on December 16, 2010 ("the petition under 37 CFR 1.183").

Third party requester's December 16, 2010 petition under 37 CFR 1.183 is before the Office of Patent Legal Administration.

The instant petition under 37 CFR 1.183 is granted in-part, to the extent, and for the reasons set forth herein.

DECISION

Requester's December 16, 2010 petition under 37 CFR 1.183, requesting waiver of the 50-page limit of 37 CFR 1.943(b) for its concurrently-filed comments submission, has been fully considered.¹

37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party. The burden is on petitioner to set forth with specificity the facts that give

¹ Requester's December 16, 2010 comments submission includes numerous exhibits, including 20 patent and non-patent literature documents, 3 declarations and their attached exhibits (hereinafter referred to as the "Liu," "Kolze," and "Paepcke" declarations), and 3 documents related to co-pending litigation (2 deposition transcripts and the court's claim construction order).

rise to an extraordinary situation in which justice requires suspension of a rule. A showing which petitioner can make in support of a request for waiver of the 50-page limit of 37 CFR 1.943(b) can be an attempt to draft a response in compliance with the 50-page limit, and submission of a resulting response that is in excess of 50 pages concurrently with a petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b), requesting entry of the submitted response. Such a response can be evaluated for economizing, extraneous material, and arrangement, without repetition of information already of record. In this way, petitioner can rely on the proposed response: (1) for justification that more pages are needed to complete the response, and (2) to set forth an accurate determination of exactly how many additional pages petitioner deems to be needed to complete the response.

In the instant petition under 37 CFR 1.183, petitioner requests that the Office waive the page length requirement of 37 CFR 1.943(b) for requester's December 16, 2010 comments submission.² Specifically, petitioner requests waiver of the 50-page limit for entry of at least 84 pages of requester's December 16, 2010 comments submission (inclusive of the Liu and Paepcke declarations).³ In support of its request for waiver of the 50-page limit, petitioner asserts that "[t]he prosecution record to date clearly supports the requested page total, based upon the dramatic increase in the number of claims at issue" in the instant proceeding.⁴ Further in support of waiver of the page limit, petitioner asserts that:

... in accordance with MPEP § 2666.05(II), Requestors must do more than merely present a brief argument that new claims 28 through 167 are unpatentable. Instead, pursuant to MPEP § 2666.05(II), Requestors are asked to present proposed rejections of the newly added claims and a detailed discussion of the grounds of rejection proposed for the newly added claims, (which have increased the claims at issue in the present reexamination by approximately 500 percent), that would satisfy the requirements of MPEP § 2617, which Requestors have done. Requestors are also asked to satisfy any applicable requirements of 37 CFR § 1.948(a) in the event that the citation of new prior art is necessary to present newly proposed rejections of the additional claims.⁵

A document is deemed to be subject to the 50-page length requirement when the document includes legal argument, *i.e.*, arguments of counsel such as, *e.g.*, arguments that the claims are patentable or unpatentable, or that are directed to how an outstanding or proposed rejection is overcome, or, in the case of a document filed by the requester, how an outstanding or proposed rejection is supported. There are no *per se* rules for determining whether a document, such as an affidavit or declaration, contains a legal argument that will cause the document to be subject to the page count. Each determination is made on a case-by-case basis. In determining whether a document such as an affidavit or declaration under 37 CFR 1.132, or any other document of a submission, includes legal argument, the Office analyzes whether the document is providing factual evidence, *i.e.*, evidence of **technological** facts, or whether the document contains

² See petition under 37 CFR 1.183 at page 1.

³ *Id.* at page 7.

⁴ *Id.* (referring to the introduction of 140 new claims by patent owner's November 16, 2010 response).

⁵ *Id.* at page 6.

argument that is merely an extension of the arguments of counsel. Factual evidence includes, for example, declarations that swear behind the filing date of a reference, that establish the date of a printed publication, that provide a technical explanation or technical definition of terms of art used by a reference, or that provide comparative test results and a scientific, or technological, analysis of the results (see, *e.g.*, MPEP 716.02). If a document is limited to factual evidence, the document is not included in the page count. In addition, affidavits or declarations **limited to** establishing commercial success, long-felt need and failure of others, skepticism of experts, or copying, as per MPEP 716.03-716.06, respectively, will not be included in the page count.

In this instance, requester has made a showing in support of the request for waiver of 37 CFR 1.943(b) by submitting the December 16, 2010 comments submission that is in excess of 50 pages. Upon brief review, the December 16, 2010 comments submission includes 68 pages of comments. Additionally, 11 pages of the Liu declaration are being counted toward the page limit because the Liu declaration is deemed to be an extension of the arguments of counsel in that it includes arguments as to the obviousness of the combination of the teachings of the prior art. On the other hand, no pages of the Kolze and Paepcke declarations and no pages of the two deposition transcripts or of the court's claim construction order are being counted toward the page limit, as none of these documents appear to contain legal argument (*i.e.*, they are not deemed to be extensions of arguments of counsel). Thus, the 68 pages of comments and the 11 pages of the Liu declaration, resulting in a total of 79 pages, are being included in the page count.

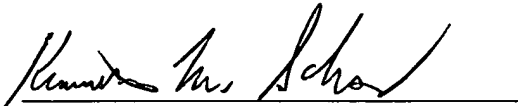
Based on the individual facts and circumstances of this case including, for example, the 140 claims newly added by the patent owner, it is deemed equitable to waive the 50-page limit of 37 CFR 1.943(b) in this instance. Thus, even though requester's December 16, 2010 comments submission exceeds the 50-page limit, it is still deemed equitable in this instance to waive the 50-page limit of 37 CFR 1.943(b) to the extent that requester's comments not exceed 79 pages.

As pointed out above, in the instant petition under 37 CFR 1.183, petitioner requests that the Office waive the page length requirement for requester's December 16, 2010 comments submission, to provide an extra 34 pages beyond the regulatory page limit; however, based on the above discussion, only 29 pages are needed. Accordingly, requester's petition under 37 CFR 1.183 is granted in-part and the page limit of 37 CFR 1.943(b) is waived to the extent of permitting requester's comments submission to exceed the page limit by up to 29 pages. This waiver makes requester's December 16, 2010 comments submission page-length compliant.

CONCLUSION

- Third party requester's December 16, 2010 petition under 37 CFR 1.183 is granted in-part and the page limit of 37 CFR 1.943(b) is waived to the extent of permitting the December 16, 2010 comments submission to exceed the page limit by up to 29 pages. This waiver makes requester's December 16, 2010 comments submission page-length compliant.

- Any questions concerning this communication should be directed to Nicole Dretar Haines, Legal Advisor, at (571) 272-7717.

A handwritten signature in black ink, appearing to read "Kenneth M. Schor", is written over a horizontal line.

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

4/4/11
Kenpaet8



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,299	08/24/2010	6549759	8934.009.RXUS00	1299

21967 7590 05/06/2011

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EXAMINER

ART UNIT

PAPER NUMBER

DATE MAILED: 05/06/2011

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CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001299

PATENT NO. : 6549759

TECHNOLOGY CENTER : 3999

ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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(For Patent Owner)

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MAY 06 2011

Novak Druce & Quigg, LLP
(NDQ Reexamination Group)
1000 Louisiana Street
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Houston, TX 77022

(For Third Party Requester)

CENTRAL REEXAMINATION UNIT

In re Arviv et al
Inter partes Reexamination Proceeding
Control No: 95/001,299
Filing Date: January 21, 2010
For: U.S. Patent No.: 6,549,759

:
:
: **DECISION DISMISSING**
:
: **PETITION TO**
:
: **TERMINATE *INTER PARTES***
:
: **REEXAMINATION PROCEEDING**

This is a decision on patent owner's March 29, 2011 petition entitled "Petition to Terminate" (the March 29, 2011 petition).

The March 29, 2011 petition, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

The \$400 fee under 37 CFR 1.17(f) for patent owner's March 29, 2011 petition has been paid.

SUMMARY

The March 29, 2011 patent owner petition under 37 CFR 1.182 to terminate the present *inter partes* reexamination proceeding is **dismissed**.

DECISION

The patent owner argues that termination of *inter partes* reexamination proceeding control number 95/001,299 (the '1299 proceeding) is required by 35 U.S.C. 317(b), which provides, in pertinent part (emphasis added):

Once a **final decision** has been entered against a party in a civil action arising in whole or in part under section 1338 of title 28, that the party has not sustained its burden of proving the invalidity of any patent claim in suit . . . then . . . an inter partes reexamination requested by that party or its privies on the basis of . . . issues [which that party or its privies raised or could have raised in such civil action] may not thereafter be maintained by the Office . . .

The Office analyzes whether a reexamination proceeding must be terminated pursuant to 35 U.S.C. 317(b) by determining whether:

1. The third party requester was a party to the litigation;
2. The decision is final, i.e., after all appeals;
3. The court decided that the requester/party had not sustained its burden of proving the invalidity of any claim in suit, which claim is also under reexamination; and
4. The issue(s) raised in the reexamination proceeding are the same issue(s) that were raised or could have been raised by the requester in the civil action.

The patent owner informs the Office that the patent under reexamination, U.S. Patent 6,549,759 (the '759 patent), was the subject of a civil action in district court, i.e., *Wi-Lan, Inc. v. Acer American Corp. et al.*, Civil Action No. 2:07-cv-473 (E.D.TX.). The patent owner submits a copy of two stipulated orders of dismissal, entered by the district court on January 31, 2011 and March 16, 2011, respectively. Co-defendants in the litigation included the third party requesters and real parties in interest in the present proceeding, i.e., Intel Corporation and Broadcom Corporation, respectively. The district court's order stated, in each case, that all claims presented by the patent owner/plaintiff, i.e., Wi-Lan Inc., and all counterclaims by the requester/defendant, i.e. Intel Corporation, and Broadcom Corporation, respectively, shall be dismissed with prejudice. In addition, the patent owner informs the Office that "the 30-day period for filing a notice of appeal under Rule 4 of the Federal Rules of Appellate Procedure has passed with respect to the January 31, 2011 order against Intel". The patent owner further states that it will "immediately notify the USPTO in the unlikely event that a notice of appeal is filed from the dismissal order against Broadcom before the 30-day period for appeal ends on April 16, 2011". To date, the Office has not received any notification from the patent owner regarding the filing of a notice of appeal from the March 16, 2011 dismissal order against Broadcom. The Office assumes, therefore, that no appeal has been filed. If this is not the case, the patent owner is **required** to so inform the Office within fifteen days of the mail date of this decision.

Thus, the third party requesters of the present proceeding were parties to the litigation, and the stipulated orders of dismissal by the district court are determined to be final decisions, after all appeals,¹ which satisfies item nos. 1 and 2.

In addition, the patent owner has submitted a copy of the court's docket for the civil action at issue, thus showing that the order was entered before trial commenced, i.e., at a sufficiently early stage of the litigation proceeding such that the requester/defendant could have introduced the prior art, and any other issues present in the '1299 reexamination proceeding, into the litigation, had the litigation not been terminated by the district court's stipulated orders of dismissal. In other words, the prior art, and any other issues present in the '1299 proceeding, "could have been raised" by the requester in the civil action, which satisfies item no. 4.

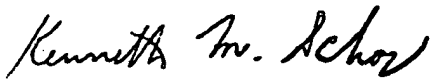
¹ The patent owner is reminded that the submission of the present petition on March 29, 2011, before the time period for filing a notice of appeal from the March 16, 2011 dismissal order, was premature, and would have been dismissed for this reason, had the present petition been taken up for action before April 16, 2011.

Item no. 3, however, has not been satisfied. The issue of invalidity has not been actually litigated in the present case. The present case solely involves two orders by the district court, separately dismissing, with prejudice, all claims by the patent owner/plaintiff, and all counterclaims by each requester/defendant, i.e., Intel Corporation and Broadcom Corporation, respectively. While such dismissals will bar a subsequent suit, they do not, themselves “establish any facts to which the doctrine of collateral estoppel can be applied in a later litigation on a different claim.” Wright & Miller, *Federal Practice and Procedure*, § 2373 (2008). Furthermore, the patent owner in the present case *points to no language in the court’s dismissals that suggests that the parties, or the court, intended the dismissal to resolve the invalidity issue*. There is nothing in the documents submitted by the patent owner that amounts to a decision that the requesters/parties did not sustain their burden of proving the invalidity of any patent claim in suit, as required by 35 U.S.C. 317(b). Instead, the civil action appears to have been dismissed without there ever being an assessment of whether the parties sustained their burden, and without the parties agreeing, through a stipulated judgment or otherwise, that the burden of proving claim invalidity had not been met. Thus, the patent owner has not provided any evidence of a final decision by a federal court that the requesters/co-defendants in *Wi-Lan, Inc.* did not sustain their burden of proving invalidity of any claim in suit of the patent under reexamination, as required by 35 U.S.C. 317(b). For these reasons, item no. 3 has not been satisfied.

Accordingly, the March 29, 2011 patent owner petition under 37 CFR 1.182 to terminate an *inter partes* reexamination proceeding is **dismissed**.

CONCLUSION

- The March 29, 2011 patent owner petition under 37 CFR 1.182 to terminate *inter partes* reexamination is **dismissed**.
- Any inquiry concerning this communication should be directed to Cynthia Nessler, Senior Legal Advisor, at (571) 272-7724, or in her absence, to the undersigned at (571) 272-7710.



Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

5-05-2011
Kenpet8



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,299	08/24/2010	6549759	8934.009.RXUS00	1299
21967	7590	07/22/2011	EXAMINER	
HUNTON & WILLIAMS LLP INTELLECTUAL PROPERTY DEPARTMENT 2200 Pennsylvania Avenue, N.W. WASHINGTON, DC 20037			ART UNIT	PAPER NUMBER

DATE MAILED: 07/22/2011

Please find below and/or attached an Office communication concerning this application or proceeding.



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MAILED
Date: JUN 22 2011
CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001299

PATENT NO. : 6549759

TECHNOLOGY CENTER : 3999

ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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(For Patent Owner)

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JUL 22 2011

CENTRAL REEXAMINATION UNIT

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Houston, TX 77022

(For Third Party Requester)

In re Arviv et al	:	
Inter partes Reexamination Proceeding	:	DECISION DENYING
Control No: 95/001,299	:	PETITION TO
Filing Date: January 21, 2010	:	TERMINATE <i>INTER PARTES</i>
For: U.S. Patent No.: 6,549,759	:	REEXAMINATION PROCEEDING

This is a decision on patent owner's June 21, 2011 renewed petition entitled "Supplemental Petition to Terminate" (the June 21, 2011 renewed petition).

The June 21, 2011 renewed petition, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

SUMMARY

The June 21, 2011 renewed petition under 37 CFR 1.182 by the patent owner to terminate the present *inter partes* reexamination proceeding is **denied**.

This decision is designated as a final agency action under 5 U.S.C. § 704.

DECISION

The patent owner again argues that termination of *inter partes* reexamination proceeding control number 95/001,299 (the '1299 proceeding) is required by 35 U.S.C. 317(b), which provides, in pertinent part (emphasis added):

Once a ***final decision*** has been entered against a party in a civil action arising in whole or in part under section 1338 of title 28, that the party has not sustained its burden of proving the invalidity of any patent claim in suit . . . then neither that party nor its privies may thereafter request an *inter partes* reexamination of any such patent claim on the basis of issues which that party or its privies ***raised or could have raised*** in such civil action . . . and an *inter partes*

reexamination requested by that party or its privies on the basis of such issues may not thereafter be maintained by the Office . . .

The Office analyzes whether a reexamination proceeding must be terminated pursuant to 35 U.S.C. 317(b) by determining whether:

1. The third party requester was a party to the litigation;
2. The decision is final, i.e., after all appeals;
3. The court decided that the requester/party had not sustained its burden of proving the invalidity of any claim in suit, which claim is also under reexamination; and
4. The issue(s) raised in the reexamination proceeding are the same issue(s) that were raised or could have been raised by the requester in the civil action.

In the renewed petition, the patent owner points out that the Office determined, in the earlier Office decision of May 6, 2011, that elements 1, 2, and 4 are satisfied in the present case.¹ The Office also determined, in the May 6, 2011 decision, that element 3 was not satisfied, and after reconsideration, that determination is maintained.

The patent owner, in its renewed petition, argues that the requesters of the present proceeding have settled *Wi-Lan, Inc. v. Acer American Corp. et al.*, Civil Action No. 2:07-cv-473 (E.D. Tex.) involving the patent under reexamination U.S. Patent 6,549,759 (the ‘759 patent) (“the litigation”). The patent owner states that the requesters, Intel and Broadcom, have “agreed to have their claims of invalidity of the ‘759 patent dismissed with prejudice, and [have] submitted a paper with the USPTO stating that as a result of the litigation settlement they will not be participating further in this *inter partes* reexamination.” The patent owner points to the stipulated orders of dismissal by the district court, arguing that the court “dismiss[ed] [the requesters’] claims that the ‘759 patent is invalid carrying into effect the parties’ settlement agreement”. The patent owner asserts that “[u]nder these circumstances, [the requesters] would be estopped from arguing that the ‘759 patent is invalid in subsequent litigation involving the accused products under the doctrine of claim preclusion”. The patent owner further asserts that “[b]ecause the dismissal order dismissed claims that the ‘759 patent was invalid and did not strike down the patent, there was no need to include language in the order that that patent was being upheld in order for claim preclusion to prevent re-litigation of the validity issues.” Finally, the patent owner argues that the “actually litigated” element of issue preclusion is inapplicable to 35 U.S.C. 317(b), and that the statute does not require that the issue of invalidity be actually litigated.

The provisions of the *inter partes* reexamination statute, however, do not expressly incorporate the doctrine of claim preclusion or the doctrine of issue preclusion. 35 U.S.C. 317(b) is the sole source of preclusion of *inter partes* reexamination, and it incorporates only elements of each doctrine. Claim preclusion generally refers to “the effect of foreclosing any litigation of matters that *never have been litigated*, because of a determination that they *should have been advanced* in an earlier suit” 18 Charles Alan Wright, Arthur R. Miller & Edward H. Cooper, Federal

¹ Regarding the March 16, 2011 dismissal order against one of the requesters, Broadcom, the Office determined in the May 6, 2011 decision, and the patent owner verifies in the present renewed petition, that the 30-day period for filing a notice of appeal has passed with respect to that order, without any appeal having been filed.

Practice and Procedure § 4402 (2d ed. 2002).² Issue preclusion refers to “the effect of foreclosing relitigation of matters that have once been litigated and decided”. Wright, Miller & Cooper § 4402. A principle distinction between claim preclusion and issue preclusion is that the former forecloses litigation of matters that have *never been litigated*.³ 35 U.S.C. 317(b) prohibits a requester from requesting, and the Office from maintaining, an *inter partes* reexamination of a patent claim on the basis of issues which the requester *raised, or could have raised*, in a civil action as defined in the statute. In other words, the statute forecloses *inter partes* reexamination on the basis of issues that *have been litigated* (i.e., *raised*), which is an element of issue preclusion. The statute also forecloses *inter partes* reexamination on the basis of issues that have not been litigated, but *should have been advanced* (i.e., *could have been raised*), which is the primary element of claim preclusion. The statute, however, does not incorporate the entirety of either doctrine.

The doctrine of claim preclusion, itself, applies to civil actions, not to reexamination proceedings. A reexamination proceeding is not a civil action.⁴ Reexamination proceedings are limited to a review of patents and printed publications, unlike a civil action, which is not so limited. The standards of the Office in determining the patentability of patent claims differ from those used in the courts to determine invalidity. In civil litigation, a challenger who attacks the validity of patent claims must overcome the presumption of validity with clear and convincing evidence that the patent is invalid. In examinations and reexaminations within the Office, there is no presumption of validity and the standard of proof, a preponderance of evidence, is lower than the clear and convincing standard in a civil action. In reexamination proceedings, claims are given their broadest reasonable interpretation, consistent with the specification, unlike the standard used in district courts. See also *In re Etter*, 756 F.2d 852, 856 (Fed. Cir. 1985)⁵:

Reexamination[s are] conducted according to the procedures established for initial examination,” 35 U.S.C. § 305, and PTO examination procedures have distinctly different standards, parties, purposes, and outcomes compared to civil litigation.

Furthermore, one of the essential elements of claim preclusion (*res judicata*), is the involvement of the same parties, or parties in privity with the original parties.⁶ See *In re Trans Texas Holdings Corp.*, 498 F.3d 1290, 83 USPQ2d 1835 (Fed. Cir. 2007), in which the court held that issue preclusion could not be applied against the Office based on a district court holding in an

² See also *Jet, Inc. v. Sewage Aeration Systems*, 223 F.3d 1360, 1362; 55 USPQ2d 1854 (Fed. Cir. 2000), quoting *Migra v. Warren City School Dist. Bd. of Educ.*, 465 U.S. 75, 77 n.1, 104 S.Ct. 892 (1984).

³ See, e.g., *Black's Law Dictionary*, definition of “claim preclusion”, quoting Charles Alan Wright, *The Law of Federal Courts*, §100A, at 723.

⁴ A reexamination proceeding is a creature of statute and regulation, and rights in a reexamination proceeding must be conferred by the statute and regulations. For *inter partes* reexamination, Congress enacted the extent of preclusion via 35 U.S.C. § 317, and that is the extent to which preclusion is limited.

⁵ See also *Ethicon v. Quigg*, 849 F.2d 1422, 1428 (Fed. Cir. 1988) (citations omitted): “[C]hallenging validity in a court and requesting PTO reexamination are ‘concepts not in conflict’”.

⁶ See *Hallco v. Foster*, 256 F.3d 2190, 59 USPQ2d 1346 (Fed. Cir. 2001): “Simply put, the doctrine of *res judicata* provides that when a final judgment has been entered on the merits of a case, ‘it is a finality as to the claim or demand in controversy, concluding parties and those in privity with them, not only as to every matter which as offered and received to sustain or defeat the claim or demand, but as to any other admissible matter which might have been offered for that purpose’.” (citations omitted) (emphasis added). See also the definition of “*res judicata*”, *Black's Law Dictionary*, 7th Ed., (1999), quoting *Restatement (Second) of Judgments*, §§17, 24 (1982).

infringement proceeding, because the Office was not a party to the earlier infringement proceeding. See also *Houston Atlas, Inc. v. Del Mar Scientific, Inc.*, 217 USPQ 1032, 1037 (N.D. Tex. 1982, *aff'd*, 703 F.2d 555 (5th Cir. 1983), in which the court stated that “[t]he Patent Office was not a party to the original proceedings, and . . . the consent judgment is not binding on the Patent Office or the public which it represents.”

For these reasons, the doctrine of claim preclusion itself is not applicable to reexamination proceedings. 35 U.S.C. 317(b), which is applicable to reexamination proceedings, stands by itself. In fact, if the doctrine of claim preclusion were applicable to reexamination in general, then there would have been no need for Congress to expressly provide for the specific provisions of 35 U.S.C. 317(b) (or, for that matter, of 35 U.S.C. 317(c)) of the *inter partes* reexamination statute.

The statutory estoppel provisions do not apply, and the maintenance of an *inter partes* reexamination proceeding by the Office is not precluded unless a final decision has been rendered against a party/requester in a civil action (arising under section 1338 of title 28), that the party/requester has not sustained its burden of proving the invalidity of any patent claim in suit, where the patent claim in suit is also under reexamination. Thus, it is reasonable and proper for the Office to require the patent owner to provide evidence specifically showing that a final decision that the requesters/co-defendants have not sustained their burden of proving the invalidity of the claims of the ‘759 patent has been rendered by the district court.

The January 31, 2011 district court order simply states that “[a]ll claims between Wi-LAN and Intel, including all claims presented by Wi-LAN’s Complaint and all of Intel’s counterclaims, shall be dismissed with prejudice”. Similarly, the March 16, 2011 district court order simply states that “[a]ll claims between Wi-LAN and Broadcom, including all claims presented by Wi-LAN’s Complaint and all of Broadcom’s counterclaims, shall be and are dismissed with prejudice.” There is no language in the court’s dismissals that suggests that the parties and the court intended the dismissal to resolve the issue of whether any party sustained its burden of proving the invalidity of any patent claim in suit. There is nothing in the documents submitted by the patent owner that would evidence the parties’ intent at settlement, or the court’s intent in dismissing the all of the claims and counterclaims with prejudice. For example, it is equally possible that the parties settled the litigation because they agreed that the requesters were not infringing the patent owner’s patents, including the patent under reexamination, or that, for purely business purposes, it was economically advantageous for one or both of the parties to settle the litigation. The language of the court’s dismissal, in such cases, could be identical to the language of the court’s dismissal in the present case. The patent owner has submitted no evidence to suggest that the court, or the parties, conducted an assessment of whether the requesters sustained their burden, and that the parties specifically agreed, through a stipulated judgment or otherwise, that the burden of proving claim invalidity had not been met.

At most, the agreement evinces the parties’ intent that the invalidity counterclaims cannot be raised in future litigation between the parties. That prohibition against future action is the result of conventional estoppel doctrines, a result that was achieved in the litigation through agreement. 35 U.S.C. 317(b), however, requires more. It requires a final decision that demonstrates the failure to sustain the burden of proving invalidity. In other words, to the extent that 35 U.S.C.

317(b) can be triggered through settlement, the settlement must demonstrate the failure to prove invalidity, not merely the agreement not to allege invalidity in the future.

Contrary to patent owner's arguments, the Office never determined that the issue of invalidity must be actually litigated in order for the provisions of 35 U.S.C. 317(b) to apply. The Office merely noted in the May 6, 2011 decision that the issue of invalidity had not been actually litigated in the present case, and the court's stipulated orders of dismissal do not contain a statement that the requester has not sustained its burden of proving the invalidity of any patent claim in suit. If the invalidity issue had been litigated prior to the issuance of the court's stipulated orders of dismissal, which is not the case here, then the court's dismissals could have been interpreted by the Office in light of the court's holding on the invalidity issue. If the invalidity issue has not been litigated, which is the case here, the patent owner must provide evidence to show that the provisions of 35 U.S.C. 317(b) have been met, including a showing that the court rendered a final decision that the requesters did not sustain their burden of proving the invalidity of the patent claims. In other words, the patent owner must show that the settlement agreement spoke not just about future activities, but clearly expressed the failure to prove invalidity in the litigation. The patent owner has not done so.

The patent owner also argues that the fact that the court's dismissals do not include a reservation clause provides evidence that the court's dismissals are a final decision that the requesters have not sustained their burden of proving the invalidity of the patent claims. The absence of a reservation clause in the court's dismissals, however, may merely be due to the parties' settlement agreement, which may have been reached for purely business purposes. It does not provide evidence that the court assessed whether the requesters sustained their burden of proving claim invalidity, or that the parties specifically agreed that the burden of providing claim invalidity had not been met.

Finally, the patent owner appears to argue that the fact that the requesters filed a paper in the present proceeding on January 26, 2011, specifically informing the Office that they will not be further participating in the present reexamination proceeding (requesters' January 26, 2011 statement) provides evidence that the requesters did not sustain, in the litigation, the burden of proving the invalidity of the claims of the '759 patent. Again, however, the parties could have settled, for example, for purely business purposes, and the requesters may have filed the statement in order to comply with the parties' settlement agreement. The patent owner has submitted no evidence that the court's stipulated orders of dismissal, with or without requester's January 26, 2011 statement, is a final decision that the requesters did not sustain their burden of proving the invalidity of the '759 patent claims in suit.

In the absence of a showing that the provisions of 35 U.S.C. 317(b) have been met, the Office is *required by statute to continue prosecution* of an *inter partes* reexamination proceeding. See 35 U.S.C. 313, which provides (emphasis added):⁷

⁷ See also MPEP 2610, which provides, in pertinent part (emphasis added);

After the request for inter partes reexamination, including the entire fee for requesting reexamination, is received in the Office, **no abandonment, withdrawal, or striking, of the request is possible, regardless of who requests the same.** In some limited circumstances, such as after a final court decision where all of the claims are held invalid, a reexamination

If, in a determination made under section 312(a), the Director finds that a substantial new question of patentability affecting a claim of a patent is raised, the determination **shall include** an order for inter partes reexamination of the patent **for resolution of the question**.

Thus, in the absence of a sufficient showing that the provisions of 35 U.S.C. 317(b) have been met, the Office is required by statute to continue prosecution of the present proceeding.

For the reasons given above, the patent owner has not provided a sufficient showing that a final decision that the requesters/co-defendants in *Wi-Lan, Inc.* did not sustain their burden of proving invalidity of any claim in suit of the patent under reexamination was rendered by the district court. Thus, the provisions of 35 U.S.C. 317(b) have not been shown to have been satisfied.

Accordingly, the June 21, 2011 patent owner petition under 37 CFR 1.182 to terminate an *inter partes* reexamination proceeding is **denied**.

CONCLUSION

- The June 21, 2011 patent owner petition under 37 CFR 1.182 to terminate *inter partes* reexamination is **denied**.
- This decision is designated as a final agency action under 5 U.S.C. § 704.
- Any further correspondence with respect to this matter should be addressed as follows:

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By Hand: Customer Service Window
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Alexandria, VA 22314

- Any inquiry concerning this communication should be directed to Cynthia Nessler, Senior Legal Advisor, at (571) 272-7724.



Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

7-21-2011
Kenpet8/...



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,299	08/24/2010	6549759	8934.009.RXUS00	1299
21967	7590	12/09/2011	EXAMINER	
HUNTON & WILLIAMS LLP INTELLECTUAL PROPERTY DEPARTMENT 2200 Pennsylvania Avenue, N.W. WASHINGTON, DC 20037			ART UNIT	PAPER NUMBER

DATE MAILED: 12/09/2011

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CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001299

PATENT NO. : 6549759

TECHNOLOGY CENTER : 3999

ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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(For Third Party Requester)

Inter Partes Reexamination Proceeding
Control No.: 95/001,299
Filed: January 21, 2010
For: U.S. Patent No. 6,549,759

: **DECISION DISMISSING**
: **PETITION FOR WAIVER**
: **OF 37 CFR 1.955 FOR**
: **ONE-TIME INTERVIEW**
:

This is a decision on patent owner's "PETITION FOR EXAMINER INTERVIEW," filed on September 27, 2011.

The patent owner petition is before the Office of Patent Legal Administration.

The petition is dismissed.

BACKGROUND

1. On April 15, 2003, U.S. Patent No. 6,549,759 ("the '759 patent") issued to Arviv *et al.*
2. On January 21, 2010, a request for *inter partes* reexamination was filed by a third party requester,¹ which was assigned control no. 95/001,299 ("the '1299 proceeding").
3. On February 26, 2010, reexamination was ordered in the '1299 proceeding.
4. On January 26, 2011, third party requester filed a paper entitled "REQUESTERS BROADCOM AND INTEL HEREBY PROVIDE NOTICE THAT THIRD PARTY

¹ Requester in the present proceeding consists of two parties Broadcom Corp. and Intel Corp.

REQUESTERS WILL NO LONGER PARTICIPATE IN THE ABOVE MENTIONED REEXAMINATION PROCEEDINGS” in the ‘1299 proceeding.

5. On September 27, 2011, patent owner filed the instant petition paper entitled “PETITION FOR EXAMINER INTERVIEW.”
6. Prosecution in the ‘1299 proceeding has advanced to issuance of a Right of Appeal Notice on November 4, 2011.

DECISION

35 U.S.C. § 314 provides, in part:

(a) IN GENERAL.— Except as otherwise provided in this section, reexamination shall be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133. In any *inter partes* reexamination proceeding under this chapter, the patent owner shall be permitted to propose any amendment to the patent and a new claim or claims, except that no proposed amended or new claim enlarging the scope of the claims of the patent shall be permitted.

(c) SPECIAL DISPATCH.— Unless otherwise provided by the Director for good cause, all *inter partes* reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, shall be conducted with special dispatch within the Office.

37 CFR 1.955 provides:

There will be no interviews in an *inter partes* reexamination proceeding which discuss the merits of the proceeding.

The instant petition under 37 CFR 1.183 has been fully considered. In the instant petition, petitioner patent owner requests waiver of 37 CFR 1.955, which prohibits interviews in *inter partes* reexamination. In particular, petitioner requests that it be granted an examiner interview in the ‘1299 proceeding asserting that “[t]he lack of further participation of third party requesters and the statutory need to conduct this reexamination with “special dispatch” adequately justifies the lifting the [*sic*] prohibition on interviews set forth in 37 C.F.R. § 1.955.”²

37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party. The burden is on petitioner to set forth with specificity the facts that give rise to an extraordinary situation in which justice requires suspension of a rule. In support of its request for waiver of 37 CFR 1.955, petitioner asserts that: (1) third party requesters have withdrawn from this *inter partes* reexamination of the ‘759 patent, (2) the interview would advance prosecution of the ‘1299 proceeding.³

² See September 27, 2011 petition under 37 CFR 1.183 at page 2.

³ See *id.*

A review of the *Notice of Final Rule Making, Rules to Implement Optional Inter Partes Reexamination Proceedings*, 65 FR 76755 (Dec. 7, 2000), 1242 *Off. Gaz. Pat. Office* 12 (Jan. 2, 2001) (final rule) reveals that the Notice of Proposed Rule Making had proposed implementation of a regulation that would have permitted interviews in *inter partes* reexamination proceedings. In the final rule, however, the Office decided to preclude both *ex parte* and *inter partes* interviews in an *inter partes* reexamination proceeding, and accordingly published 37 CFR 1.955 in its present form. The Office concluded that, for a variety of reasons, "[n]o matter what the structure of the interview, the presence of a third party requester (or a separate interview with the requester) will complicate the reexamination proceeding and significantly delay it." Thus, the key basis for the present 37 CFR 1.955 proscription of all and any interviews in an *inter partes* reexamination proceeding was that the presence of two (or more) parties in the proceeding would interfere with the Office's ability to conduct an *inter partes* reexamination proceeding with special dispatch as mandated by 35 U.S.C. § 314.

In this instance, the third party requesters have stated on the record that they will not further participate in the '1299 *inter partes* reexamination proceeding.⁴ Thus, only a single party (patent owner) will now participate in the '1299 proceeding, and any interview that might be permitted in the proceeding. Further, petitioner asserts in the instant petition that the Office has granted an examiner interview under the same facts and circumstances of the present proceeding for *inter partes* reexamination proceeding 95/000,274 (the '274 proceeding).⁵ Patent owner is, however, silent with regards to what issues would be addressed in an interview if granted.

Regarding the '274 proceeding, an interview was granted based upon evidence on the record that the third party requester would not participate, had expressly waived all rights in the proceeding and would not be prejudiced by the conduct of an interview. Proceedings are addressed on a case-by-case basis, and decisions on petition in a prior proceeding do not serve as binding precedent upon the Office. Further, the present proceeding's record does not reflect the same facts and circumstances that existed on the record in the '274. Accordingly, patent owner's attempt to use the '274 proceeding to justify the granting of a interview is not persuasive. Furthermore, patent owner has not focused the matters at issue in the proceeding to be discussed at the interview. As pointed out above, patent owner is silent with regard to what will be discussed in any granted interview. The petition merely indicates a basic desire to hold an interview. Thus, patent owner has not sufficiently focused the issues to be addressed at the interview, and instead provided nothing more than a desire to have an interview.

Should patent owner correct the matter identified above and sufficiently focus the issues to be discussed during the interview, it could be found that permitting a single interview to be conducted at this point in the '1299 *inter partes* proceeding may well assist the Office in expeditiously resolving the proceeding. If patent owner chooses to present a petition to address the above-identified matters, patent owner is to immediately renew it, given the Office's statutory requirement (35 U.S.C. § 314(c)) to conduct reexaminations with special dispatch.

⁴ See January 26, 2011, third party requesters filed paper entitled "REQUESTERS BROADCOM AND INTEL HEREBY PROVIDE NOTICE THAT THIRD PARTY REQUESTERS WILL NO LONGER PARTICIPATE IN THE ABOVE MENTIONED REEXAMINATION PROCEEDINGS."

⁵ January 26, 2011 petition under 37 CFR 1.183 at page 2.

Patent owner is called upon to explain why the present petition for waiver of the interview prohibition was not filed earlier in the prosecution. Even if waiver is ultimately granted, that would only remove the bar of the rule; it will be still be the decision of the examiner as to whether to grant the interview. In this instance, the proceeding has advanced to issuance of a Right of Appeal Notice.

CONCLUSION

1. Patent owner's September 27, 2011 petition under 37 CFR 1.183 to waive the provisions of 37 CFR 1.955 is dismissed.
2. Any questions concerning this communication should be directed to Joseph F. Weiss, Jr., Legal Advisor, Office of Patent Legal Administration, at (571) 272-7759.

/Kenneth M. Schor/

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration



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95/001,299	08/24/2010	6549759	8934.009.RXUS00	1299

21967 7590 02/08/2011

HUNTON & WILLIAMS LLP
INTELLECTUAL PROPERTY DEPARTMENT
2200 Pennsylvania Avenue, N.W.
WASHINGTON, DC 20037

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 02/08/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Date:

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HOUSTON, TX 77022

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001299

PATENT NO. : 6549759

TECHNOLOGY CENTER : 3999

ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

**Decision Granting 37 CFR 1.59
Petition in Reexamination**

Control No.: 95/001,299

1. The petition under 37 CFR 1.59 to expunge proprietary, protective order and/or trade secret documents under 37 CFR 1.59 filed 4/13/2011 is granted.
2. The Patent owner's representative requests expungement of document(s) that have been filed under MPEP 724.02. The examiner has determined that the information in such document(s) presented under seal are not material to patentability in the instant reexamination proceeding. Further, the petitioner has complied with all of the requirements of MPEP 724.05.

A. ☒ Since the petition does not specify otherwise, the documents have been:

- i. ☒ Destroyed.
- ii. ☐ Expunged.

B. ☐ Other/Comment:

3. CONCLUSION

Telephone inquiries with regard to this decision should be directed to Daniel Ryman at (571)272-3152. In his/her absence, calls may be directed to Mark Reinhart at (571)272-1611 in the Central Reexamination Unit

/Daniel Ryman/
[Signature]

SPE, AU 3992
(Title)



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United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,300	01/22/2010	7478140	ZUMBOX-001	1554
919	7590	08/31/2011	EXAMINER	
PITNEY BOWES INC. INTELLECTUAL PROPERTY & TECH. LAW DEPT. 35 WATERVIEW DRIVE MSC 26-22 SHELTON, CT 06484			ART UNIT	PAPER NUMBER

DATE MAILED: 08/31/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
LAW OFFICE OF DAVID H. JUDSON
15950 DALLAS PARKWAY
SUITE 225
DALLAS, TX 75248

Date:

MAILED

AUG 31 2011

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001300
PATENT NO. : 7478140
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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George M. Macdonald
PITNEY BOWES SOFTWARE, INC
Intellectual Property and Technology Law Department
35 Waterview Drive, MSC 26-22
Shelton, CT 06484

(For Patent Owner)

MAILED

AUG 31 2011

CENTRAL REEXAMINATION UNIT

Law Offices of David H. Judson
15950 Dallas Parkway
Suite 225
Dallas, TX 75248

(For Third Party Requester)

In re Application of: King *et al.*
Control No. 95/001,300
Filed: January 22, 2010
For: U.S. Patent No. 7,478,140 B2

: **DECISION**
: **DISMISSING**
: **PETITIONS**
:

This is a decision on (1) Patent Owner's petition, filed on June 22, 2010, which requests that the Director strike the Requestor's Comments submitted on June 16, 2010 for failure to comply with 37 CFR 1.943, and (2) Requestor's petition, filed on June 28, 2010, which seeks relief under 37 CFR 1.181 requesting that the Director dismiss Patent Owners petition filed on June 22, 2010. The Requestor's petition also requests for the opportunity to re-submit Comments or alternatively to have the first 50 pages of the Comments filed on June 16, 2010 accepted as proper and timely. The petition and opposition are being treated as petitions under 37 CFR 1.181.

Both petitions are before the Director of Technology Center 1600, who oversees the Central Reexamination Unit.

The Petition to Strike filed by the Patent Owner on June 22, 2010, is dismissed as premature.

The Opposition Petition filed by the Requestor on June 28, 2010 is dismissed as premature.

STATEMENT OF RELEVANT FACTS

1. U.S. Patent No. 7,478,140 B2 (the '140 patent) issued on January 13, 2009.
2. A request for reexamination of the '140 patent was filed on January 22, 2010. The request was assigned control No. 95/001,300 (the '300 reexamination proceeding).
3. On March 15, 2010, the Office ordered that the patent be reexamined, finding that requester had raised a substantial new question of patentability as to claims 1-20 of '140 patent. On the same day, the Office mailed an Office action.
4. On May 17, 2010, the Patent Owner's response was timely filed with an amendment, including proposed amendments to patent claims 8 and 20 and proposed new claims 21-110. Patent Owner's response is 35 pages. Patent Owner also filed a declaration under 37 CFR 1.132, which is 77 pages, and a second declaration under 37 CFR 1.132, which is 28 pages.
5. On June 16, 2010, the Requestor filed Comments to Patent Owner's response. The comments paper is 86 pages in length. The Requester also filed two declarations under 37 CFR 1.132 in reply to Patent Owner's response. One declaration is 14 pages and the other declaration is 3 pages.
6. On June 22, 2010, the Patent Owner filed the instant petition, which is treated as under 37 CFR 1.181 requesting supervisory review on whether the Requestor's Comments fail to comply with page length requirements of 37 CFR 1.943.
7. On June 28, 2010, the Requester filed an opposition, which is treated as a petition under 37 CFR 1.181 requesting that the Director dismiss Patent Owner's petition filed on June 22, 2010.

DECISION

As pointed out, the Patent Owner filed a June 22, 2010 petition, which is being treated as a petition under 37 CFR 1.181 to invoke supervisory authority to not enter the June 16, 2010 comments. On June 28, 2010, Requester filed an opposition to Patent Owner's June 22, 2010 petition. However, there has been no decision by the examiner if the Requester's June 16, 2010 comments are in compliance with Office rules and procedures. Accordingly, it is premature to invoke supervisory authority regarding entry or refusal to enter the June 16, 2010 comments because the examiner has not made his or her decision. Thus, the Patent Owner's June 22, 2010 petition and third party Requester's June 28, 2010 opposition are premature, and they are dismissed.

CONCLUSION

1. The June 22, 2010 patent owner petition is **dismissed as premature**.
2. The June 28, 2010 requester opposition petition is **dismissed as premature**.
3. Telephone inquiries related to this decision should be directed to Eric Keasel, Supervisory Patent Examiner, at (571) 272-4929.



Irem Yucel, Director
Technology Center 1600



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,307	03/17/2010	7542610	OJOS.P106REX	4791
30554	7590	03/21/2011	EXAMINER	
MAHAMEDI PARADICE KREISMAN LLP 550 Winchester Boulevard Suite 605 SAN JOSE, CA 95128			ART UNIT	PAPER NUMBER

DATE MAILED: 03/21/2011

Please find below and/or attached an Office communication concerning this application or proceeding.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

LIKE.COM
Patent Owner

SUPERFISH, INC.
Third Party Requester

Inter partes Reexamination Control 95/001,307
Patent 7,542,610

DECISION ON PETITION

This is a decision on “Respondent /Patent Owner’s Petition Under 37 C.F.R. § 1.182 to Find Appellant/Requester’s Appeal Brief Not In Compliance With 37 C.F.R. § 41.67(c),” filed October 15, 2010 (“Petition”). Also considered was ‘Third-Party Requester’s Opposition to Respondent/Patent Owner’s Petition Under 37 C.F.R. § 182 to Find Requester’s Brief on Appeal Not In Compliance with 37 C.F.R. § 41.67(c),” filed October 29, 2010 (Opposition).

In the Petition, Patent Owner requests “that the Patent Office refuse consideration of [Third Party Requester’s Appellant Brief] filed on September 15, 2010 because the Appellant Brief raises several new grounds for rejection . . . and because the Appellant Brief fails to provide a concise explanation of the claims” Petition, p. 1.

FINDINGS

1. Patent 7,542,610 issued June 2, 2009 containing 25 claims. The '610 patent is assigned to Patent Owner Like.Com
2. On March 17, 2010, Requester Superfish, Inc. ("Superfish") filed a corrected request for reexamination of the '610 patent.
3. On April 26, 2010, the Office granted the request for reexamination under control 95/001,307.
4. Also on April 26, 2010, the Office issued an Action Closing Prosecution, confirming claims 1-25.
5. On June 16, 2010, the Office issued a Right of Appeal Notice, confirming claims 1-25.
6. On July 15, 2010, Superfish filed a Notice of Appeal.
7. On September 15, 2010, Superfish filed an Appellant Brief.
8. On October 15, 2010, Like.Com filed the present Petition.
9. Also on October 15, 2010, Like.Com filed a Respondent Brief.
9. On October 29, 2010, Superfish filed the present Opposition.
10. On December 29, 2010, the Examiner issued an Answer, stating:
This Examiner's Answer does not contain any new ground of rejection and any new determination not to make a proposed rejection.
11. On January 27, 2011, Superfish filed a Rebuttal Brief.

RELEVANT AUTHORITY

Concerning the contents of appellant briefs, 37 C.F.R.

§ 41.67(c)(1)(vi) provides:

(vi) *Issues to be reviewed on appeal.* A concise statement of each issue presented for review. No new ground of rejection can be proposed by a

third party requester appellant, unless such ground was withdrawn by the examiner during the prosecution of the proceeding, and the third party requester has not yet had an opportunity to propose it as a third party requester proposed ground of rejection.

ANALYSIS

Like.Com argues that Superfish's Appellant Brief "does not comply with 37 C.F.R. 41.67(c)(vi) because the Appellant Brief raises multiple issues on appeal which are not based on proposed rejections asserted by the Requester/Appellant in the Request for Reexamination." Petition, p. 3.

The parties do not dispute that the rejections proposed as Issues E and F in Superfish's Appellant Brief were not brought to the Examiner's attention in the Request for Reexamination or before the Examiner issued the Action Closing Prosecution. Further, while both Superfish, in its Appellant Brief, and Like.Com, in its Respondent Brief, argue the merits of Issues E and F, as noted above, in the Answer, the Examiner specifically acknowledged that the Answer does not present any new rejection or determination not to make a rejection. Thus, Issues E and F were not considered by the Examiner and are not before the Board for decision.

The panel of Judges to which this appeal is assigned for decision is free to disregard Issues E and F.

Inter partes Reexamination Control 95/001,307
Patent 7,542,610

DECISION

In view of the forgoing, the Petition is DISMISSED as moot.



James T. Moore
Acting Chief Administrative Patent Judge

Counsel for Patent Owner:
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Mahamedi Paradice Kreisman LLP
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(For Patent Owner)

MAILED

OCT 12 2011

Richard D. McLeod, Esq.
Klarquist Sparkman, LLP
121 SW Salmon Street
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Portland, OR 97204

(For Requester)

CENTRAL REEXAMINATION

In re Juan C. Vélez et al.
Inter Partes Reexamination Proceeding
Control No. 95/001,221
Filed: August 12, 2009
For: U.S. Patent No. 7,043,450

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:
:
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:
: **DECISION GRANTING**
: **PETITION UNDER**
: **37 CFR 1.137(b)**

In re Juan C. Vélez et al.
Inter Partes Reexamination Proceeding
Control No. 95/001,308
Filed: February 2, 2010
For: U.S. Patent No. 7,043,450

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This is a decision on the August 15, 2011 patent owner petition under 37 CFR 1.137(b) to accept a delayed response to Office action and revive the present terminated merged reexamination proceeding ("the August 15, 2011 patent owner petition to revive").

The August 15, 2011 patent owner petition to revive is before the Office of Patent Legal Administration (OPLA) for consideration.

The August 15, 2011 patent owner petition to revive is **granted**.

The August 12, 2011 Notice of Intent to Issue Inter Partes Reexamination Certificate (NIRC) based on the termination of prosecution for failure to timely respond to the Office action of September 28, 2010, is **withdrawn**.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

35 U.S.C. 41(a)(7) provides, in pertinent part:

REVIVAL FEES. — On filing each petition ... for an unintentionally delayed response by the patent owner in any reexamination proceeding ...

35 U.S.C. 133 provides:

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Director in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Director that such delay was unavoidable.

35 U.S.C. 314(a) provides, in pertinent part:

IN GENERAL. — Except as otherwise provided in this section, reexamination shall be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133 of this title.

37 CFR 1.137 provides, in pertinent part:

(b) *Unintentional*. If the delay in reply by ... patent owner was unintentional, a petition may be filed pursuant to this paragraph to revive ... a reexamination prosecution terminated under §§ 1.550(d) or 1.957(b) or limited under § 1.957(c) A grantable petition pursuant to this paragraph must be accompanied by:

- (1) The reply required to the outstanding Office action or notice, unless previously filed;
- (2) The petition fee as set forth in § 1.17(m);
- (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Director may require additional information where there is a question whether the delay was unintentional

*

*

(d) *Terminal disclaimer*.

*

*

- (3) The provisions of paragraph (d)(1) of this section do not apply to ... reexamination proceedings.

37 CFR 1.945(a) provides, in pertinent part:

The patent owner will be given at least thirty days to file a response to any Office action on the merits of the *inter partes* reexamination.

37 CFR 1.957(b) provides, in pertinent part:

If no claims are found patentable, and the patent owner fails to file a timely and appropriate response in an *inter partes* reexamination proceeding, the prosecution in the reexamination proceeding will be a terminated prosecution and the Director will proceed to issue and publish a certificate concluding the reexamination proceeding under § 1.997 in accordance with the last action of the Office.

37 CFR 1.958(b) provides, in pertinent part:

Any response by the patent owner not timely filed in the Office may be accepted if the delay was unintentional. A grantable petition to accept an unintentionally delayed response must be filed in compliance with § 1.137(b).

MPEP 2668 provides, in pertinent part:

II. PETITION BASED ON UNINTENTIONAL DELAY

The unintentional delay fee provisions of 35 U.S.C. 41(a)(7) are imported into, and are applicable to, any reexamination proceeding by Sec. 4605(a) of the American Inventors Protection Act of 1999. Accordingly, the Office will consider, in appropriate circumstances, a petition showing unintentional delay under 37 CFR 1.137(b) where untimely papers are filed by the patent owner subsequent to the order for reexamination. Any such petition must provide a verified statement that the delay was unintentional, a proposed response to continue prosecution (unless it has been previously filed), and the petition fee required by 37 CFR 1.17(m).

*

*

IV. FURTHER DISCUSSION OF THE PETITION REQUIREMENTS

See also MPEP § 711.03(c), subsection III, for a detailed discussion of the requirements of petitions filed under 37 CFR 1.137(a) and (b).

DECISION

The Petition Under 37 CFR 1.137(b) is Granted

A grantable petition under 37 CFR 1.137(b) for a reexamination proceeding must be accompanied by: (1) a response to the outstanding Office action; (2) the petition fee set forth in 37 CFR 1.17(m); and (3) a proper statement under 37 CFR 1.137(b)(3) that the entire delay in filing the required response from the due date of the response to the filing of a grantable petition was unintentional.

Regarding item (1), this merged reexamination proceeding prosecution was terminated under 37 CFR 1.957(b) due to patent owner's failure to timely submit a response to the September 28, 2010 Office action pursuant to 37 CFR 1.945(a). 37 CFR 1.945(a) provides that the patent owner will be given at least thirty days to file a response to any Office action on the merits of the *inter partes* reexamination. The September 28, 2010 Office action set a two-month period for response. A complete response to the September 28, 2010 Office action was not filed until November 30, 2010, which was untimely. However, for the purpose of evaluating whether the August 15, 2011 patent owner petition to revive is a grantable petition, the submission of the (i) November 30, 2010 Amendment In Response To Non-Final Office Action and (ii) Declaration Of Juan C. Vélez And Daren Murrer satisfies item (1).¹

Patent owner has been charged the \$810.00 petition fee, thereby satisfying item (2).

A proper statement under 37 CFR 1.137(b)(3) was submitted as part of the August 15, 2011 patent owner petition to revive, thereby satisfying item (3).

The present proceeding is a merged reexamination proceeding; thus, the petition does not require a terminal disclaimer.²

Accordingly, the August 15, 2011 patent owner petition to revive is **granted**.

The August 12, 2011 Notice of Intent to Issue Inter Partes Reexamination Certificate (NIRC) based on the termination of prosecution for failure to timely respond to the Office action of September 28, 2010, is **withdrawn**.

CONCLUSION

1. The August 15, 2011 patent owner petition under 37 CFR 1.137(b) has been **granted**.
2. The August 12, 2011 Notice of Intent to Issue *Inter Partes* Reexamination Certificate (NIRC) based on the termination of prosecution for failure to timely file an appropriate response to the Office action of September 28, 2010, is **withdrawn**.
3. Patent owner's response to the September 28, 2010 Office action is hereby entered in the record, thus triggering a comment right for third party requester

¹ This decision is not directed to either (i) the persuasiveness and propriety of the arguments presented in patent owner's November 30, 2010 Amendment and Declaration as to each of the rejections set forth in the September 28, 2010 Office action or (ii) the November 30, 2010 Amendment's compliance with formal matters; such is the examiner's province.

² See: 37 CFR 1.137(d)(3).

under 37 CFR 1.947. Accordingly, third party requester may file comments to patent owner's response as per 37 CFR 1.947 within 30 days of the mailing date of this decision.

4. Any inquiry concerning this decision should be directed to the undersigned at (571) 272-7728.



Raul Tamayo
Legal Advisor
Office of Patent Legal Administration

September 30, 2011



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,310	02/09/2010	7099981	ACQI-010/12US 310578-2058	3473
58249	7590	01/05/2012	EXAMINER	
COOLEY LLP ATTN: Patent Group Suite 1100 777 - 6th Street, NW WASHINGTON, DC 20001			ART UNIT	PAPER NUMBER

DATE MAILED: 01/05/2012

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
HAYNES AND BOONE, LP
IP SECTION
2323 VICTORY AVENUE, SUITE 700
DALLAS, TX 75219

Date: **MAILED**
JAN 05 2012
CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001310
PATENT NO. : 7099981
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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JAN 05 2012

CENTRAL REEXAMINATION UNIT

C. Scott Talbot : (For Patent Owner)
COOLEY, LLP :
777 6th Street NW, Suite 1100 :
Washington DC, 20001 :

David L. McCombs :
HAYNES and BOONE, LLP : (For Third Party
IP Section : Requester)
2323 Victory Ave., Suite 700 :
Dallas, TX. 75219 :

In re: Chu :
Inter Partes Reexamination Proceeding : DECISION ON PETITIONS
Control No.: 95/001,310 :
For: U.S. Patent No.: 7,099,981 :

This is a decision on two petitions filed by the patent owner: a petition filed on October 29th, 2010, entitled "PETITION REQUESTING EXPUNGMENT OF THIRD PARTY COMMENTS" [hereinafter "petition 1"], and a petition filed by Third Party Requestor on November 29th, 2010, entitled "PETITION IN OPPOSITION TO PATENT OWNER'S PETITION TO EXPUNGE THIRD PARTY COMMENTS" [hereinafter "petition 2"].

Petition 1 is treated as a petition under 37 CFR § 1.181.

Petition 2 is treated also as a petition under 37 CFR § 1.181 as a submission in opposition to Petition 1.

The petitions are before the Director of the Central Reexamination Unit. The petition 1 is **dismissed as moot** and petition 2 is **dismissed as moot and untimely**.

REVIEW OF RELEVANT FACTS

- U.S. Patent No. 7,099,981 issued on August 29, 2006.
- A request for *inter partes* reexamination was filed on February 9, 2010 and assigned control no. 95/001,310.
- *Inter partes* reexamination was ordered on April 9, 2010.
- A Non-Final Office Action was mailed on July 6, 2010.
- Patent Owner's Response to the Non-Final Office Action was received by the Office and serviced to the Third Party Requestor on September 3, 2010.
- The Third Party Requestor's Comments responsive to the Patent Owners comments after the Non-Final Office Action were received and serviced to the Patent Owner on October 1, 2010.
- Petition 1 was filed October 29th, 2010, and petition 2 was filed November 29th, 2010.
- An Action Closing Prosecution (ACP) was mailed on February 15, 2011.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

37 C.F.R. § 1.181 Petition to the Director

(f) The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings. Any petition under this part not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided. This two-month period is not extendable.

DECISION

Patent owner ["petitioner"] argues in petition 1 that the Office expunge from the record, pursuant to MPEP § 2667 the Third Party Requestor's Comments dated October 1, 2010 because the Third Party Comments impermissibly cite references: (i) IEEE 1355 (Exhibit P of Comments) (ii) Microsoft Computer Dictionary (Exhibit Q of Comments). Furthermore, the Patent Owner asserts that the Third Party Comments include new proposed rejections.

The Third Party Requester ["petitioner"] argues in petition 2, in opposition to petition 1, that the Patent Owner's October 29, 2010 Petition (petition 1) is improper and the Comments submitted were permissible under 37 C.F.R. § 1.948 and MPEP § 2666.05.

Petition 1

As a procedural matter, the petition was filed under 37 CFR § 1.181, which is reserved for action or requirement of any examiner in the ex parte prosecution of an application, or in ex parte or inter partes prosecution of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court.

In regards to the references cited 37 C.F.R. 1.948(a) clearly states:

- (a) After the inter partes reexamination order, the third party requester may only cite additional prior art as defined under § 1.501 if it is filed as part of a comments submission under § 1.947 or § 1.951(b) and is limited to prior art:
 - (1) which is necessary to rebut a finding of fact by the examiner;
 - (2) which is necessary **to rebut a response of the patent owner**; or
 - (3) which for the first time became known or available to the third party requester after the filing of the request for inter partes reexamination proceeding. Prior art submitted under paragraph (a)(3) of this section must be accompanied by a statement as to when the prior art first became known or available to the third party requester and must include a discussion of the pertinency of each reference to the patentability of at least one claim.

The Patent Owner in his response, dated September 3, 2010, argued the technical merits of the claim element "serial communication hub controller" and further introduced evidence in the form of a declaration and in the form of an excerpt from the Microsoft Computer Dictionary (5th Ed., Microsoft Press, 2002), the Third Party Requestor to specifically and clearly rebut the Patent Owner's arguments cited portions of the Microsoft Computer Dictionary (4th Ed., Microsoft Press, 1999), **consistent** with C.F.R. 1.948(a)(2). In regards to the new proposed rejections based on the IEEE 1355 reference the rejections were **not considered** as is clearly stated in the Action Closing Prosecution office action dated February 15, 2010. Therefore, based on the

above discussion the Office considers the petition (petition 1) to expunge from the record the Third Party Requestor's Comments as being dismissed as moot.

Petition 2

As a procedural matter, the petition was filed under 37 CFR § 1.181, which is reserved for action or requirement of any examiner in the ex parte prosecution of an application, or in ex parte or inter partes prosecution of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court. Petitioner argues in petition 2 that the Patent Owner's October 29, 2010 Petition (petition 1) is improper and the Comments submitted were permissible under 37 C.F.R. § 1.948 and MPEP § 2666.05. However, the November 29, 2010 opposition is untimely. See MPEP 2667, subsection II.B.3., which sets forth the policy that oppositions must be filed within two weeks of the date upon which the original petition was served to the opposing party. In this case, the November 29, 2010 opposition was filed more than two weeks from October 29, 2010, the date of service for the original Patent Owner petition (petition 1). Therefore, in light of the discussion above the petition (petition 2) is dismissed as moot and untimely.

CONCLUSION

1. The petition filed October 29th, 2010 is dismissed as moot and the petition filed November 29th, 2010 is dismissed as moot and untimely.
2. The most-recent Office action, Right of Appeal Notice (RAN) dated November 7, 2011, remains outstanding.
3. Telephone inquiries related to this decision should be directed to Sudhanshu C. Pathak, Supervisory Patent Reexamination Examiner, at (571) 272-5509 or in his absence to the undersigned at (571) 272-0700.



Irem Yucel
Director, Central Reexamination Unit



UNITED STATES PATENT AND TRADEMARK OFFICE

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CENTRAL REEXAMINATION UNIT

PROSKAUER ROSE LLP : (For Patent Owner)
ONE INTERNATIONAL PLACE :
BOSTON, MA 02110 :

FOLEY AND LARDNER LLP : (For Third Party
3000 K STREET SUITE 500 : Requester)
WASHINGTON, DC 20007 :

In re: Nanikashvili :
Inter Partes Reexamination Proceeding : DECISION ON PETITION
Control No.: 95/001,312 :
Deposited: March 16, 2010 :
For: U.S. Patent No.: 7,542,878 :

This is a decision on a petition filed by the patent owner on April 5, 2011, entitled "PETITION UNDER 37 C.F.R. §§ 1.181 AND 1.183," [hereinafter "the petition"] and is a request that prosecution be reopened, a declaration be considered, and new communication be issued by the Office. The petition additionally seeks an extension of time to file an appeal brief until after the petition is decided.

The petition is before the Director of the Central Reexamination Unit.

The petition is denied-in-part and dismissed-in-part.

REVIEW OF RELEVANT FACTS

- U.S. Patent No. 7,542,878 issued on June 2, 2009.
- A request for *inter partes* reexamination was filed March 16, 2010 and assigned control no. 95/001,312.
- Prosecution progressed until an Action Closing Prosecution was issued on December 16, 2010.
- Patent owner filed a response to the ACP on January 18, 2011. Included with the Response was a Declaration by John Moss.
- The examiner issued a Right of Appeal Notice on March 25, 2011. Among other things, the examiner refused consideration of the Moss Declaration as it failed to comply with 37 CFR § 1.68.
- Patent owner filed the instant petition on April 5, 2011. Included with the petition was a corrected Moss Declaration, allegedly correcting the defect.
- Patent owner filed a Notice of Appeal on April 25, 2011.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

37 CFR § 1.4 Nature of correspondence and signature requirements (in part):

(c) Since different matters may be considered by different branches or sections of the United States Patent and Trademark Office, each distinct subject, inquiry or order must be contained in a separate paper to avoid confusion and delay in answering papers dealing with different subjects.

37 CFR § 1.68 Declaration in Lieu of Oath

Any document to be filed in the Patent and Trademark Office and which is required by any law, rule, or other regulation to be under oath may be subscribed to by written declaration. Such declaration may be used in lieu of the oath otherwise required, if, and only if, the declarant is on the same document, warned that willful false statements and the like are punishable by fine or imprisonment, or both (18 U.S.C. 1001) and may jeopardize the

validity of the application or any patent issuing thereon. The declarant must set forth in the body of the declaration that all statements made of the declarant's own knowledge are true and that all statements made on information and belief are believed to be true.

37 CFR § 1.116 Amendments and affidavits or other evidence after final action and prior to appeal (in part):

(e) An affidavit or other evidence submitted after . . . an action closing prosecution (§ 1.949) in an *inter partes* reexamination filed under § 1.913 but before or on the same date of filing an appeal (§ 41.31 or § 41.61 of this title), may be admitted upon a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented.

(f) Notwithstanding the provisions of paragraph (e) of this section, no affidavit or other evidence can be made in an *inter partes* reexamination proceeding after the right of appeal notice under § 1.953 except as provided in § 1.981 or as permitted by § 41.77(b)(1) of this title.

DECISION

1.181 Portion

Patent owner ["petitioner"] argues that its declaration by John Moss, filed after the action closing prosecution ["ACP"], should have been entered and considered. The examiner declined entry of the declaration, therefore petitioner seeks reopening of prosecution for consideration of the declaration. Alternatively, petitioner has filed a corrected version of the declaration, and seeks reopening of prosecution for reconsideration of this corrected version.

In certain instances before the Office, an applicant or patent owner is required to file an oath or declaration, swearing to the truth of the statements made in the oath or declaration. 37 CFR § 1.68 permits the filing of a declaration in lieu of an oath, "if, and only if, the declarant is on the same document, warned that willful false statements and the like are punishable by fine or imprisonment, or both (18 U.S.C. 1001) and may jeopardize the validity of the application or any patent issuing thereon." (emphasis added). Petitioner admits that the declaration at issue here did not meet this requirement of the regulations, as it did not include this statement. Nevertheless, petitioner argues that it met the "spirit and intent" of the rule, and that the Board of Patent Appeals and Interferences has permitted declarations in similar situations.

It is clear that the examiner did not abuse her discretion in denying entry of the Moss declaration, as petitioner admits it does not comply with the letter of the rule. Even if the declaration was

compliant with the “spirit and intent” of the rule, this would only make it so that the examiner could, in her discretion, enter it if she wished. It does not compel entry because, as stated, it failed to comply with the rule. She chose, in her discretion, not to enter the declaration. The Director cannot say the examiner is incorrect or has abused her discretion for following the letter of the rule. Supervisory authority is not for substituting the discretion of the Director for the examiner’s discretion; it is for correcting improper applications of the rules or abuses of discretion.

That the Board has considered a declaration in a similar situation is not persuasive. In the *Pemberton* proceeding cited by petitioner at Petition p. 2, the Board noted that the declarations of record improperly lacked the 1.68 statement, but considered them anyway as being, in spirit and intent, in compliance with the regulation. Importantly, the question there, such as it was, was the consideration of evidence that was already in the record before the Board; the examiner never objected to the declarations in *Pemberton*, and they were a part of the record on appeal. It is a different situation for the Board to consider evidence that is already in the record, than for the examiner to deny entry into the record in the first place. In *Pemberton*, the Board was not acting as gatekeeper of the evidence, it was merely deciding the case on the record before it. The Board’s consideration is therefore not the same as an examiner acting as gatekeeper of what evidence is permissible to be placed into the record, therefore *Pemberton* does not compel entry and is not persuasive on the issue.

Petitioner further argues that 37 CFR § 1.957(d) permits it to correct the declaration, and it filed a corrected version with the petition. Petition pp. 2-3. While it is true in some cases that an omission may be corrected, 37 CFR § 1.951(a) requires that a patent owner “may once” file comments to an ACP. See MPEP 2672(I.); see also MPEP 2672(III.) (no opportunity to correct improper post-ACP submission unless rule 1.951 is waived). A second submission after ACP is therefore not proper for consideration. Additionally, this second submission comes after the Right of Appeal Notice, and no affidavit or other evidence can be made after the Right of Appeal Notice. 37 CFR § 1.116(f). Further, to the extent that petitioner argues that leniency should be provided, Petition p. 3, this is again an issue within the discretion of the examiner, and again it is not the place of the Director during supervisory review to substitute the Director’s discretion in place of the examiner’s.

The citation to 35 U.S.C. § 26 and *In re Bennett*, 766 F.2d 524 (Fed. Cir. 1985), Petition p. 4, also does not help petitioner. 35 U.S.C. § 26 permits a document to be provisionally accepted despite a defective execution, and an opportunity given for correction. In *Bennett*, a reissue declaration was executed by the assignee’s representative, rather than the inventor as required. The Federal Circuit held that “the Board erred in refusing to allow appellant to correct the defective execution of the reissue application.” *Bennett*, 766 F.2d 524, 528. Thus, the issue in *Bennett* and 35 U.S.C. § 26 is defective execution. Here, the execution of the declaration, the actual signing, does not appear to be defective. Rather, it is the content of the declaration that is

defective, by the declarant not including certain required statements. In this sense, *Bennett* and 35 U.S.C. § 26 are inapplicable.

It should be noted that the examiner also had additional grounds for not entering the declaration. The Moss declaration goes to the propriety of the priority claim. Priority has been at issue from the beginning of this proceeding, and any declarations as to this issue should have been filed in response to the original action. Indeed, patent owner was warned in the first Office action:

In order to ensure full consideration of any amendments, affidavits or declarations, or other documents as evidence of patentability, such documents must be submitted in response to this Office action. Submissions after the next Office action, which is intended to be a final action, will be governed by the requirements of 37 CFR 1.116, after final rejection and 37 CFR 41.33 after appeal, which will be strictly enforced.

Office action mailed June 11, 2010 at page 14. Patent owner chose not to file any declarations at that time as to priority, instead providing arguments. Only when those arguments failed was the declaration provided. The statutory mandate for special dispatch requires a patent owner to fully respond to the first Office action with all evidence, not to pursue piecemeal prosecution by submitting evidence only when other submissions are unsuccessful.

The post-ACP declaration is therefore subject to the requirements of 37 CFR § 1.116(e), which states that such evidence “may be admitted upon a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented.” Patent owner did not attempt to provide a showing as to why there was good and sufficient reasons why the declaration was necessary and not earlier presented, therefore this is a further reason why the declaration should not be admitted.

For the reasons above, the examiner did not abuse her discretion in denying entry and consideration of the post-ACP declaration. Accordingly, the declaration is not considered, and prosecution is not reopened. The substitute declaration filed with the petition is also not entered. The petition under 37 CFR § 1.181 is denied.

1.183 Extension


In addition to the above, the petition additionally seeks an extension of time under 37 CFR § 1.183 to file the appeal brief. The petition therefore raises multiple issues which are distinct inquiries addressed by different branches of the Office, and this is an improper paper not in compliance with 37 CFR § 1.4(c). For example, petitions filed under 37 CFR § 1.181 are decided by the Central Reexamination Unit, but petitions filed under 37 CFR § 1.183 are decided by the Office of Patent Legal Administration. As the petition purports to be filed under both of these rules, therefore combining multiple distinct subjects in a single paper, the petition is

dismissed under 37 CFR § 1.4(c) to the extent that an extension of time is requested under 37 CFR § 1.183. Petitioner should file a new petition directed solely to this issue if it wishes to continue to request an extension, though such a request would appear to be moot in light of the instant decision, given that this decision is rendered not long after the filing of the Notice of Appeal.

Accordingly, the petition is denied as to the entry of the Moss Declaration and the reopening of prosecution. The petition is dismissed as to the request for extension of time to file a brief.

CONCLUSION

1. For the reasons presented herein, the petition is denied-in-part and dismissed-in part.
2. The Notice of Appeal by patent owner has been received. The requirement to file an appeal brief remains outstanding and unaffected by this decision. Any request for an extension under 37 CFR § 1.183 must be re-filed in a paper directed solely to that issue.
3. Telephone inquiries related to this decision should be directed to Mark Reinhart, Supervisory Patent Examiner, at (571) 272-1611 or in his absence to the undersigned at (571) 272-0700.



Bruce Kisliuk
Director, Central Reexamination Unit



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(For Patent Owner)

MAILED

JUN 03 2011

FOLEY & LARDNER LLP
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(For *Inter Partes* Requester) CENTRAL REEXAMINATION UNIT

Inter Partes Reexamination Proceeding
Control No. 95/001,312
Filed: March 18, 2010
For: U.S. Patent No. 7,542,878

:
: **DECISION**
: **ON**
: **PETITION**
:

This is a decision on a May 25, 2011 patent owner petition entitled "PETITION UNDER 37 C.F.R. §1.183 REQUESTING EXPEDITED HANDLING REQUESTED," requesting an extension of time to file an appeal brief.

The petition is before the Office of Patent Legal Administration.

The patent owner petition under 37 C.F.R. § 1.183 for waiver of the regulatory prohibition for an extension of time to file an appellant's brief and for an extension of time to file an appellant's brief is granted.

The time for filing patent owner's Appellant Brief is extended to run 30 days from the due date; i.e., through July 25, 2011.

BACKGROUND

1. On June 2, 200, United States Patent No. 7,542,878 ("the '878 patent") issued to Reuven Nanikashvili.
2. On March 16, 2010,¹ a request for *inter partes* reexamination of the '878 patent was filed by third party requester, United Therapeutics Corp., which request was assigned Reexamination Control No. 95/001,312 ("the '1312 proceeding").
3. On April 23, 2010, the Office mailed an order granting *inter partes* reexamination in the '1312 proceeding.

¹ Requester originally deposited papers on February 16, 2010, which were noted as non-compliant in a March 10, 2010 Office Notice of Failure to Comply with *Inter Partes* Reexamination Request Filing Requirements (37 CFR 1.915(d)).

4. Prosecution advanced until, on March 25, 2011, a Right of Appeal Notice (RAN) was issued by the Office.
5. On April 5, 2011, patent owner filed a paper entitled "PETITION UNDER 37 C.F.R. §§ 1.181 and 1.183," requesting a reopening of prosecution and an extension of time to file an appeal brief.
6. On April 25, 2011, patent owner filed a notice of appeal.
7. On May 3, 2011, the Office issued a decision denying patent owner's request for reopening prosecution. The Office decision dismissed patent owner's request for an extension of time to file an appeal brief as improper under 37 CFR 1.4(c).
8. On May 24, 2011, patent owner filed a request for reconsideration of the April 5, 2011 petition.
9. On May 25, 2011, patent owner filed the present petition entitled "PETITION UNDER 37 C.F.R. §1.183 REQUESTING EXPEDITED HANDLING REQUESTED," requesting an extension of time to file an appeal brief.
10. This decision addresses patent owner's petition under 37 C.F.R. § 1.183 requesting waiver of the rule and granting of an extension of time to file an appeal brief in an *inter partes* reexamination proceeding.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

37 C.F.R. § 1.182 provides:

All situations not specifically provided for in the regulations of this part will be decided in accordance with the merits of each situation by or under the authority of the Director, subject to such other requirements as may be imposed, and such decision will be communicated to the interested parties in writing. Any petition seeking a decision under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 C.F.R. § 1.183 states:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 C.F.R. § 41.37 states, in pertinent part:

(a)(1) Appellant must file a brief under this section within two months from the date of filing the notice of appeal under § 41.31.

(e) The time periods set forth in this section **are extendable under** the provisions of § 1.136 of this title for patent applications and **§ 1.550(c) of this title for ex parte reexamination proceedings.** (Emphasis added)

37 C.F.R. § 41.61(b) states:

(1) Within fourteen days of service of a requester's notice of appeal under paragraph (a)(2) of this section and upon payment of the fee set forth in § 41.20(b)(1), an owner who has not filed a notice of appeal may file a notice of cross appeal with respect to the final rejection of any claim of the patent.

(2) Within fourteen days of service of an owner's notice of appeal under paragraph (a)(1) of this section and upon payment of the fee set forth in § 41.20 (b)(1), a requester who has not filed a notice of appeal may file a notice of cross appeal with respect to any final decision favorable to the patentability, including any final determination not to make a proposed rejection, of any original, proposed amended, or new claim of the patent.

37 CFR § 41.66 states, in pertinent part:

(a) An appellant's brief must be filed no later than two months from the latest filing date of the last-filed notice of appeal or cross appeal or, if any party to the proceeding is entitled to file an appeal or cross appeal but fails to timely do so, no later than two months from the expiration of the time for filing (by the last party entitled to do so) such notice of appeal or cross appeal. **The time for filing an appellant's brief or an amended appellant's brief may not be extended.** (Emphasis added)

DECISION

Patent owner has filed the present petition under § 1.183 for an extension of time on May 25, 2011, subsequent to the patent owner filing of a notice of appeal on April 25, 2011, and the Office's May 3, 2011 denial of patent owner's request to reopen prosecution after issuance of a RAN.

The time for filing an appellant's brief is two months from the latest filing date of the last-filed notice of appeal or cross-appeal, pursuant to 37 C.F.R. § 41.66(a). In the present proceeding, a notice of appeal was filed on April 25, 2011. Therefore, the time for patent owner petitioner to file an appeal brief is due to expire on June 25, 2011. Under 37 C.F.R. § 41.66(a), the time for filing the appellant's brief may not be extended.

In this instance, however, patent owner has filed its petition for extension of time under § 1.183 to waive the § 41.66(a) prohibition as to obtaining an extension the time (for filing the appellant's brief) to obtain the results of a decision on petition filed under § 1.181, so that an appeal brief need not be filed in the event the § 1.181 petition is granted. A decision on the §

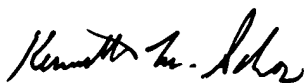
1.181 petition has yet to be rendered. In the event patent owner were to file an appellant's brief to keep the proceeding pending, in this case, that filing could cause an unnecessary expenditure of resources by the Central Reexamination Unit (CRU) to consider a brief, the need for which may become moot, should the petition under § 1.181 be granted.

Under the current facts and circumstances of the proceeding, an extension of time under 37 C.F.R. § 1.183 is granted to the extent that patent owner petitioner's time period to submit an appellant's brief is extended to run 30 days from the due date; i.e., July 25, 2011.

If the petition under § 1.181 has not yet been decided at the point where the time for patent owner to file an appellant's brief becomes less than two weeks prior to the deadline as extended, then patent owner may file a further § 1.182 petition for an additional extension of time. In that event, patent owner is strongly advised to contact Joseph Weiss at the phone number given below in the contact information to inform the Office that the petition for an additional extension of time is being filed, in order to expedite its review.

CONCLUSION

1. The patent owner petition under 37 C.F.R. § 1.183 for waiver of the regulatory prohibition for an extension of time to file an appellant's brief and for an extension of time to file an appellant's brief is **granted**.
2. The time for to file both the patent owner's and third party requester's briefs is extended to run **30 days** from the due date; i.e., through July 25, 2011.
3. Telephone inquiries related to this decision should be directed Joseph F. Weiss, Jr., Legal Advisor, Office of Patent Legal Administration, at (571) 272-7759.



Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration



UNITED STATES PATENT AND TRADEMARK OFFICE

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CENTRAL REEXAMINATION UNIT

In re: Nanikashvili :
Inter Partes Reexamination Proceeding : **DECISION ON PETITION**
Control No.: 95/001,312 :
Deposited: March 16, 2010 :
For: U.S. Patent No.: 7,542,878 :

This is a decision on a petition filed by the patent owner on May 24, 2011, entitled "PETITION FOR RECONSIDERATION UNDER 37 C.F.R. § 1.181," [hereinafter "the petition"] and is a request for reconsideration of a previous denial of a petition under 37 C.F.R. § 1.181.

The petition is before the Director of the Central Reexamination Unit.

The petition is granted-in-part.

REVIEW OF RELEVANT FACTS

- U.S. Patent No. 7,542,878 issued on June 2, 2009.
- A request for *inter partes* reexamination was filed March 16, 2010 and assigned control no. 95/001,312.
- Prosecution progressed until an Action Closing Prosecution was issued on December 16, 2010.
- Patent owner filed a response to the ACP on January 18, 2011. Included with the Response was a Declaration by John Moss.
- The examiner issued a Right of Appeal Notice on March 25, 2011. Among other things, the examiner refused consideration of the Moss Declaration as it failed to comply with 37 CFR § 1.68.
- Patent owner filed a petition on April 5, 2011 requesting supervisory review of the examiner's decision to decline entry of the Moss Declaration. Patent owner also filed a supplemental declaration by John Moss that included the 37 CFR § 1.68 statement.
- Patent owner filed a Notice of Appeal on April 25, 2011.
- The April 5, 2011 petition was denied in pertinent part in a decision mailed May 3, 2011.
- The instant petition was filed May 24, 2011.
- A separate petition for extension of time to file an appeal brief was filed May 25, 2011, and a one month extension was granted in a decision mailed June 3, 2011.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

37 CFR § 1.68 Declaration in Lieu of Oath

Any document to be filed in the Patent and Trademark Office and which is required by any law, rule, or other regulation to be under oath may be subscribed to by written declaration. Such declaration may be used in lieu of the oath otherwise required, if, and only if, the

declarant is on the same document, warned that willful false statements and the like are punishable by fine or imprisonment, or both (18 U.S.C. 1001) and may jeopardize the validity of the application or any patent issuing thereon. The declarant must set forth in the body of the declaration that all statements made of the declarant's own knowledge are true and that all statements made on information and belief are believed to be true.

37 CFR § 1.957 Failure to file a timely, appropriate or complete response or comment in *inter partes* reexamination (in part)

(d) When action by the patent owner is a *bona fide* attempt to respond and to advance the prosecution and is substantially a complete response to the Office action, but consideration of some matter or compliance with some requirement has been inadvertently omitted, an opportunity to explain and supply the omission may be given.

DECISION

Patent owner ["petitioner"] requests reconsideration of its previous petition requesting entry and consideration of the declaration of John Moss, filed after the action closing prosecution ["ACP"]. In the prior decision, the Director denied the petition and refused entry of the Moss declaration, stating that the examiner had the discretion to refuse entry because the declaration did not meet the letter of the rule, even if it met the spirit and intent, and that in any case the examiner had an additional reason to refuse entry under 37 CFR § 1.116. Upon further consideration, the Director reconsiders and grants the petition to the extent that prosecution is reopened for the examiner to consider whether entry and consideration of the declaration is appropriate.

The examiner in the ACP refused consideration of the Moss declaration because it did not include the clause regarding "willful false statements" required by 37 CFR § 1.68. The declarant did declare "under penalty of perjury under the laws of the United States that the statements herein made based on my personal knowledge are true and the statements herein made on information and belief are believed to be true." Moss Declaration, filed January 18, 2011. In the prior petition, the petitioner pointed out that in *Ex Parte Pemberton*, Appeal No. 2009-006175, at 24 n.15 (March 22, 2010) a case before the Board of Patent Appeals and Interferences, the BPAI observed that similar language was within the spirit and intent of the rules, including 37 CFR § 1.68. Petitioner also included with the prior petition a supplemental Moss declaration that did include the "willful false statements" clause.

In the prior decision, the Director stated that *Pemberton* was not applicable because there the declarations were already in the record and had been considered by the examiner, whereas here the issue was the actual entry of the declaration. The Director stated that even if the declaration

was compliant with the spirit and intent of the rules, it did not comply with the letter of the rules and the examiner was within her discretion to deny entry. The Director further denied entry of the supplemental Moss declaration, stating that 37 CFR § 1.957(d) did not apply because 37 CFR § 1.951(a) only permits submissions “once” after an ACP, and additionally the submission came after a Right of Appeal Notice and could be considered barred under 37 CFR § 1.116(f).

Upon further consideration, the Director determines that the supplemental declaration may be considered for entry and prosecution should be reopened for such consideration.

37 CFR § 1.957(d) states that when a *bona fide* attempt to respond and advance prosecution is made, but some matter of compliance with some requirement has been inadvertently omitted, an opportunity to explain and supply the omission may be given. Here, it is clear on its face that the January 18, 2011 response, including the Moss declaration, was a *bona fide* attempt to respond. The Moss declaration was complete as to substance, but was merely lacking in omitting a matter of compliance with some requirement—the willful false statements clause. Thus, the examiner could have provided an opportunity to explain and supply the omission, and the Director finds that she should have given such an opportunity.

While this is a discretionary issue (an opportunity to explain and supply “may” be given), the Director determines that discretion in this case only leads to granting the opportunity to supply the omission. The defect here had nothing to do with the substantive content of the declaration or response. The spirit and intent of the rule—dissuading false statements—was met by the declarant declaring he was subject to penalty of perjury, thus he was clearly willing to comply with the rule and file a correction (as was done by petitioner in filing the supplemental paper). The defect was easily correctable to be unambiguously compliant with the complained of rule without otherwise altering the content (again, as petitioner has already done). Special dispatch, while harmed, is not greatly harmed as we are moving backwards only one action and a few months of prosecution. And fairness weighs in favor of considering the declaration (if it is otherwise compliant for entry), given that this is patent owner’s final opportunity to be heard before appeal, and procedures such as continuation applications or continued examination are unavailable in reexamination therefore if the declaration is not entered now it never will be. The Director sees no real factors weighing against consideration, given that the correction has already been explained and supplied, except for the harm to special dispatch which again is no major in this instance. Thus, the examiner should have given the patent owner an opportunity to correct the omission. As it has already done so via the filing of the April 5, 2011 supplemental declaration, that submission is considered the explanation/correction.

The Director in the prior decision said that 37 CFR §§ 1.951(a) and 1.116(f) would preclude entry, but upon further consideration this is not the case. While section 1.951(a) permits a response to an ACP only once, nothing in that rule prevents the application of section 1.957(d) to permit an opportunity to explain and supply an omission in certain instances. That is, the

supplemental declaration is not really a second response, but more a preemptive 1.957(d) submission. And while section 1.116(f) precludes the filing of evidence after a Right of Appeal Notice, this presumes the Right of Appeal Notice itself was proper and the proceeding is moving on to appeal. It does not prevent a determination, like here, that prosecution be reopened.

Note this decision is drawn to the additional opportunity to supply the omission, which petitioner has already done. The Director maintains from the prior decision that the examiner was well within her discretion to deny entry of the original declaration. Even if it complied with the “spirit and intent” of the rule, it did not comply with the clear and unambiguous plain language of the rule. As stated in the prior decision, an examiner cannot be faulted for following the rules that govern Office proceedings and for requiring a patent owner to comply with those rules, and the Board’s decision to be lenient in the *Pemberton* case does not amend the rule to remove its requirements. That is, while the Office has the power to be lenient, it also has the power to enforce its regulations that were validly promulgated through notice and comment. The original declaration from January 11, 2011 therefore remains denied entry, and the petition remains denied as to that point. For the reasons stated herein, however, an opportunity to explain and supply the omission should have been given.

This decision also does not actually enter the supplemental declaration; it only finds that it may be considered for entry. In the prior decision, the Director additionally cited 37 CFR § 1.116(e) as a further basis for denying entry of the declaration. Petitioner now argues that the examiner never cited 37 CFR § 1.116 as a basis for denying entry of the declaration, and the Director should not make that decision for her. The Director agrees. The examiner in the Right of Appeal Notice never stated whether or not she found the declaration to be in compliance with 37 CFR § 1.116(e). As described in the previous decision, it is not correct for the Director in a supervisory role to make examination decisions that fall within the discretion of the examiner, therefore the Director does not decide whether the declaration complies with 37 CFR § 1.116(e). As the examiner apparently never decided this issue at all, it remains open for consideration in the next Office action. Nothing in the instant decision permits the patent owner to circumvent the requirements of 37 CFR § 1.116,¹ therefore if the examiner determines the declaration is not compliant with the rule she may again deny entry and consideration. The petition therefore remains denied to the extent it specifically requests entry of the supplemental Moss declaration.

For the reasons above, on the facts of the instant proceeding the examiner should have provided an opportunity to explain and supply the omission of the “willful false statements” clause. Petitioner has already provided such explanation as the supplemental Moss declaration, and this supplemental submission is considered the 1.957(d) reply. The supplemental Moss declaration


¹ 37 CFR § 1.957(d) would not give an additional opportunity to explain such a defect. Compliance with 37 CFR § 1.116(e) goes to the substantive content and whether such content is shown to be necessary, etc., not to “inadvertent omission” of a requirement.

should therefore now be considered for entry. Whether it actually will be entered will be decided by the examiner in the next Office action. Note that as the issue here resulted from a post-ACP submission, the next Office action may be a Right of Appeal Notice if the requirements of such action are otherwise satisfied.

Accordingly, upon reconsideration the petition is granted to the extent that the examiner will issue a new Office action where the supplemental Moss declaration is considered for entry. The petition is denied as to the request for actual entry of that submission, as that is a determination for the examiner. It is also denied as to entry of the original Moss declaration.

CONCLUSION

1. For the reasons presented herein, the petition is granted-in-part and denied-in-part.
2. Prosecution is reopened and jurisdiction returns to the examiner for reconsideration of the January 18, 2011 submission, along with the supplemental Moss Declaration filed April 5, 2011. The reopening is at the post-ACP stage, and the next action may be a Right of Appeal Notice if appropriate.
3. The supplemental Moss declaration is not entered by the present decision, but is merely deemed to satisfy 37 CFR § 1.68 and should be considered for entry. It remains subject to the normal requirements of declarations, and its entry is subject to 37 CFR § 1.116(e).
4. Telephone inquiries related to this decision should be directed to Mark Reinhart, Supervisory Patent Examiner, at (571) 272-1611 or in his absence to the undersigned at (571) 272-0700.



Irem Yucel
Director, Central Reexamination Unit



United States Patent and Trademark Office

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(For Patent Owner)

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3000 K STREET, SUITE 500
WASHINGTON, DC 20007

(For *Inter Partes* Requester)

Inter Partes Reexamination Proceeding
Control No. 95/001,312
Filed: March 18, 2010
For: U.S. Patent No. 7,542,878

:
: **DECISION**
: **ON**
: **PETITION**
:

This is a decision on the patent owner petition entitled "PETITION UNDER 37 C.F.R. §1.182 ADDITIONAL EXTENSION OF TIME TO SUBMIT APPEAL BRIEF," filed on JULY 11, 2011.

The petition is before the Office of Patent Legal Administration.

The patent owner petition under 37 C.F.R. § 1.182 is taken as a petition under 37 C.F.R. § 1.183 for waiver of the regulatory prohibition for an extension of time to file an appellant's brief and for an extension of time to file an appellant's brief and is granted.

The time for filing patent owner's Appellant Brief is extended to run 30 days from the due date; i.e., through August 25, 2011.

BACKGROUND

1. On June 2, 200, United States Patent No. 7,542,878 ("the '878 patent") issued to Reuven Nanikashvili.

2. On March 16, 2010,¹ a request for *inter partes* reexamination of the '878 patent was filed by third party requester, United Therapeutics Corp., which request was assigned Reexamination Control No. 95/001,312 ("the '1312 proceeding").
3. On April 23, 2010, the Office mailed an order granting *inter partes* reexamination in the '1312 proceeding.
4. Prosecution advanced until, on March 25, 2011, a Right of Appeal Notice (RAN) was issued by the Office.
5. On April 5, 2011, patent owner filed a paper entitled "PETITION UNDER 37 C.F.R. §§ 1.181 and 1.183," requesting a reopening of prosecution and an extension of time to file an appeal brief.
6. On April 25, 2011, patent owner filed a notice of appeal.
7. On May 3, 2011, the Office issued a decision denying patent owner's request for reopening prosecution. The Office decision dismissed patent owner's request for an extension of time to file an appeal brief as improper under 37 CFR 1.4(c).
8. On May 24, 2011, patent owner filed a request for reconsideration of the April 5, 2011 petition.
9. On May 25, 2011, patent owner filed a petition entitled "PETITION UNDER 37 C.F.R. §1.183 REQUESTING EXPEDITED HANDLING REQUESTED," requesting an extension of time to file an appeal brief.
10. On June 3, 2011, patent owner's request for an extension of time was granted in a decision giving a 30 day extension of time for filing a brief until July 25, 2011 and indicating the possibility of additional extensions of time if necessary.
11. On July 11, 2011, patent owner filed a petition entitled "PETITION UNDER 37 C.F.R. §1.182 ADDITIONAL EXTENSION OF TIME TO SUBMIT APPEAL BRIEF," requesting a second extension of time to file an appeal brief.
12. This decision addresses patent owner's petition requesting a second of an extension of time to file an appeal brief in an *inter partes* reexamination proceeding.

¹ Requester originally deposited papers on February 16, 2010, which were noted as non-compliant in a March 10, 2010 Office Notice of Failure to Comply with *Inter Partes* Reexamination Request Filing Requirements (37 CFR 1.915(d)).

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

37 C.F.R. § 1.182 provides:

All situations not specifically provided for in the regulations of this part will be decided in accordance with the merits of each situation by or under the authority of the Director, subject to such other requirements as may be imposed, and such decision will be communicated to the interested parties in writing. Any petition seeking a decision under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 C.F.R. § 1.183 states:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 C.F.R. § 41.37 states, in pertinent part:

(a)(1) Appellant must file a brief under this section within two months from the date of filing the notice of appeal under § 41.31.

(e) The time periods set forth in this section **are extendable under** the provisions of § 1.136 of this title for patent applications and **§ 1.550(c) of this title for ex parte reexamination proceedings**. (Emphasis added)

37 C.F.R. § 41.61(b) states:

(1) Within fourteen days of service of a requester's notice of appeal under paragraph (a)(2) of this section and upon payment of the fee set forth in § 41.20(b)(1), an owner who has not filed a notice of appeal may file a notice of cross appeal with respect to the final rejection of any claim of the patent.

(2) Within fourteen days of service of an owner's notice of appeal under paragraph (a)(1) of this section and upon payment of the fee set forth in § 41.20 (b)(1), a requester who has not filed a notice of appeal may file a notice of cross appeal with respect to any final decision favorable to the patentability, including any final determination not to make a proposed rejection, of any original, proposed amended, or new claim of the patent.

37 CFR § 41.66 states, in pertinent part:

(a) An appellant's brief must be filed no later than two months from the latest filing date of the last-filed notice of appeal or cross appeal or, if any party to the proceeding is entitled to file an appeal or cross appeal but fails to timely do so, no later than two months from the expiration of the time for filing (by the last

party entitled to do so) such notice of appeal or cross appeal. **The time for filing an appellant's brief or an amended appellant's brief may not be extended.**
(Emphasis added)

DECISION

The time for filing an appellant's brief is two months from the latest filing date of the last-filed notice of appeal or cross-appeal, pursuant to 37 C.F.R. § 41.66(a). In the present proceeding, a notice of appeal was filed on April 25, 2011. In its June 3, 2011 decision, the Office extended the time period for patent owner petitioner to file an appeal brief to expire on July 25, 2011.

Under 37 C.F.R. § 41.66(a), the time for filing the appellant's brief may not be extended. In this instance, however, patent owner has filed its petition for extension of time, taken under § 1.183, to waive the § 41.66(a) prohibition as to obtaining an extension the time (for filing the appellant's brief) to obtain the results of a decision on petition filed under § 1.181, so that an appeal brief need not be filed in the event the § 1.181 petition is granted. A decision on the § 1.181 petition has yet to be rendered. In the event patent owner were to file an appellant's brief to keep the proceeding pending, in this case, that filing could cause an unnecessary expenditure of resources by the Central Reexamination Unit (CRU) to consider appellant's brief, the need for which may become moot, should the petition under § 1.181 be granted.

Under the current facts and circumstances of the proceeding, an extension of time under 37 C.F.R. § 1.182 is granted to the extent that patent owner petitioner's time period to submit an appellant's brief is extended to run 30 days from the July 25, 2011 due date; i.e. through August 25, 2011.

If the petition under § 1.181 has not yet been decided at the point where the time for patent owner to file an appellant's brief becomes less than two weeks prior to the deadline as extended, then patent owner may file a further § 1.182 petition for an additional extension of time. In that event, patent owner is strongly advised to contact Joseph Weiss at the phone number given below in the contact information to inform the Office that the petition for an additional extension of time is being filed, in order to expedite its review.

CONCLUSION

1. The patent owner petition for waiver of the regulatory prohibition for an extension of time to file an appellant's brief and for an extension of time to file an appellant's brief is **granted**.
2. The time for to file patent owner's brief is extended to run **30 days** from the July 25, 2011 due date; i.e., to Aug 25, 2011.

3. Telephone inquiries related to this decision should be directed Joseph F. Weiss, Jr., Legal Advisor, Office of Patent Legal Administration, at (571) 272-7759.

/Kenneth M. Schor/

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

7-14-11



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,313	02/17/2010	7262411	F050.84RE	1159
24978	7590	09/22/2010	EXAMINER	
GREER, BURNS & CRAIN 300 S WACKER DR 25TH FLOOR CHICAGO, IL 60606			ART UNIT	PAPER NUMBER

DATE MAILED: 09/22/2010

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Date:

MAILED

SEP 22 2010

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

CENTRAL REEXAMINATION UNIT

REEXAMINATION CONTROL NO. : 95001313

PATENT NO. : 7262411

TECHNOLOGY CENTER : 3999

ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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(For Patent Owner)

MAILED

SEP 22 2010

Michael O. Scheinberg
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Austin, TX 78716-4140

(For Third Party Requester) **CENTRAL REEXAMINATION UNIT**

In re Nguyen-Huu et al.
Inter Partes Reexamination Proceeding
Control No. 95/001,313
Filed: February 17, 2010
For: U.S. Patent No. 7,262,411

:
: **DECISION**
: **GRANTING**
: **PETITION**
: **UNDER 37 CFR 1.183**

This is a decision on the requester paper entitled "Petition to Suspend Rule 37 C.F.R. § 1.943 Pursuant to the Provisions of 37 C.F.R. § 1.183", filed on July 22, 2010 (the July 22, 2010 requester petition).

The July 22, 2010 requester petition is before the Office of Patent Legal Administration for consideration.

The \$400 fee pursuant to 37 CFR 1.17(f) for the July 22, 2010 petition will be charged to deposit account 15-1635, as authorized by the requester on page 3 of the July 22, 2010 requester petition.

The petition under 37 CFR 1.183 is granted for the reasons set forth herein.

DECISION

Requester's July 22, 2010 petition under 37 CFR 1.183, requesting waiver of the 50-page limit of 37 CFR 1.943(b) for its concurrently-filed comments has been fully considered. The requester filed comments on July 22, 2010 to patent owner's June 22, 2010 response, and on the April 22, 2010 first Office action.

37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party. The burden is on petitioner to set forth with specificity the facts that give rise to an extraordinary situation in which justice requires suspension of a rule. A showing which petitioner can make in support of a request for waiver of the 50-page limit of 37 CFR 1.943(b) can be an attempt to draft comments in compliance with the 50-page limit, and submission of the resulting comments paper that is in excess of 50 pages concurrently with a

petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b), requesting entry of the submitted comments. Such a comments submission can be evaluated for economizing, extraneous material, and arrangement, without repetition of information already of record. In this way, petitioner can rely on the proposed comments submission: (1) for justification that more pages are needed to complete the comments submission, and (2) to set forth an accurate determination of exactly how many additional pages are needed to complete the comments submission.

In the instant petition under 37 CFR 1.183, the requester requests that the page limit for its July 22, 2010 comments be waived to the extent needed to accommodate the number of pages of requester's concurrently-submitted comments (including an expert declaration). In support of the waiver of 37 CFR 1.943(b), the requester states that the "Patentees amended nine of eighteen claims . . . and added twenty (20) claims . . . [Patentee's] Response was largely addressed only to the nine original claims which remain unamended" Requester additionally argues that "[i]n addition to commenting on the Patentees Response to the rejections of the remaining nine original claims, Requestors must also comment on 29 claims which are either new or amended to add additional limitations." Finally, the requester points out that "Requestor has also proactively reduced the number of pages as much as possible, for example by eliminating repetition of arguments by referring to previously argued SNQs or similar arguments."

If the requester in an *inter partes* reexamination proceeding wishes to newly propose a rejection of any of the newly added or amended claims, the requester must present proposed rejections that would satisfy the requirements of MPEP § 2617. The requester must also satisfy any applicable requirements of 37 CFR § 1.948(a).

In support of its request for waiver of 37 CFR 1.943(b), the requester has submitted, on July 22, 2010, a comments paper that is in excess of 50 pages. The July 22, 2010 comments submission includes 92 pages of comments, and a nine-page declaration under 37 CFR 1.132 of Dr. Michael R. Scheinfein. The Scheinfein declaration is determined to be free of legal argument.¹ Thus, a total of 92 pages count toward the page limit. The requester asserts that it has made every effort to minimize the length of the comments and supporting evidence.

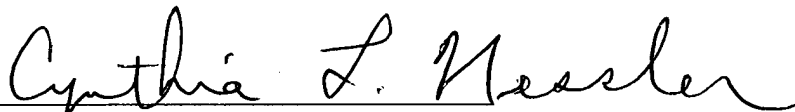
Based on the individual facts and circumstances of this case including, for example, the 29 claims newly added or amended by the patent owner, it is deemed equitable to waive the 50-page limit of 37 CFR 1.943(b) in this instance. Thus, even though requester's July 22, 2010 comments submission exceeds the 50-page limit, it is still deemed equitable in this instance to waive the 50-page limit of 37 CFR 1.943(b) to the extent that requester's comments not exceed 92 pages. Accordingly, requester's petition under 37 CFR 1.183 is granted and the page limit of

¹ In determining whether an affidavit or declaration under 37 CFR 1.132 is subject to the 50-page length requirement under 37 CFR 1.943(b), the Office analyzes whether the affidavit or declaration is providing factual evidence, i.e., evidence of *technological* facts, or whether the affidavit or declaration is merely an extension of the arguments of counsel. Factual evidence includes declarations that swear behind the filing date of a reference, that establish the date of a printed publication, that provide a technical explanation or technical definition of terms of art used by a reference, or that provide comparative test results and a scientific, or technological, analysis of the results. Where the affidavit or declaration includes arguments containing legal argument, including legal analysis and legal conclusions, such as arguments that the claims are patentable or unpatentable, or are directed to how an outstanding or proposed rejection is overcome, or, in the case of a declaration filed by the requester, how an outstanding or proposed rejection is supported, the affidavit or declaration is subject to the 50-page length requirement.

37 CFR 1.943(b) is waived to the extent of permitting requester's comments submission to exceed the page limit by up to 42 pages. This waiver makes requester's July 22, 2010 comments submission page-length compliant.

CONCLUSION

- The July 22, 2010 requester petition is **granted** and the page limit of 37 CFR 1.943(b) is **waived to the extent** of permitting requester's July 22, 2010 comments submission to exceed the page limit by up to 42 pages. This waiver makes requester's July 22, 2010 comments submission page-length compliant.
- Jurisdiction over this proceeding is being returned to the Central Reexamination Unit for appropriate action.
- Any inquiry concerning this communication should be directed to the undersigned at (571) 272-7724.



Cynthia L. Nessler
Senior Legal Advisor
Office of Patent Legal Administration



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,313	02/17/2010	7262411	F050.84RE	1159
24978	7590	06/29/2011	EXAMINER	
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DATE MAILED: 06/29/2011

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JUN 29 2010

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001313

PATENT NO. : 7262411

TECHNOLOGY CENTER : 3999

ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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MICHAEL O. SCHEINBERG
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AUSTIN, TX 78716

(For Third Party Requester)

MAILED

JUN 29 2011

CENTRAL REEXAMINATION UNIT

Inter Partes Reexamination Proceeding
Control No. 95/001,313
Filed: February 17, 2010
For: U.S. Patent No. 7,262,411

:
: **DECISION**
: **DISMISSING**
: **PETITION**
:

This is a decision on patent owner's petition paper, filed on April 8, 2011, entitled "PETITION TO WAIVE SIGNATURE REQUIREMENTS FOR INVENTOR WHO CANNOT BE REACHED UNDER MPEP § 715.04 AND 37 CFR 1.183" (the petition under 1.183), requesting waiver of the requirement for a signature of an unavailable inventor on a declaration under 37 CFR 1.131 and acceptance of the declaration under 37 CFR 1.131 (including a supplemental declaration under 37 CFR 1.131)¹ without execution by all of the named inventors. The petition under 37 CFR 1.183 was accompanied by a paper entitled "STATEMENT OF FACTS IN SUPPORT OF PETITION TO WAIVE SIGNATURE REQUIREMENTS FOR INVENTOR WHO CANNOT BE REACHED" (the statement).

The petition under 37 CFR 1.183 is before the Office of Patent Legal Administration.

The petition under 37 CFR 1.183 to waive the requirements of 37 CFR 1.131 is dismissed.

REVIEW OF THE RELEVANT FACTS

1. On August 28, 2007, United States Patent Number 7,262,411 (the '411 patent) was issued. The '411 patent was assigned to The Regents of the University of California (referred to herein as "University of California").

¹ Presumably, entry is requested subject to the examiner's review to determine whether 37 CFR 1.116 has been complied with.

2. On February 17, 2010, a request for *inter partes* reexamination of the '411 patent was filed by a third party requester, which request was assigned Reexamination Control No. 95/001,313 (the '1313 proceeding).
3. On April 22, 2010, an order granting *inter partes* reexamination in the '1313 proceeding was issued, concurrently with a non-final Office action on the merits.
4. The '1313 proceeding progressed to the point where, on March 8, 2011, the Office issued an Action Closing Prosecution (ACP).
5. On April 8, 2011, patent owner timely filed a submission under 37 CFR 1.951(a) in the '1313 proceeding, accompanied by papers entitled "37 CFR 1.131 DECLARATION SHOWING DILIGENCE IN REDUCTION TO PRACTICE" and "SUPPLEMENTAL 37 CFR 1.131 DECLARATION" (the 1.131 declarations).
6. Concurrently, on April 8, 2011, patent owner filed the instant petition under 37 CFR 1.183, accompanied by the statement.

DECISION

Relevant Statutes, Regulations and Procedures

37 CFR 1.131(a) provides, in pertinent part:

When any claim of an application or a patent under reexamination is rejected, the inventor of the subject matter of the rejected claim, **the owner of the patent under reexamination**, or the party qualified under §§ 1.42, 1.43, or 1.47, may submit an appropriate oath or declaration to establish invention of the subject matter of the rejected claim prior to the effective date of the reference or activity on which the rejection is based. [Emphasis added.]

37 CFR 1.183 provides, in pertinent part:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 CFR 3.73 provides:

(a) The inventor is presumed to be the owner of a patent application, and any patent that may issue therefrom, unless there is an assignment. The original

applicant is presumed to be the owner of a trademark application or registration, unless there is an assignment.

(b)(1) In order to request or take action in a patent or trademark matter, the assignee must establish its ownership of the patent or trademark property of paragraph (a) of this section to the satisfaction of the Director. The establishment of ownership by the assignee may be combined with the paper that requests or takes the action. Ownership is established by submitting to the Office a signed statement identifying the assignee, accompanied by either:

(i) Documentary evidence of a chain of title from the original owner to the assignee (e.g., copy of an executed assignment). For trademark matters only, the documents submitted to establish ownership may be required to be recorded pursuant to § 3.11 in the assignment records of the Office as a condition to permitting the assignee to take action in a matter pending before the Office. For patent matters only, the submission of the documentary evidence must be accompanied by a statement affirming that the documentary evidence of the chain of title from the original owner to the assignee was or concurrently is being submitted for recordation pursuant to § 3.11; or

(ii) A statement specifying where documentary evidence of a chain of title from the original owner to the assignee is recorded in the assignment records of the Office (e.g., reel and frame number).

(2) The submission establishing ownership must show that the person signing the submission is a person authorized to act on behalf of the assignee by:

(i) Including a statement that the person signing the submission is authorized to act on behalf of the assignee; or

(ii) Being signed by a person having apparent authority to sign on behalf of the assignee, e.g., an officer of the assignee.

(c) For patent matters only:

(1) Establishment of ownership by the assignee must be submitted prior to, or at the same time as, the paper requesting or taking action is submitted.

(2) If the submission under this section is by an assignee of less than the entire right, title and interest, such assignee must indicate the extent (by percentage) of its ownership interest, or the Office may refuse to accept the submission as an establishment of ownership.

MPEP 715.04 I. provides, in pertinent part:

The following parties may make an affidavit or declaration under 37 CFR 1.131:

(A) All the inventors of the subject matter claimed.

(B) An affidavit or declaration by less than all named inventors of an application is accepted where it is shown that less than all named inventors of an application invented the subject matter of the claim or claims under rejection. For

example, one of two joint inventors is accepted where it is shown that one of the joint inventors is the sole inventor of the claim or claims under rejection.

(C) If a petition under 37 CFR 1.47 was granted or the application was accepted under 37 CFR 1.42 or 1.43, the affidavit or declaration may be signed by the 37 CFR 1.47 applicant or the legal representative, where appropriate.

(D) The assignee or other party in interest when it is not possible to produce the affidavit or declaration of the inventor. *Ex parte Foster*, 1903 C.D. 213, 105 O.G. 261 (Comm'r Pat. 1903).

Affidavits or declarations to overcome a rejection of a claim or claims must be made by the inventor or inventors of the subject matter of the rejected claim(s), a party qualified under 37 CFR 1.42, 1.43, or 1.47, **or the assignee or other party in interest when it is not possible to produce the affidavit or declaration of the inventor(s)**. Thus, where all of the named inventors of a pending application are not inventors of every claim of the application, any affidavit under 37 CFR 1.131 could be signed by only the inventor(s) of the subject matter of the rejected claims. [Emphasis added.]

Analysis and Findings

On April 8, 2011, patent owner timely filed a response in the '1313 proceeding, accompanied by the declarations under 37 CFR 1.131, which were executed by three of the four named inventors of the '411 patent - Xuong Nguyen-Huu, Mark Ellisman and Stuart Kleinfelder. Concurrently, on April 8, 2011, patent owner filed the instant petition under 37 CFR 1.183, accompanied by the statement of Victoria B. Cajipe, PhD, in support of the petition under 37 CFR 1.183, requesting waiver of the signature requirement for the fourth inventor of the '411 patent, Peter Denes, on the declarations under 37 CFR 1.131.

The instant petition has been fully considered. Addressing the substance of the petition, it is pointed out that the extraordinary relief of waiving a rule is not granted if the rules provide an alternative avenue for obtaining the relief sought. *See, Cantello v. Rasmussen*, 220 USPQ 664 (Comr. 1982). In this instance, it would appear that, even if the petition is not granted, an alternative avenue that complies with the rules is available to obtain the requested relief.

37 CFR 1.131 specifically provides that "... *the owner of the patent under reexamination*. . . may submit an appropriate oath or declaration to establish invention of the subject matter of the rejected claim prior to the effective date of the reference or activity on which the rejection is based" (emphasis added). As pointed out in MPEP 715.04 I.(D), an assignee, or other party in interest is permitted to make a declaration under 37 CFR 1.131 "when it is not possible to produce the declaration of the inventor," as is asserted in the case here. In accordance with the language of 37 CFR 1.131 (the governing rule), the assignee may make the declaration for a patent under reexamination, even if the inventors are available to sign a declaration.² In this case, three of the four inventors, rather than the patent owner, have attempted to submit a

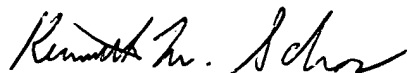
² It is noted that in order to make the declaration under 37 CFR 1.131, the assignee must establish its ownership of the patent by submitting a proper statement under 37 CFR 3.73(b), if such statement has not already been provided.

declaration under 37 CFR 1.131. And, as the assignee-signature avenue for relief is available to patent owner, waiver of the rule is not required.

In summary, the petitioner has not shown the present situation to be one warranting extraordinary relief, and for that reason, the petition under 37 CFR 1.183 to waive the requirements of 37 CFR 1.131 is dismissed. The declarations under 37 CFR 1.131, which accompanied patent owner's submission under 37 CFR 1.951(a) filed on April 8, 2011, will not be entered into the record of the '1313 proceeding.³

CONCLUSION

1. For the reasons set forth herein, patent owner's April 8, 2011 "PETITION TO WAIVE SIGNATURE REQUIREMENTS FOR INVENTOR WHO CANNOT BE REACHED UNDER MPEP § 715.04 AND 37 CFR 1.183" is dismissed.
2. The "37 CFR 1.131 DECLARATION SHOWING DILIGENCE IN REDUCTION TO PRACTICE" and "SUPPLEMENTAL 37 CFR 1.131 DECLARATION", which accompanied patent owner's submission under 37 CFR 1.951(a) filed on April 8, 2011, will not be entered into the record of the '1313 proceeding.
3. Any questions concerning this communication should be directed to Nicole D. Haines, Legal Advisor, at (571) 272-7717.



Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

06-29-2011

³ Thus, examiner review to determine whether 37 CFR 1.116 has been complied with, also required for entry, need not be conducted as to the proffered declarations.



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,315	05/13/2010	6928148	8419-84536-01	1906
92556	7590	06/09/2011	EXAMINER	
HONEYWELL/HUSCH Patent Services 101 Columbia Road P.O.Box 2245 Morristown, NJ 07962			ART UNIT	PAPER NUMBER

DATE MAILED: 06/09/2011

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Portland, OR 97204

Date:

MAILED

JUN 09 2011

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001315

PATENT NO. : 6928148

TECHNOLOGY CENTER : 3999

ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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(For Patent Owner) **MAILED**

JUN 09 2011

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CENTRAL REEXAMINATION UNIT
(For Third Party Requester)

Inter Partes Reexamination Proceeding
Control No.: 95/001,315
Filed: May 13, 2010
For: U.S. Patent No. 6,928,148

: **DECISION GRANTING**
: **PETITION FOR**
: **WAIVER OF 37 CFR 1.955**
: **FOR ONE-TIME INTERVIEW**

This is a decision on patent owner's "PETITION FOR SUSPENSION OF RULES PURSUANT TO 37 C.F.R. § 1.183," filed on May 9, 2011, as supplemented by patent owner's "SUPPLEMENTAL PETITION FOR SUSPENSION OF RULES PURSUANT TO 37 C.F.R. § 1.183," filed on May 23, 2011 (collectively referred to herein as "the petition under 37 CFR 1.183").

The petition under 37 CFR 1.183 is before the Office of Patent Legal Administration.

The petition under 37 CFR 1.183 is granted to the extent set forth herein.

BACKGROUND

1. On August 9, 2005, U.S. Patent No. 6,928,148 ("the '148 patent") issued to Simon *et al.*
2. On February 17, 2010, a request for *inter partes* reexamination of the '148 patent was filed by a third party requester, which request was assigned control no. 95/001,315 ("the '1315 proceeding").
3. On May 13, 2010, a corrected request for *inter partes* reexamination of the '148 patent was filed by the third party requester, and the '1315 proceeding was assigned a filing date of May 13, 2010.
4. On August 6, 2010, the Office issued an order granting *inter partes* reexamination in the '1315 proceeding.
5. On September 16, 2010, the Office mailed a non-final Office action on the merits.

6. On December 16, 2010, patent owner filed a timely response to the September 16, 2010 Office action.¹
7. On January 15, 2011, third party requester filed comments after patent owner's December 16, 2010 response.
8. On April 18, 2011, the Office mailed an Action Closing Prosecution (ACP).
9. Also, on April 18, 2011, third party requester filed a paper entitled "NOTIFICATION OF CONCURRENT PROCEEDINGS UNDER 37 C.F.R. 1.985(b)" in the '1315 proceeding.
10. On May 9, 2011, patent owner filed the instant petition paper entitled "PETITION FOR SUSPENSION OF RULES PURSUANT TO 37 C.F.R. § 1.183," which was supplemented by patent owner's "SUPPLEMENTAL PETITION FOR SUSPENSION OF RULES PURSUANT TO 37 C.F.R. § 1.183," filed on May 23, 2011.

DECISION

Relevant Statutes, Regulations and Practice

35 U.S.C. § 314 provides, in part:

(a) IN GENERAL.— Except as otherwise provided in this section, reexamination shall be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133. In any *inter partes* reexamination proceeding under this chapter, the patent owner shall be permitted to propose any amendment to the patent and a new claim or claims, except that no proposed amended or new claim enlarging the scope of the claims of the patent shall be permitted.

(c) SPECIAL DISPATCH.— Unless otherwise provided by the Director for good cause, all *inter partes* reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, shall be conducted with special dispatch within the Office.

37 CFR 1.955 provides:

There will be no interviews in an *inter partes* reexamination proceeding which discuss the merits of the proceeding.

Patent Owner's Petition under 37 CFR 1.183

The instant petition under 37 CFR 1.183 has been fully considered. In the instant petition, petitioner patent owner requests waiver of 37 CFR 1.955, which prohibits interviews in *inter*

¹ See November 12, 2010 decision granting patent owner's request for a one-month extension of time.

partes reexamination. In particular, petitioner requests that waiver be granted to allow the patent owner to conduct a single interview in the '1315 proceeding.²

37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party. The burden is on petitioner to set forth with specificity the facts that give rise to an extraordinary situation in which justice requires suspension of a rule. In support of its request for waiver of 37 CFR 1.955, petitioner asserts that third party requester has withdrawn from, and will not further participate in, the '1315 proceeding in any way.³ Petitioner further asserts that the interview would advance prosecution in the '1315 proceeding by providing an opportunity to discuss the claim features in light of the art of record.⁴

For example, petitioner asserts that "[a]t issue in this reexamination proceeding are disputes as to whether the three newly cited references, alone or in combination with each other or the previously cited references, anticipate or render obvious the previously rejected claims and/or the newly rejected claims (including original claims 3, 4, 30, 44, 45, 66, 79, 80, and 106, and new claims 118-170)."⁵ Specifically, petitioner asserts that: (1) "there is a dispute as to whether the newly cited Parker reference discloses that access to electronic mail is restricted based on a state of the system, as recited in claims 4, 45, 80 and other claims, including certain of the newly added claims"; (2) "[t]here is also a dispute as to whether the newly cited DSS1555 reference discloses a system that transmits security data signals via two channels, and terminates transmission of the signals on one of the channels when acknowledgement of transmission arrives from the other channel, as recited in claims 30, 66, 106 and other claims, including certain of the newly added claims"; and (3) the interpretation of "user control interface ... *further connected* to an external data network" as recited in independent claims 1, 42, and 77 is at issue as the references relied upon in the ACP to teach this feature "by and large disclose 'dumb' user control devices (e.g., keypads) which require another component, such as a processor, between themselves and the external data network to communicate with the external data network, as opposed to themselves being able to communicate with the external data network."⁶

A review of the *Notice of Final Rule Making, Rules to Implement Optional Inter Partes Reexamination Proceedings*, 65 FR 76755 (Dec. 7, 2000), 1242 *Off. Gaz. Pat. Office* 12 (Jan. 2, 2001) (final rule) reveals that the Notice of Proposed Rule Making had proposed implementation of a regulation that would have permitted interviews in *inter partes* reexamination proceedings. In the final rule, however, the Office decided to preclude both *ex parte* and *inter partes* interviews in an *inter partes* reexamination proceeding, and accordingly published 37 CFR 1.955 in its present form. The Office concluded that, for a variety of reasons, "[n]o matter what the structure of the interview, the presence of a third party requester (or a separate interview with the

² See May 9, 2011 petition under 37 CFR 1.183 at page 1.

³ See *id.* at pages 1-2.

⁴ See May 23, 2011 supplemental petition under 37 CFR 1.183 at page 3 (stating, "The ACP of April 18, 2011, maintained the rejections of the first Office Action, and added ten new rejections based on three newly cited prior art references listed in the IDS submitted by the Patent Owner with their December 16 response. The ACP also withdrew the confirmation of many of the previously confirmed claims in light of the three new references, including claims 3, 4, 30, 44, 45, 66, 79, 80, and 106, upon which the patentability of the newly added claims was premised. Consequently, the ACP also rejected new claims 118-170.")

⁵ *Id.*

⁶ See *id.* at pages 3-4.

requester) will complicate the reexamination proceeding and significantly delay it.” Thus, the key basis for the present 37 CFR 1.955 proscription of all and any interviews in an *inter partes* reexamination proceeding was that the presence of two (or more) parties in the proceeding would interfere with the Office's ability to conduct an *inter partes* reexamination proceeding with special dispatch as mandated by 35 U.S.C. § 314.

In this instance, the third party requester has stated on the record that it will not further participate in the ‘1315 *inter partes* reexamination proceeding.’⁷ Thus, only a single party (patent owner) will now participate in the ‘1315 proceeding, and any interview that might be permitted in the proceeding. Additionally, petitioner has focused upon specific matters at issue in the proceeding to be discussed at the interview, pointing to particular claim features to be discussed relative to the asserted prior art. Based on the present facts and circumstances, it is found that permitting a single interview to be conducted at this point in the ‘1315 *inter partes* proceeding is not anticipated to potentially hinder the ability of the Office to conduct the ‘1315 proceeding with special dispatch, but rather may well assist the Office in expeditiously resolving the proceeding.⁸

Accordingly, in view of the particular facts and circumstances set forth herein, in this instance and at this point, the record in the ‘1315 proceeding is deemed to present an extraordinary situation which justifies waiver of 37 CFR 1.955 to further the interests of the patent owner, members of the public who may be interested in the outcome of the proceeding, and the Office. Thus, patent owner’s petition under 37 CFR 1.183 is granted to the extent that 37 CFR 1.955 is waived such that a single interview will be permitted, subject to the examiner’s approval.

There are no established regulatory or practice guidelines to govern the manner in which an interview in an *inter partes* reexamination proceeding is to be conducted. Therefore, the waiver of 37 CFR 1.955 so as to permit an interview is granted only to the extent that patent owner satisfies the following preliminary requirements.

Requirements and Guidelines for Conducting Interview

A. Preliminary Requirements

1. Promptly, upon receipt of the present decision, patent owner must contact the examiner in charge of the proceeding to identify the issues that are sought to be discussed, to determine if an interview will be granted with respect to those issues (which determination the examiner is directed to make based on criteria analogous to that of granting *ex parte* reexamination interviews), and to ascertain the examiner’s desktop facsimile number.
2. At least three (3) working days prior to the interview, patent owner must file an informal written statement of the issues to be discussed at the interview, and an informal copy of any

⁷ See April 18, 2011 “NOTIFICATION OF CONCURRENT PROCEEDINGS UNDER 37 C.F.R. 1.985(b)” (stating, “2Gig hereby notifies the Office that it will not further participate in this re-examination proceeding or any other pending re-examination or request for a re-examination proceeding involving U.S. Patent No. 6,928,148 in any way.”)

⁸ As set forth in the Office’s May 13, 2011 decision, the time period for filing patent owner’s submission under 37 CFR 1.951(a) after the April 18, 2011 ACP has been extended by one month.

proposed claims to be discussed, unless the examiner waives this requirement. The copy of these materials is to be submitted by facsimile transmission (FAX) directly to the examiner, or to be hand-carried to the examiner, so as to avoid the possibility of delay in matching the materials with the file. The informal copies that are considered by the examiner will be made of record in the reexamination proceeding – as an attachment to an Interview Summary form PTOL-474 (modified as needed for *inter partes* reexamination) to be completed by the examiner after the interview.

3. Patent owner must serve a copy of the papers discussed in item (2) above on the third party requester in accordance with 37 CFR 1.903, and include a copy of the certificate of service of such papers in the papers as filed in item (2) above.

B. Guidelines for Conducting the Interview

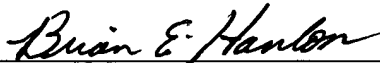
1. The interview must be conducted in the Office at such times, within Office hours as examiner may designate. The interview will not be permitted at any other time or place, without the authority of the Director.
2. Patent owner must make every effort to conduct the interview in not more than one (1) hour. Patent owner may, however, show cause, at the interview, why more time is needed, and the examiner is also free to extend the interview, at the examiner's sole discretion.
3. The interview should be attended by the conferees who signed the April 18, 2011 ACP, or their substitutes if the conferees are not reasonably available.
4. At the conclusion of the interview, the examiner will prepare an interview summary, using form PTOL-474, the *Ex Parte* Interview Summary Form, and making appropriate modifications thereto, taking into account that the present proceeding is an *inter partes* reexamination proceeding. A copy of the interview summary form is to be given to patent owner at the conclusion of the interview. A copy of the interview summary form will also be mailed to third party requester, and the original of the form is to be made of record in the Image File Wrapper for the proceeding.

C. Prosecution after the Interview

1. Patent owner must file a complete written statement of the reasons presented at the interview as warranting favorable action, to avoid termination or limitation of the proceeding as appropriate under 37 CFR 1.957. The written statement must be filed as a separate paper filed within one month from the date of the interview or with the response to the outstanding Office action (whichever is later).
2. All papers filed by patent owner in the '1315 *inter partes* reexamination proceeding must continue to be served in accordance with 37 CFR 1.903, and service must be reflected by attaching a certificate of service, or consideration of the document may be refused.

CONCLUSION

1. Patent owner's petition under 37 CFR 1.183 is granted to waive the provisions of 37 CFR 1.955, to the extent that a single interview will be permitted, upon approval by the examiner and compliance with the Preliminary Requirements, as set forth above.
2. The provisions of 37 CFR 1.955 are waived solely on the present facts and circumstances, and solely for the purposes of conducting one interview with respect to the April 18, 2011 ACP.
3. Any future petition for waiver of 37 CFR 1.955 will not be granted absent a further strong showing of necessity, including an explanation of why the basis for any further interview could not have been addressed in the first interview.
4. Any questions concerning this communication should be directed to Nicole Dretar Haines, Legal Advisor, Office of Patent Legal Administration, at (571) 272-7717.



Brian Hanlon
Director
Office of Patent Legal Administration
Office of the Associate Commissioner
for Patent Examination Policy

06-08-2011



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,317	03/04/2010	J. Michael Goodson	LBP-1G	9476
7590 05/06/2011			EXAMINER	
K&L GATES LLP FOUR EMBARCADERO CENTER SUITE 1200 SAN FRANCISCO, CA 94111			ART UNIT PAPER NUMBER	

DATE MAILED: 05/06/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
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30 SOUTH 17th STREET
UNITED PLAZA, SUITE 1600
PHILADELPHIA, PA 19103-4009

Date:

MAILED

MAY 05 2011

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001317
PATENT NO. : 7598654
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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CENTRAL REEXAMINATION UNIT

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(For Requester)

In re *Goodson*
Reexamination Proceeding
Control No. 95/001,317
Filed: March 4, 2010
For: U.S. Patent No. 7,598,654

:
: **DECISION ON**
: **PETITION UNDER**
: **37 CFR 1.181**
:

This is a decision on a petition filed by the patent owner on January 7, 2011 entitled "PETITION TO WITHDRAW ACTION CLOSING PROSECUTION AS PREMATURE," filed under 37 CFR 1.182. The petition has been treated as a request to the Director to exercise his discretion pursuant to 37 CFR 1.181 to withdraw the Action Closing Prosecution (ACP) issued on December 7, 2010. The petition is accompanied by a response to the ACP, including amendments to the claims.

The petition is before the Technology Center Director overseeing the Central Reexamination Unit.

The petition under 37 CFR 1.181 to invoke the supervisory authority of the Director dated January 7, 2011 is granted with respect to withdrawing the ACP mailed December 7, 2010.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 7,598,654 (hereinafter, the '654 patent) issued on October 6, 2009.
2. During prosecution, independent claims 1, 6, 7, 8 and 9 of the '654 patent were amended by an examiner's amendment attached to a Notice of Allowability mailed August 28, 2009. The amendment added the phrase "and exceeds" to each independent claim so that the claimed frequency range "includes *and exceeds* the fundamental resonant frequencies" was recited (emphasis added).
3. However, the above amendment to independent claims 1, 6, 7, 8 and 9 was not made to the claims printed in the issued '654 patent.
4. In order to correct the mistake, On June 20, 2010, Patent Owner submitted a Request for Expedited Issuance of Certificate of Correction.
5. In the meantime, on March 4, 2010, a third party requester deposited a request for *inter partes* reexamination of the '654 patent, and the resulting reexamination proceeding was assigned Control No. 95/001,317 (hereinafter, the '317 reexamination proceeding).
6. *Inter partes* reexamination was ordered for the '654 reexamination proceeding on April 21, 2010. On the same day, a non-final Office action was mailed in the '654 reexamination proceeding.
7. On June 21, 2010, Patent Owner filed a response to the first Office action. The response included a copy of the Request for Expedited Issuance of Certificate of Correction, supporting documentation and a Certificate of Correction.
8. On July 21, 2010, the third party requester filed comments.
9. On August 24, 2010, the Office issued a Certificate of Correction correcting independent claims 1, 6, 7, 8 and 9 in accordance with the examiner's amendment of August 28, 2009 and the Request for Expedited Issuance of Certificate of Correction.
10. On December 7, 2010, the Office issued an Action Closing Prosecution (ACP).
11. On January 7, 2011, Patent Owner filed the instant petition under 37 CFR 1.181 to invoke the supervisory authority of the Director and requesting that the ACP be withdrawn. The petition was accompanied by a response to the ACP, including amendments to the claims.

DECISION

Patent Owner (petitioner) states that the ACP mailed December 7, 2010 was not in accordance with Office policies set forth in MPEP 2673 et seq., because the ACP was premature in that it is the first Office action that addresses the correct claims. Patent Owner argues that all but one of the rejections set forth in the April 21, 2010 first Office action were directed to the incorrect claims. Patent Owner also argues that since the December 7, 2010 ACP is the first action to squarely address the patentability of the correct claims, the rejections constitute new grounds of rejection and the action should thus not have been an ACP and cites to 37 CFR 1.949 for support. Therefore, patent owner states that he has not had a fair opportunity to present amendments for the purpose of addressing the rejections of the corrected claims. For these reasons, Patent Owner argues that the ACP should be deemed premature and thus, that the prosecution should be reopened.

In response to patent owner's arguments for reopening prosecution in this reexamination proceeding, the director finds there are good and sufficient reasons to do so for the reasons set forth below, and for the reasons set forth by the patent owner in the petition.

Turning to the facts in this proceeding, patent owner is correct that Office policy supports the reopening of prosecution when the examiner decides to modify his or her position that is adverse to the patent owner's position. In the instant case, as pointed out by Patent Owner, since the certificate of correction issued on August 24, 2010, the December 7, 2010 ACP is the first action to squarely address the patentability of the correct claims. Therefore, the ACP of December 7, 2010 cannot fairly be said to have given patent owner an adequate opportunity to address the new position prior to the appeal stage.

Specifically, 37 CFR 1.949 states:

"Upon consideration of the issues a second or subsequent time, or upon a determination of patentability of all claims, the examiner shall issue an Office action treating all claims present in the *inter partes* reexamination, which may be an action closing prosecution. The Office action shall set forth all rejections and determinations not to make a proposed rejection, and the grounds therefor. An Office action will not usually close prosecution if it includes a new ground of rejection which was not previously addressed by the patent owner, unless the new ground was necessitated by an amendment."

Furthermore, the Patent Owner correctly notes that it was Office error that the examiner's amendment of August 28, 2009 was not included in the issued '654 patent. The August 28, 2009 examiner's amendment was of record in the prosecution history of the '654 patent, but was inadvertently overlooked by the Office in issuing the '654 patent.

Therefore, the examiner improperly closed prosecution because the ACP dated December 7, 2010 fails to give patent owner an adequate opportunity to address the new position prior to the appeal stage, in accordance with 37 CFR 1.949 and MPEP 2673.01. In

addition, it was Office error that resulted in the incorrect claims being printed in the '654 patent. Accordingly, good and sufficient reasons to withdraw the ACP dated December 7, 2010 in the reexamination proceeding have been provided and the patent owner's petition, as it relates to withdrawing the ACP dated December 7, 2010, is granted.

Due to the vacatur of the December 7, 2010 ACP, patent owner's response filed with the petition will be entered and considered by the examiner.

CONCLUSION

1. The petition under 37 CFR 1.181 for reconsideration of the ACP dated December 7, 2010 is granted.
2. The ACP, dated December 7, 2010, is hereby vacated and the examiner will issue a corrected non-final Office action, in due course, to replace the December 7, 2010 Office action.
3. Patent Owner's amendment accompanying the petition, filed January 7, 2010 will be entered and considered by the examiner.
4. Telephone inquiries related to this decision should be directed to Andy Kashnikow, Supervisory Patent Examiner, at (571) 272-4361.



Bruce Kisliuk
Assistant Deputy Commissioner for Patent Operations and
Acting Director, Central Reexamination Unit



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,319	03/29/2010	7133293	MOUNT-00100	1333
32361	7590	09/15/2011	EXAMINER	
GREENBERG TRAURIG (NY) MET LIFE BUILDING 200 PARK AVENUE NEW YORK, NY 10166			ART UNIT	PAPER NUMBER

DATE MAILED: 09/15/2011

Please find below and/or attached an Office communication concerning this application or proceeding.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Inter Partes Antec, Inc.

v.

Streak Products, Inc.

Reexamination Control No. 95/001,319

Patent No. 7,133,293

Technology Center 3900

DECISION ON PETITION

This is a decision on the patent owner's "Combined Petition under 37 C.F.R. § 1.182 to Strike Respondent Brief for Violation of 37 C.F.R. § 1.943 Page Limit and Declaration in Support," filed on July 22, 2011 (petition). The petition requests that the requester's respondent brief of July 11, 2011, be expunged for not being compliant with 37 C.F.R. § 1.943(c), because it exceeds 15 pages in length, and does not contain a certificate of word count. The petition fee of \$400 has been charged to petitioner's deposit account on July 25, 2011, as authorized on page 5 of the petition.

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Inter Partes Reexamination Control No. 95/001,319
Patent No. 7,133,293

This is also a decision on third party requester's "Combined Petition for Suspension of the Rules under 37 C.F.R. § 1.183 and Opposition to Motion to Strike by Third Party Requester," filed on August 5, 2011 (opposition). The opposition requests suspension of the certification requirement under 37 C.F.R. § 1.943(c) because requester's respondent brief of July 11, 2011, was less than 7,000 words long, but requester inadvertently failed to certify such word count. The petition fee of \$400 has been charged to petitioner's deposit account on August 8, 2011, as authorized on page 2 of the opposition.

See 75 Fed. Reg. 50,750-51 (Aug. 17, 2010) for authority of the Chief Administrative Patent Judge.

FINDINGS

1. A request for *inter partes* reexamination of U.S. Patent No. 7,133,293 was filed on March 29, 2010, and was assigned control no. 95/001,319.
2. On May 11, 2010, reexamination was ordered, and a non-final Office action was mailed.
3. Prosecution was conducted and on January 28, 2011, a Right of Appeal Notice (RAN) was mailed.
4. Patent owner filed a Notice of Appeal on February 25, 2011, and an appellant brief on May 11, 2011.
5. Requester filed a respondent brief on July 11, 2011.
6. Patent owner filed the present petition on July 22, 2011.
7. Requester filed an opposition to the petition on August 5, 2011.

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Inter Partes Reexamination Control No. 95/001,319
Patent No. 7,133,293

DISCUSSION

The patent owner's petition requests that the requester's respondent brief of July 11, 2011, be expunged for not complying with 37 C.F.R. § 1.943(c), because it exceeds 15 pages in length, and does not contain a certificate of word count. The requester's opposition requests suspension of the certification requirement under 37 C.F.R. § 1.943(c) because it is asserted that requester's respondent brief of July 11, 2011, was less than 7,000 words long, but requester inadvertently failed to certify such word count. Requester states that they served the brief again on August 1, 2011, with the required certification; and that the brief with the required certification is attached to the opposition as "Exhibit A."

RELEVANT AUTHORITY

37 C.F.R. § 1.182 states:

All situations not specifically provided for in the regulations of this part will be decided in accordance with the merits of each situation by or under the authority of the Director, subject to such other requirements as may be imposed, and such decision will be communicated to the interested parties in writing. Any petition seeking a decision under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 C.F.R. § 1.183 states:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, sua sponte, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

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Inter Partes Reexamination Control No. 95/001,319
Patent No. 7,133,293

37 C.F.R. § 1.943(c) states:

Appellant's briefs filed by the patent owner and the third party requester shall not exceed thirty pages or 14,000 words in length, excluding appendices of claims and reference materials such as prior art references. All other briefs filed by any party shall not exceed fifteen pages in length or 7,000 words. If the page limit for any brief is exceeded, a certificate is required stating the number of words contained in the brief.

ANALYSIS

The petition and opposition have been considered fully. A petition under 37 C.F.R. § 1.182 to strike another party's submission is only appropriate if a submission is improper. The USPTO has the discretion to waive the applicable rules under 37 C.F.R. § 1.183 in an extraordinary situation when justice requires waiver.

A review of the record reveals that a Notice of Defective Brief was mailed on June 15, 2011, indicating that the requester's respondent brief of June 10, 2011, was defective for failure to include a certificate of service. The requester was given one opportunity to file a corrected respondent brief in response to the Notice. The corrected respondent brief of July 11, 2011, includes a certificate of service. It is noted that both respondent briefs exceed fifteen (15) pages and do not include a certificate of word count, and therefore are not in compliance with 37 C.F.R. § 1.943(c). This was first brought to requester's attention via the filing of patent owner's petition of July 22, 2011.

In the opposition, requester indicates that they served the respondent brief again on August 1, 2011, with the required certification, and that the respondent brief with the required certification is attached to the opposition as "Exhibit A." However, a review of the file history does not reveal that a document of August 1, 2011, has been made of record in the instant *inter partes* reexamination, and there

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Inter Partes Reexamination Control No. 95/001,319
Patent No. 7,133,293

is no "Exhibit A" attached to the instant opposition. A careful review of all pages filed on August 5, 2011, via the Office's electronic filing system (eFS) does not reveal that a certification of the word count for the respondent brief has been received. With regard to requester's requested relief of waiving the required word count certification, in the opposition, requester indicates that they inadvertently failed to certify such word count. An inadvertent omission does not rise to the level of an extraordinary situation. Requester has provided no showing of an extraordinary situation where justice requires waiver of 37 C.F.R. § 1.943(c).

Accordingly, the patent owner's petition is **granted** to the extent that requester's respondent brief is found to be not in compliance with 37 C.F.R. § 1.943(c). The requested relief of expunging the respondent brief is held in abeyance, as the requester will be permitted one opportunity to provide the
required word count certification, which requester indicates they have already prepared and filed on August 1, 2011, and again on August 5, 2011.

The requester's opposition is **denied**.

CONCLUSION

The petition is GRANTED.

Requester hereby is given one opportunity to complete the filing of a corrected respondent brief in compliance with 37 C.F.R. § 1.943(c), *i.e.*, by filing the certification of the word count for the respondent brief of July 11, 2011, within a non-extendable time period of seven (7) days from the mailing date of this decision. If the certification showing compliance with the word count of 37 C.F.R. § 1.943(c), is not timely received, or the certification is timely received but shows

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Inter Partes Reexamination Control No. 95/001,319

Patent No. 7,133,293

that the respondent brief exceeds 7000 words, then the appeal will proceed without consideration of a respondent brief.



James Donald Smith
Chief Administrative Judge

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,320	03/03/2010	7181866	356093US26RX	1486
9629	7590	06/14/2011	EXAMINER	
MORGAN LEWIS & BOCKIUS LLP (WA) 1111 PENNSYLVANIA AVENUE NW WASHINGTON, DC 20004			ART UNIT	PAPER NUMBER

DATE MAILED: 06/14/2011

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1940 DUKE STREET
ALEXANDRIA, VA 22314

Date:

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CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001320
PATENT NO. : 7181866
TECHNOLOGY CENTER : 3999
ART UNIT : 3993

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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MORGAN LEWIS & BOCKIUS LLP (WA)
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(For Patent Owner)

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JUN 14 2011

CENTRAL REEXAMINATION UNIT

OBLON, SPIVAK, MCCLELLAND
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1940 DUKE STREET
ALEXANDRIA, VA 22314

(For Third Party Requester)

In re Braunschweiler
Reexamination Proceeding
Control No. : 95/001,320
Filed: March 3, 2010
Patent No. 7,181,866

: **DECISION**
: **ON**
: **PATENT OWNER'S**
: **PETITION**
: **UNDER 37 CFR 1.181**

This is a decision addressing Patent Owner's petition, filed May 25, 2011, under 37 CFR 1.181 requesting that the amendment dated November 30, 2010 be entered into the record. This decision solely addresses the issues raised under 37 CFR 1.181, e.g., whether the examiner followed the laws and procedures in denying entry of the amendment in the Right of Appeal Notice.

The petition is before the Director of Technology Center 1600, who also oversees the Central Reexamination Unit, for decision.

Patent Owner's petition is DENIED.

STATEMENT OF FACTS RELEVANT TO THE DECISION

1. Patent No. 7,181,866 (the '866 patent) issued on February 27, 2007.
2. A request for reexamination, assigned Control No. 95/001,320 (the '320 proceeding), was filed by a third party Requester on March 3, 2010.
3. Reexamination was ordered in the '320 reexamination proceeding on April 2, 2010. An Office action on the merits was mailed on the same day. The Office action contained rejections of patent claims 1-10.
4. On April 30, 2010, Patent Owner filed a response to the Office action by the examiner. The response proposed to add new claim 11 and was supported by three declarations under 37 CFR 1.132. On May 3, 2010, Patent Owner submitted a corrected proposed amendment in compliance with Office regulations.
5. On May 28, 2010, the Requester filed comments on the Patent Owner's response, which supported the rejections set forth in the first Office action. On June 1, 2010, the Requester filed a corrected set of comments.
6. On October 29, 2010, the Office mailed an Action Closing Prosecution (ACP). The ACP continued to reject patent claims 1-10 and added a new rejection for newly proposed claim 11.
7. On November 29, 2010, Patent Owner filed a response to the ACP. The response included amendments to claims 1 and 9, cancelled claim 11, and added proposed new claims 12-16. The amendments were not in a format compliant with Office regulations. On November 30, 2010, Patent Owner submitted a corrected set of proposed amendments.
8. On December 29, 2010, the Requester filed comments.
9. On April 25, 2011, the Office mailed a Right of Appeal Notice (RAN). The RAN denied entry of the Patent Owner's November 30, 2010 response, and maintained the rejection of claims 1-11.
10. On May 25, 2011, the Patent Owner filed the instant petition under 37 CFR 1.181. The Patent Owner also filed petitions under 37 CFR 1.182 and 1.183, which will be decided in separate decisions in due course.
11. On May 25, 2011, the Patent Owner filed a Notice of Appeal.

DECISION UNDER 37 CFR 1.181

The Patent Owner (petitioner) states that they are seeking relief under 37 C.F.R. § 1.181 to have the November 30, 2010 amendment entered into the proceeding record. Petitioner specifically requests that the director find that the RAN improperly denied entry of the November 30, 2010 proposed amendment. See, e.g., pages 5-10 of the petition.

In response to petitioner's general arguments for entering the November 30, 2010 proposed amendment in this reexamination proceeding, the director finds there are not good and sufficient reasons to do so. First, 35 U.S.C. 314(c) requires that all *inter partes* reexamination proceedings to be acted upon with "special dispatch." The rules and procedures of the Office were established through notice and comment in order to achieve special dispatch in a reasonable manner. The Office rules and procedures encourage examiners to look at the facts involved in a particular proceeding and to weigh the equities before issuing a right of appeal notice (RAN) and/or an action closing prosecution (ACP). The petition does not state that the examiner failed to follow Office policies and procedures, and does not allege that the RAN was premature. The record shows that the examiner appropriately followed Office rules and procedures in the determination to issue a RAN, and did not categorically deprive the petitioner of its statutory rights to present amendments and evidence in reexamination proceedings.

In the petition, patent owner alleges that the examiner erred in deciding not to enter the proposed post-ACP amendment. Specifically, patent owner argues that the post-ACP amendment should have been entered because the ACP raised new issues that could not reasonably been anticipated. The petition states that the ACP raised new issues because it changed citations to the Szentos reference in the explanation for the second ground of rejection, it clarified claim interpretation in response to patent owner's arguments in the explanation for the first ground of rejection, and it responded to the evidence filed by the patent owner. First and foremost, these issues raised by the patent owner pertain to the ACP (and not the RAN). This petition is untimely to request relief from the examiner's actions in the ACP because it is filed more than two months from the filing date of the ACP. See 37 CFR 1.181(f). In addition, to the extent that this petition is deemed timely filed as being a petition requesting relief from the RAN, the basis for which petitioner requests entry of the post-ACP amendment is the examiner's response to argument and evidence in the patent owner's response filed May 3, 2010. To reiterate, in the ACP, the examiner was addressing arguments and evidence of the Patent Owner by clarifying issues and explaining why the newly submitted evidence is not sufficient in accordance with Office policies, and did not modify or alter the grounds of rejection. Therefore, in summary, no new grounds of rejection were made in the ACP, and this petition is not timely to request relief from the ACP. See MPEP 2673.01.

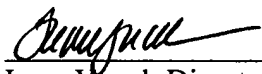
Furthermore, the petition states that the examiner erred in refusing to enter the amendment because patent owner met the requirements of 37 CFR 1.116. However, upon review of the record, it is clear that the November 30, 2010 amendments do more than simply clarify issues for appeal. For example, the amendments to claims 1 and 9

add additional limitations that were not previously claimed (e.g., “the resilient hollow member open to the ambient”). Furthermore, as explained by the examiner on pages 5-6 of the RAN, it appears that the proposed amendment to claims introduces issues under 35 U.S.C. 112. Patent owner argues that the examiner did not make a *prima facie* showing of indefiniteness or lack of written description. However, such a showing is not required as the examiner is not rejecting the claims but only explaining that the proposed amendments raises these issues as the basis for not entering the proposed amendment. In other words, the examiner needs only to state a reasonable basis for denying entry, and upon review of the record at the time of the RAN, the record supports the examiner’s analysis. In other words, the record does not show that the examiner’s actions were arbitrary and capricious. In addition, the November 30, 2010 response proposes to introduce five new claims while only cancelling one claim. Therefore, for this additional reason, denial of entry of the November 30, 2010 amendment is also in accordance with 37 CFR 1.116(b) and MPEP 2673. The record shows that the November 30, 2010 amendment clearly does more than merely cancel claims, adopt examiner’s suggestions, remove issues for appeal, or in some other way requires only a cursory review by the examiner. Finally, the examiner did make a showing of why entry of the amendment would be an undue burden as required by 37 CFR 1.116 and MPEP 2673. See pages 4-6 of the RAN. Specifically, as discussed above, the examiner explained how entry of the post-ACP amendment would raise new issues because of the proposed amendments introduces new issues and does not clarify issues for appeal. Therefore, the record shows that the examiner properly determined that the proposed post-ACP amendment should not be entered.

In summary, the examiner appropriately applied Office policies and procedures in determining that the post-ACP amendment should not be entered, and issued a RAN in the interest of “special dispatch.” For the reasons set forth above, it is deemed that the examiner followed Office rules and procedures and did not abuse her discretion in deciding to not enter the post-ACP amendments. Therefore, the patent owner’s petition is denied.

CONCLUSION

1. Patent Owner’s petition under 37 CFR 1.181, filed May 25, 2011, is DENIED for the reasons discussed above.
2. Telephone inquiries related to this decision should be directed to Andy Kashnikow, Supervisory Patent Examiner, at (571) 272-4361.



Irem Yucel, Director
Technology Center 1600



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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DATE MAILED: 07/06/2011

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Date: **MAILED**
JUN 06 2011
CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001320
PATENT NO. : 7181866
TECHNOLOGY CENTER : 3999
ART UNIT : 3993

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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MAILED
JUN 06 2011
(For Patent Owner)
CENTRAL REEXAMINATION UNIT

Steven P. Weihrouch
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1940 Duke Street
Alexandria, VA 22314

(For Third Party Requester)

In re Braunschweiler
Inter Partes Reexamination Proceeding
Control No. 95/001,320
Filed: March 3, 2010
For: U.S. Patent No. 7,181,866 B2

:
: **DECISION**
: **DISMISSING PETITION**
: **UNDER § 1.182**
:

This is a decision on the May 25, 2011 patent owner petitions entitled "PETITION UNDER 37 CFR § 1.182 REQUEST FOR CONTINUED EXAMINATION" and PETITION UNDER 37 CFR § 1.183 FOR WAIVER OF THE PROHIBITION OF AN EXTENSION OF TIME FOR FILING AN APPEAL BRIEF & FOR EXTENSION OF TIME TO FILE THE APPEAL BRIEF UNTIL AFTER DECISIONS ON PETITIONS UNDER 37 CFR § 1.182 AND § 1.183."

The patent owner petitions are before the Office of Patent Legal Administration.

The petitions under 37 C.F.R. §§ 1.182 and 1.183 are **dismissed**.

PERTINENT BACKGROUND

- On February 27, 2007, U.S. Patent No. 7,181,866 B2 ("the '866 patent") was issued to Braunschweiler having 10 claims.
- On March 3, 2010, a request for *inter partes* reexamination was filed by the third party requester, the real party in interest being K-Swiss Inc., and the resulting reexamination proceeding was assigned control number 95/001,320 ("the '1320 proceeding").

- On April 4, 2010, reexamination was ordered for claims 1-10 of the '866 patent. On the same date, an Office action was mailed, rejecting claims 1-10.
- On May 3, 2010, patent owner filed a response to the April 4, 2010 Office action, including resubmission of claims 1-10 in their previously presented form, and addition of new claim 11, and presentation of evidentiary submissions.
- On May 28, 2010, third party requester filed comments pursuant to 37 C.F.R. § 1.947.
- On October 29, 2010, an Office Action Closing Prosecution (ACP) was mailed, repeating rejections made in the May 3, 2010 Office actions on claims 1-10, and adding rejections directed to new claim 11.
- On November 29, 2010, patent owner filed a response to the October 29, 2010 ACP, presenting proposed claim amendments, new claims 12-16, and proposing cancellation of claim 11.
- On December 29, 2010, third party requester filed comments pursuant to 37 C.F.R. § 1.951(b).
- On April 25, 2011, a Right of Appeal Notice (RAN) was mailed, refusing entry of the proposed amendments and claim cancellation filed with patent owner's November 29, 2010 response.
- On May 25, 2011, patent owner filed petitions under §§ 1.181, 1.182 and 1.183 for the purpose of requesting entry of proposed claim amendments, entry of new claims 12-16, and proposed cancellation of claim 11 as submitted on November 29, 2010 and refused entry in the Right of Appeal Notice of April 25, 2011, for reopening of prosecution for consideration of the same, and for waiver of rules to permit an extension of time for the petitions under §§ 181 and 182 to be answered. On the same date, patent owner filed a Notice of Appeal.
- On June 14, 2011, patent owner's May 25, 2011 petition under § 1.181 was dismissed in a decision mailed by the Office.

PERTINENT STATUTES AND REGULATIONS

35 U.S.C. § 314 provides, in pertinent part:

- (a) **IN GENERAL.** — Except as otherwise provided in this section, reexamination shall be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133. In any inter partes reexamination proceeding under this chapter, the patent owner shall be permitted to propose any amendment to the patent and a

new claim or claims, except that no proposed amended or new claim enlarging the scope of the claims of the patent shall be permitted.

(c) SPECIAL DISPATCH. — Unless otherwise provided by the Director for good cause, all inter partes reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, shall be conducted with special dispatch within the Office.

37 C.F.R. § 1.182 provides:

All **situations not specifically provided** for in the regulations of this part will be decided in accordance with the merits of each situation by or under the authority of the Director, subject to such other requirements as may be imposed, and such decision will be communicated to the interested parties in writing. Any petition seeking a decision under this section must be accompanied by the petition fee set forth in § 1.17(f). (emphasis added)

37 C.F.R. § 1.183 provides:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, sua sponte, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

DECISION

The § 1.182 Petition

In March of 2005, the Office issued a Notice titled "Notice of Changes in Requirement for a Substantial New Question of Patentability for a Second or Subsequent Request for Reexamination While an Earlier Filed Reexamination is Pending."¹ Notice was provided therein that a patent owner could file a petition under 37 CFR § 1.182 requesting continued prosecution on the merits in the reexamination proceeding to seek entry of an amendment and/or evidence that was denied entry after a final rejection in an *ex parte* reexamination proceeding, or after an action closing prosecution in an *inter partes* reexamination proceeding.

By filing such a petition, the patent owner could obtain continued prosecution on the merits in the reexamination proceeding, including entry of the amendment and/or evidence that was denied entry after a final rejection in an *ex parte* reexamination proceeding, or after an action

¹ 1292 Off. Gaz. Pat. Office 20, March 1, 2005.

closing prosecution in an *inter partes* reexamination proceeding. Accordingly, relief in the form of a continuation of the reexamination prosecution (after a final Office action) was made available by the Office via a 37 CFR § 1.182 petition, in appropriate circumstances. This petition will be referred to herein as “the § 1.182 petition.”

The § 1.182 petition must further the prosecution of the reexamination proceeding, rather than delay it, and must provide a submission toward that end. This is critical in the reexamination setting, where 35 U.S.C. § 305 (for *ex parte* reexamination) and 35 U.S.C. § 314 (for *inter partes* reexamination) mandate that reexamination proceedings must be conducted “with special dispatch within the Office.” Accordingly, the patent owner must make a *bona fide* effort, in the submission accompanying the § 1.182 petition, to define the issues for appeal, or the issuance of a reexamination certificate, since this is a key factor in reducing pendency of a reexamination proceeding. It thus follows that the petition should therefore clearly discuss the manner in which the entry of the submission would act to overcome a rejection or satisfy a requirement of form such that the issues in the proceeding are better defined for appeal or issuance of a reexamination certificate.

Furthermore, where relief is requested under § 1.182, any continuation of prosecution in a reexamination proceeding must be in accord with the statutory mandate of 35 U.S.C. § 314(c), stating that “all inter partes reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, shall be conducted with special dispatch within the Office.” Therefore, any Office decision granting continuation of prosecution in a reexamination proceeding must further its handling of the proceeding with special dispatch.

In this instance, patent owner petitions for reopening of prosecution to present claim amendments that purport to respond to new issues raised by the October 29, 2010 ACP, such that the amendments could not have been earlier anticipated, and that entry of such would advance prosecution.

To be consistent with the requirement of special dispatch, the showing of a *bona fide* effort made during the proceeding must explain why the need for the patent owner’s proposed response could not have been anticipated earlier, and only became apparent as a result of a new issue arising at, or subsequent to, the close of prosecution in the proceeding. In this case, the record is to the contrary. It is apparent from the prosecution history that the issue for which the proposed amendments and new claims are stated to address arose in the initial Office action of April 4, 2010.

Furthermore, each of the patent claims 1-10 were rejected upon multiple grounds, such that all of the rejected claims were rejected upon at least some grounds which are not contested by petitioner to have given rise to new issues between the first Office action and the ACP.² Although patent owner chose only to argue against the legal sufficiency of the rejections in patent owner’s response to the initial Office action, patent owner could have *also* presented new claims having the scope of the presently proposed amendments, in addition to the arguments

² *E.g.*, the rejections under § 103 based upon Pagani in view of Szentes and Okabe, upon Takahashi in view of Szentes, and upon Inohara in view of Szentes.

against the rejected claims. Patent owner could have presented these claim amendments, or new claims having the scope of these amendments, in patent owner's response to the non-final Office action, and all issues could have been resolved together. It is not to be expected, in all instances, that the Office will change its position in response to arguments. The need for the instant amendment, including the presentation of new claims, to define over the examiner's rejection could have been anticipated following the first Office action, and entry at this stage would run counter to the requirement of special dispatch.

Additionally, patent owner's response includes a submission directed towards the entry of claim amendments and new claims, as described in patent owner's instant petition. Entry of these claims would increase rather than decrease the amount of issues in the present proceeding, since the proposed amendments contain previously unconsidered claim limitations which were found by the examiner to "appear to introduce new matter or are indefinite under 35 USC 112".^{3,4}

Therefore, as such reopening would not be consistent with the Office's requirement to handle reexamination proceedings with special dispatch, the instant patent owner petition under § 1.182 is **dismissed**.

The § 1.183 Petition

The instant petition is filed under § 1.183, which permits relief "[i]n an extraordinary situation, where justice requires" waiver of any requirement of the rules. Such relief may not involve waiver of any statutory requirement.

Patent owner petitioner filed the instant petition to request that the time for filing an appellant's Brief be extended until patent owner's petitions under § 1.181 and § 1.182 have been acted upon. Patent owner's petition under § 1.181 was dismissed on June 14, 2011. Patent owner's petition under § 1.182 is being dismissed in the present decision. Patent owner petitioner's petitions have thus been answered prior to the due date for filing an appellant's brief, causing the question of any waiver of the rules to become moot. Therefore, the instant patent owner petition under § 1.183 is **dismissed**.

CONCLUSION

1. The patent owner petitions under §§ 1.182 and 1.183 are **dismissed**.
2. A copy of this decision will be made of record in the reexamination file.

³ Petition at 8-9.

⁴ RAN at 5-6.

3. Telephone inquiries related to this decision should be directed to the undersigned, at (571) 272-7700.

/Michael Cygan/

Michael Cygan
Legal Advisor
Office of Patent Legal Administration

July 6, 2011



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,321	03/23/2010	6,972,116	HTRON.001RE	2114
20995	7590	07/12/2011	EXAMINER	
KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614				
			ART UNIT	PAPER NUMBER

DATE MAILED: 07/12/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

ADAMS AND REESE LLP
1221 McKINNEY STREET
SUITE 4400
HOUSTON, TX 77010

Date:

MAILED

JUL 12 2011

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001321
PATENT NO. : 6972116
TECHNOLOGY CENTER : 3999
ART UNIT : 3991

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

**Decision on Petition for Extension
of Time in Reexamination**

Control No.:95/001,321

1. THIS IS A DECISION ON THE PETITION FILED July 8, 2011.

2. THIS DECISION IS ISSUED PURSUANT TO:

- A. ☐ 37 CFR 1.550(c) – The time for taking any action by a patent owner in an *ex parte* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.
- B. ☒ 37 CFR 1.956 – The time for taking any action by a patent owner in an *inter partes* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.
- The petition is before the Central Reexamination Unit for consideration.

3. FORMAL MATTERS

Patent owner requests that the period for responding to the Office action mailed on June 22, 2011, which sets a one-month period for filing a response thereto, be extended by one month.

- A. ☒ Petition fee per 37 CFR §1.17(g):
- i. ☒ Petition includes authorization to debit a deposit account.
 - ii. ☐ Petition includes authorization to charge a credit card account.
 - iii. ☐ Other: _____.
- B. ☒ Proper certificate of service was provided. (Not required in reexamination where patent owner is requester.)
- C. ☒ Petition was timely filed.
- D. ☒ Petition properly signed.

4. DECISION (See MPEP 2265 and 2665)

- A. ☒ Granted or ☐ Granted-in-part for _____, because petitioner provided a factual accounting that established sufficient cause. (See 37 CFR 1.550(c) and 37 CFR 1.956).
- ☐ Other/comment: _____.
- B. ☐ Dismissed because:
- i. ☐ Formal matters (See unchecked box(es) (A, B, C and/or D) in section 4 above).
 - ii. ☐ Petitioner failed to provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period.
 - iii. ☐ Petitioner failed to explain why, in spite of the action taken thus far, the requested additional time is needed.
 - iv. ☐ The statements provided fail to establish sufficient cause to warrant extension of the time for taking action (See attached).
 - v. ☐ The petition is moot.
 - vi. ☐ Other/comment: _____.

5. CONCLUSION **Response is due on August 22, 2011.**

Telephone inquiries with regard to this decision should be directed to Deborah Jones at 571-272-1535 in the Central Reexamination Unit.


[Signature]

DEBORAH D. JONES
(Title) CRU SPE-AU 3991



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JAN 10 2012

Sunbeam Products, Inc. **CENTRAL REEXAMINATION UNIT** (For Patent Owner)
2381 Executive Center Dr. :
Boca Raton, FL. 33431 :

R. Joseph Trojan :
TROJAN LAW OFFICES : (For Third Party
9250 Wilshire Blvd., Suite 325 : Requester)
Beverly, CA. 90212 :

In re: Wulf et al. :
Inter Partes Reexamination Proceeding : DECISION ON PETITION
Control No.: 95/001,324 :
For: U.S. Patent No.: 7,520,659 :

This is a decision on a petition filed by the Patent Owner: a petition filed on September 14, 2010, entitled "PETITION TO EXPUNGE PURSUANT TO 37 C.F.R. § 1.59(b)".

The petition is before the Director of the Central Reexamination Unit. The decision on the petition will be **held in abeyance** until the issuance of the Notice of Intent to Issue *Ex Parte* Reexamination Certificate (NIRC) is mailed.

REVIEW OF RELEVANT FACTS

- U.S. Patent No. 7,520,659 issued on April 21, 2009.
- A request for *inter partes* reexamination was April 22, 2010 and assigned control no. 95/001,324.
- *Inter partes* reexamination was ordered on June 11, 2010.
- A Non-Final Office Action was mailed on June 11, 2010.
- The Patent Owner filed a Petition under 37 C.F.R. § 1.59(b) "petition" on September 14, 2010.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

37 C.F.R. § 1.59 Expungement of information or copy of papers in application file.

(b) An applicant may request that the Office expunge information, other than what is excluded by paragraph (a)(2) of this section, by filing a petition under this paragraph. Any petition to expunge information from an application must include the fee set forth in § 1.17(g) and establish to the satisfaction of the Director that the expungement of the information is appropriate in which case a notice granting the petition for expungement will be provided.

MPEP § 724.05 Petition To Expunge Information or Copy of Papers in Application File

A petition under 37 CFR 1.59(b) to expunge information submitted under MPEP § 724.02, or that should have been submitted under MPEP § 724.02 (as where proprietary information is submitted in an information disclosure statement but inadvertently not submitted in a sealed envelope as discussed in MPEP § 724.02) will be entertained only if the petition fee (37 CFR 1.17(g)) is filed and the information has been found not to be material to patentability. If the information is found to be material to patentability, any petition to expunge the information will be denied. Any such petition to expunge information submitted under MPEP § 724.02 should be submitted at the time of filing the information under MPEP § 724.02 and directed to the Technology Center (TC) to which the application is assigned.

DECISION

The Patent Owner (“Petitioner”) requests that material (Information Disclosure Statement (IDS)) that is subject to a protective order, submitted in a sealed envelope on September 14, 2010, be expunged from the file of the above referenced reexamination proceeding if found not to be material to patentability. The request purports to have been filed in compliance with the requirements of MPEP § 724.02.

As outlined in section 724.05 of the MPEP, material submitted under MPEP § 724.02 will be expunged, **if it is found not to be material to patentability** and the petition seeking to have the material expunged contains: (A) a clear identification of the information to be expunged without disclosure of the details thereof; (B) a clear statement that the information to be expunged is trade secret material, proprietary

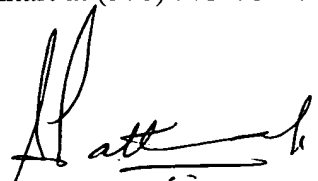
material and/or subject to a protective order, and that the information has not been otherwise made public; (C) a commitment on the part of the petitioner to retain such information for the period of any patent with regard to which such information has been submitted; (D) a statement that the petition to expunge is being submitted by, or on behalf of, the party in interest who originally submitted the information; and (E) the fee as set forth in 37 CFR 1.17(g) for a petition under 37 CFR 1.59(b). All the above-identified items have been provided.

Per the guidelines set forth in section 724.04(c), a final decision on whether the information in question is "material to patentability" in the instant reexamination proceeding will be made prior to the mailing of a Notice of Intent to Issue Ex Parte Reexamination Certificate (NIRC). The submitted information will be maintained separate from the reexamination file and will not be publicly available until a final determination is made as to whether or not the information is material to patentability.

The petition is premature because the prosecution in the present proceeding has not been terminated, and, a final determination has not yet been made as to whether or not the information requested to be expunged is "material," with "materiality" being defined as any information which the examiner considers as being important to a determination of patentability of the claims. Thus, the petition to expunge must be dismissed at this time. Therefore, based on the above determination the decision on the petition will be held in abeyance until the issuance of the Notice of Intent to Issue *Ex Parte* Reexamination Certificate (NIRC) is mailed.

CONCLUSION

1. The petition filed September 14, 2010, is held in abeyance.
3. Telephone inquiries related to this decision should be directed to Sudhanshu C. Pathak, Supervisory Patent Reexamination Examiner, at (571) 272-5509 or in his absence to Mark J. Reinhart at (571) 272-1611.



Sudhanshu C. Pathak
SPRS, CRU



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,324	04/22/2010	7520659	09-23278	5623
73723	7590	01/25/2012	EXAMINER	
Sunbeam Products, Inc. 2381 Executive Center Drive Boca Raton, FL 33431			ART UNIT	PAPER NUMBER

DATE MAILED: 01/25/2012

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

CISLO & THOMAS LLP

1333 2ND STREET

SUITE #500

SANTA MONICA, CA 90401-4110

Date:

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JAN 25 2012

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001324

PATENT NO. : 7520659

TECHNOLOGY CENTER : 3999

ART UNIT : 3991

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

Decision Granting 37 CFR 1.59 Petition in Reexamination	Control No.: 95/001,324
--	-------------------------

1. The petition under 37 CFR 1.59 to expunge proprietary, protective order and/or trade secret documents under 37 CFR 1.59 filed September 14, 2010 is granted.

2. The Patent owner's representative requests expungement of document(s) that have been filed under MPEP 724.02. The examiner has determined that the information in such document(s) presented under seal are not material to patentability in the instant reexamination proceeding. Further, the petitioner has complied with all of the requirements of MPEP 724.05.
 - A. ☒ Since the petition does not specify otherwise, the documents have been:
 - i. ☒ Destroyed.
 - ii. ☐ Expunged.

 - B. ☐ Other/Comment:

3. CONCLUSION

Telephone inquiries with regard to this decision should be directed to Deborah Jones at 571-272-1535 in the Central Reexamination Unit

/Deborah Jones/ [Signature]	SPE, Art Unit 3991, CRU (Title)
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,325	03/12/2010	6758592	09-23278	5638
73723	7590	01/10/2012	EXAMINER	
Sunbeam Products, Inc. 2381 Executive Center Drive Boca Raton, FL 33431			ART UNIT	PAPER NUMBER

DATE MAILED: 01/10/2012

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Date: 1-10-12

R. Joseph Trojan
TROJAN LAW OFFICES
9250 Wilshire Blvd.
Beverly Hills, CA 90212

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001325
PATENT NO. : 6758592
TECHNOLOGY CENTER : 3999
ART UNIT : 3991

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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CENTRAL REEXAMINATION UNIT

Sunbeam Products, Inc. : (For Patent Owner)
2381 Executive Center Dr. :
Boca Raton, FL. 33431 :

R. Joseph Trojan :
TROJAN LAW OFFICES : (For Third Party
9250 Wilshire Blvd., Suite 325 : Requester)
Beverly, CA. 90212 :

In re: Wulf et al. :
Inter Partes Reexamination Proceeding : DECISION ON PETITION
Control No.: 95/001,325 :
For: U.S. Patent No.: 6,758,592 :

This is a decision on a petition filed by the Patent Owner: a petition filed on August 9, 2010, entitled "PETITION TO EXPUNGE PURSUANT TO 37 C.F.R. § 1.59(b)".

The petition is before the Director of the Central Reexamination Unit. The decision on the petition will be **held in abeyance** until the issuance of the Notice of Intent to Issue *Ex Parte* Reexamination Certificate (NIRC) is mailed.

REVIEW OF RELEVANT FACTS

- U.S. Patent No. 6,758,592 issued on July 6, 2004.
- A request for *inter partes* reexamination was March 12, 2010 and assigned control no. 95/001,325.
- *Inter partes* reexamination was ordered on May 7, 2010.
- A Non-Final Office Action was mailed on May 7, 2010.
- The Patent Owner filed a Petition under 37 C.F.R. § 1.59(b) "petition" on August 9, 2010.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

37 C.F.R. § 1.59 Expungement of information or copy of papers in application file.

(b) An applicant may request that the Office expunge information, other than what is excluded by paragraph (a)(2) of this section, by filing a petition under this paragraph. Any petition to expunge information from an application must include the fee set forth in § 1.17(g) and establish to the satisfaction of the Director that the expungement of the information is appropriate in which case a notice granting the petition for expungement will be provided.

MPEP § 724.05 Petition To Expunge Information or Copy of Papers in Application File

A petition under 37 CFR 1.59(b) to expunge information submitted under MPEP § 724.02, or that should have been submitted under MPEP § 724.02 (as where proprietary information is submitted in an information disclosure statement but inadvertently not submitted in a sealed envelope as discussed in MPEP § 724.02) will be entertained only if the petition fee (37 CFR 1.17(g)) is filed and the information has been found not to be material to patentability. If the information is found to be material to patentability, any petition to expunge the information will be denied. Any such petition to expunge information submitted under MPEP § 724.02 should be submitted at the time of filing the information under MPEP § 724.02 and directed to the Technology Center (TC) to which the application is assigned.

DECISION

The Patent Owner (“Petitioner”) requests that material (Information Disclosure Statement (IDS)) that is subject to a protective order, submitted in a sealed envelope on July 9, 2010, be expunged from the file of the above referenced reexamination proceeding if found not to be material to patentability. The request purports to have been filed in compliance with the requirements of MPEP § 724.02.

As outlined in section 724.05 of the MPEP, material submitted under MPEP § 724.02 will be expunged, **if it is found not to be material to patentability** and the petition seeking to have the material expunged contains: (A) a clear identification of the information to be expunged without disclosure of the details thereof; (B) a clear statement that the information to be expunged is trade secret material, proprietary

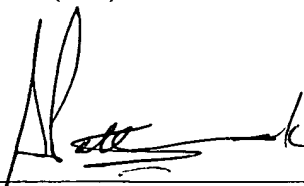
material and/or subject to a protective order, and that the information has not been otherwise made public; (C) a commitment on the part of the petitioner to retain such information for the period of any patent with regard to which such information has been submitted; (D) a statement that the petition to expunge is being submitted by, or on behalf of, the party in interest who originally submitted the information; and (E) the fee as set forth in 37 CFR 1.17(g) for a petition under 37 CFR 1.59(b). All the above-identified items have been provided.

Per the guidelines set forth in section 724.04(c), a final decision on whether the information in question is "material to patentability" in the instant reexamination proceeding will be made prior to the mailing of a Notice of Intent to Issue *Ex Parte* Reexamination Certificate (NIRC). The submitted information will be maintained separate from the reexamination file and will not be publicly available until a final determination is made as to whether or not the information is material to patentability.

The petition is premature because the prosecution in the present proceeding has not been terminated, and, a final determination has not yet been made as to whether or not the information requested to be expunged is "material," with "materiality" being defined as any information which the examiner considers as being important to a determination of patentability of the claims. Thus, the petition to expunge must be dismissed at this time. Therefore, based on the above determination the decision on the petition will be held in abeyance until the issuance of the Notice of Intent to Issue *Ex Parte* Reexamination Certificate (NIRC) is mailed.

CONCLUSION

1. The petition filed August 9, 2010, is held in abeyance.
3. Telephone inquiries related to this decision should be directed to Sudhanshu C. Pathak, Supervisory Patent Reexamination Examiner, at (571) 272-5509 or in his absence to Mark J. Reinhart at (571) 272-1611.



Sudhanshu C. Pathak
SPRS, CRU

Decision Granting 37 CFR 1.59 Petition in Reexamination	Control No.:95/001,325
<p>1. The petition under 37 CFR 1.59 to expunge proprietary, protective order and/or trade secret documents under 37 CFR 1.59 filed <u>August 11, 2010</u> is granted.</p> <p>2. The Patent owner's representative requests expungement of document(s) that have been filed under MPEP 724.02. The examiner has determined that the information in such document(s) presented under seal are not material to patentability in the instant reexamination proceeding. Further, the petitioner has complied with all of the requirements of MPEP 724.05.</p> <p>A. <input checked="" type="checkbox"/> Since the petition does not specify otherwise, the documents have been:</p> <p>i. <input type="checkbox"/> Destroyed.</p> <p>ii. <input checked="" type="checkbox"/> Expunged.</p> <p>B. <input type="checkbox"/> Other/Comment:</p> <p>_____</p> <p>3. CONCLUSION</p> <p>Telephone inquiries with regard to this decision should be directed to Deborah Jones at 571-272-1535 in the Central Reexamination Unit</p> <p>/Deborah Jones/ [Signature]</p> <p>SPE, Art Unit 3991, CRU (Title)</p>	



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,325	03/12/2010	6758592	09-23278	5638
73723	7590	01/25/2012	EXAMINER	
Sunbeam Products, Inc. 2381 Executive Center Drive Boca Raton, FL 33431			ART UNIT	PAPER NUMBER

DATE MAILED: 01/25/2012

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Date: 1-25-12

R. Joseph Trojan
TROJAN LAW OFFICES
9250 Wilshire Blvd.
Beverly Hills, CA 90212

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001325
PATENT NO. : 6758592
TECHNOLOGY CENTER : 3999
ART UNIT : 3991

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

**Decision Granting 37 CFR 1.59
Petition in Reexamination**

Control No.:95/001,325

1. The petition under 37 CFR 1.59 to expunge proprietary, protective order and/or trade secret documents under 37 CFR 1.59 filed August 9, 2010 is granted.
2. The Patent owner's representative requests expungement of document(s) that have been filed under MPEP 724.02. The examiner has determined that the information in such document(s) presented under seal are not material to patentability in the instant reexamination proceeding. Further, the petitioner has complied with all of the requirements of MPEP 724.05.

A. ☒ Since the petition does not specify otherwise, the documents have been:

- i. ☐ Destroyed.
- ii. ☒ Expunged.

B. ☐ Other/Comment:

3. CONCLUSION

Telephone inquiries with regard to this decision should be directed to Deborah Jones at 571-272-1535 in the Central Reexamination Unit

/Deborah Jones/
[Signature]

SPE, Art Unit 3991, CRU
(Title)



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,328	03/19/2010	Patent No. 7146446	ACQI-010/13US 310578-2059	4265
58249	7590	10/03/2011	EXAMINER	
COOLEY LLP ATTN: Patent Group Suite 1100 777 - 6th Street, NW WASHINGTON, DC 20001			ART UNIT	PAPER NUMBER

DATE MAILED: 10/03/2011

Please find below and/or attached an Office communication concerning this application or proceeding.



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

HAYNES AND BOONE, LLP

IP SECTION

2323 VICTORY AVENUE SUITE 700

DALLAS, TX 75219

Date:

MAILED

OCT 03 2011

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001328

PATENT NO. : 7146446

TECHNOLOGY CENTER : 3999

ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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(For Patent Owner)

COOLEY LLP
ATTN: Patent Group
Suite 1100
777 - 6th Street, NW
WASHINGTON DC 20001

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OCT 03 2011

CENTRAL REEXAMINATION UNIT

(For Requester)

HAYNES AND BOONE, LLP
IP SECTION
2323 VICTORY AVENUE
SUITE 700
DALLAS, TX 75219

In re: Chu
Reexamination Proceeding
Control No. 95/001,328
Request Deposited: March 19, 2010
For: U.S. Patent No. 7,328,297

:
: **DECISION**
: **DISMISSING**
: **PETITIONS**
:

The *inter partes* reexamination is before the Central Reexamination Unit to address the October 28, 2010 patent owner (PO) paper entitled "PETITION UNDER 37 C.F.R. § 1.181 REQUESTING EXPUNGEMENT OF THIRD PARTY COMMENTS FILED SEPTEMBER 23, 2010" and the November 12, 2010 third party requester (3PR) paper entitled "PETITION UNDER 37 C.F.R. § 1.181 REQUESTING DENIAL OF THE PETITION FILED OCTOBER 28, 2010".

PO petitioner argues that the examiner should not consider the IEEE 1355 reference or the Microsoft Dictionary. However, it is noted that PO submitted these same documents in their IDS filed on December 15, 2010. Accordingly, the request to have the examiner not consider these references is considered moot in view of the fact the PO submitted these for consideration by the examiner a few weeks later.

As to the PO contention that the examiner should not consider various proposed rejections set forth in the 3PR comments, the request was initially premature and the subsequently issued Action Closing Prosecution (ACP) addressed PO's concerns.

Accordingly, the petitions are dismissed as moot.

Application/Control Number: 95/001,328

Page 2

Art Unit: 3992

Inquiries regarding this decision may be directed to Eric Keasel, Supervisory Patent Examiner, at (571) 272-4929.

This decision is not a final agency decision and is without prejudice to request reconsideration or higher-level review.

A handwritten signature in cursive script, reading "Eric Keasel", positioned above a horizontal line.

Eric Keasel

SPE, Central Reexamination Unit, Art Unit 3992



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,329	07/06/2010	7671214	073986.156	7531
37509	7590	12/19/2011	EXAMINER	
DECHERT LLP P.O. BOX 390460 MOUNTAIN VIEW, CA 94039-0460			ART UNIT	PAPER NUMBER

DATE MAILED: 12/19/2011

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Date:

CENTRAL REEXAMINATION UNIT

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
PIERCE BIOTECHNOLOGY, INC.
3747 N. MERIDIAN RD.
ROCKFORD, IL 61101

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001329
PATENT NO. : 7671214
TECHNOLOGY CENTER : 3999
ART UNIT : 3991

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

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If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

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DECHERT LLP
P.O. Box 390460
Mountain View, CA 94039-0460

(For Patent Owner)

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CENTRAL REEXAMINATION UNIT

PIERCE BIOTECHNOLOGY, INC..
3747 N. Meridian Rd.
Rockford, IL 61101

(For Requester)

Reexamination Proceeding
Control No.: 95/001,329
Deposited: July 6, 2010
For: U.S. Patent No.: 7,671,214


**DECISION ON
REQUEST**

This is a decision on the paper filed September 13, 2010 requesting the petition filed under 37 CFR 1.927 on October 12, 2010 be withdrawn.

The request is granted.

The petition filed under 37 CFR 1.927 on October 12, 2010 is dismissed as moot.

Telephone inquiries related to this decision should be directed to the undersigned at (571) 272-1535.

 12/15/2011
Deborah Jones
SPE/ AU 3991
Central Reexamination Unit



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,333	04/01/2010	6859699	410630139	3732
38598	7590	10/25/2011	EXAMINER	
ANDREWS KURTH LLP 1350 I STREET, N.W. SUITE 1100 WASHINGTON, DC 20005			ART UNIT	PAPER NUMBER

DATE MAILED: 10/25/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

PERKINS COIE LLP

P.O. BOX 1208

SEATTLE, WA 98111-1208

Date:

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OCT 25 2011

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001333

PATENT NO. : 6859699

TECHNOLOGY CENTER : 3999

ART UNIT : 3993

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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Kirupa Pushparaj
PERKINS COIE LLP
P.O. BOX 1208
SEATTLE, WA 98111-1208

(For 3rd Party Requester)

MAILED

OCT 25 2011

Sean Wooden
ANDREWS KURTH LLP
1350 I STREET, N.W.
SUITE 1100
WASHINGTON DC 20005

(For Patent Owner)

CENTRAL REEXAMINATION UNIT

In re: Carroll et alia
Inter Partes Reexamination Proceeding
Control No. 95/001,333
Deposited on: 1 April 2010
For: US Patent No. 6,859,699

DECISION GRANTING
PETITION FOR ENTRY OF
PREVIOUSLY RETURNED
COMMENTS
37 CFR 1.181

This is a decision on the petition, filed 1 September 2011, to have previously-returned comments entered pursuant to 37 CFR 1.181.

The petition is **granted** for the reasons set forth below.

REVIEW OF RELEVANT FACTS

- Patent Owner filed an Owner's Response on 31 August 2010 to a non-final Office action mailed on 2 July 2010.
- In response, the Third Party Requester ("Requester") filed a set of comments under 37 CFR 1.947 on 29 September 2010 ("the Original Comments"), which contained a total of twenty proposed rejections.
- The Examiner mailed a Notice of Defective Paper ("Notice") on 29 March 2010 indicating that nine proposed rejections of the twenty proposed rejection submitted in the Original Comments did not comply with 37 CFR 1.947.
- In response to the Notice, the Requester submitted a set of Revised Comments on 12 April 2010, in which the Requester removed each and every one of the nine proposed rejections identified by the Examiner.

- In a Second Office action, mailed on 22 August 2011, the Examiner refused entry of the Revised Comments due to the inclusion of a proposed rejection (“the 10th proposed rejection”), which was originally present in the Original Comments, but which had not been identified as defective in the Notice.

CITATION OF RELEVANT AUTHORITY

37 C.F.R. § 1.181 *Petition to the Director* states, in part:

- (a) Petition may be taken to the Director:
 - (1) From any action or requirement of any examiner in the ex parte prosecution of an application, or in ex parte or inter partes prosecution of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court;

37 C.F.R. § 1.947 *Comments by Third Party Requester to Patent Owner’s Response in Inter Partes Reexamination* states, in part:

Each time the patent owner files a response to an Office action on the merits pursuant to § 1.945, a third party requester may once file written comments within a period of 30 days from the date of service of the patent owner’s response. These comments shall be limited to issues raised by the Office action or the patent owner’s response.

MPEP 2666.05(II) *Third Party Comments After Patent Owner Response* states, in part:

If the written comments are improper, the examiner should return the written comments (the entire paper) with an explanation of what is not proper.

DECISION

Any comments submitted by a third party requester shall be limited to issues raised by the Office action or the patent owner’s response. 37 CFR 1.947. “If the written comments are improper, the examiner should return the written comments (the entire paper) with an explanation of what is not proper”. MPEP 2666.05(II). In the Notice of Defective Paper, the Examiner identified nine of the twenty proposed rejections as being defective as not being limited to issues raised by the Office action or the patent owner’s response. The Examiner failed to object to or otherwise identify in the Notice any defect in relation to the 10th proposed rejection which was the basis for denying entry of the Revised Comments, even though the 10th proposed rejection was present in the Original Comments. Thus, the Revised Comments submitted by the Requester fully followed the guidance of the Notice and eliminated all proposed rejections that were specifically deemed unacceptable by the Examiner.

CONCLUSION

1. In view of the foregoing, the request to enter previously-retained comments pursuant to 37 CFR 1.181 is **granted**.
2. The Amended Revised Comments, attached to the petition, in which the Requester has removed the 10th proposed rejection, will be made of record and considered by the Examiner.
3. The proceeding is being returned to the Examiner for issuance of the appropriate action.
4. All correspondence involving this proceeding may be addressed to the following:

By Mail to: Mail Stop *Ex Parte* Reexam
Central Reexamination Unit
Commissioner for Patents
United States Patent & Trademark Office
P. O. Box 1450
Alexandria, VA 22313-1450

By Fax to: (571) 273-9900
Central Reexamination Unit

By Hand: Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

By EFS: Registered users of EFS-Web may alternatively submit such correspondence via the electronic filing system EFS-Web, at <https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html>. EFS-Web offers the benefit of quick submission to the particular area of the Office that needs to act on the correspondence. Also, EFS-Web submissions are "soft scanned" (i.e., electronically uploaded) directly into the official file for the reexamination proceeding, which offers parties the opportunity to review the content of their submissions after the "soft scanning" process is complete.

5. Telephone inquiries related to this decision should be directed to Daniel Ryman, at (571)272-3152 or Mark Reinhart, at (571) 272-1611, who are Supervisory Patent Examiners in Art Unit 3992. In their absence, telephone inquiries should be directed to the undersigned at (571) 272-0700.



Irem Yucel
Director, Central Reexamination Unit



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,336	04/19/2010	7328297	ACQI-010/14US 310578-2060	4690
58249	7590	04/18/2011	EXAMINER	
COOLEY LLP ATTN: Patent Group Suite 1100 777 - 6th Street, NW WASHINGTON, DC . 20001			ART UNIT	PAPER NUMBER

DATE MAILED: 04/18/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Date: 4-18-11

David L. McCombs
HAYNES AND BOONE LLP, IP SECTION
2323 Victory Ave., Suite 700
Dallas, TX 75219

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001336
PATENT NO. : 7328297
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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CENTRAL REEXAMINATION UNIT

(For Patent Owner)

COOLEY LLP
ATTN: Patent Group
Suite 1100
777 - 6th Street, NW
WASHINGTON DC 20001

(For Requester)

HAYNES AND BOONE, LLP
IP SECTION
2323 VICTORY AVENUE
SUITE 700
DALLAS, TX 75219

In re: Chu
Reexamination Proceeding
Control No. 95/001,336
Request Deposited: April 19, 2010
For: U.S. Patent No. 7,328,297

:
: **DECISION**
: **DISMISSING**
: **PETITIONS**
:

The *inter partes* reexamination is before the Central Reexamination Unit to address the November 17, 2010 patent owner paper entitled "PETITION UNDER 37 C.F.R. § 1.181 REQUESTING RETURN OF THIRD PARTY COMMENTS FILED NOVEMBER 2, 2010" and the December 16, 2010 third party requester paper entitled "PETITION UNDER 37 C.F.R. § 1.181 REQUESTING DENIAL OF THE PETITION FILED NOVEMBER 17, 2010".

As the office has not yet issued an office action addressing the comments of November 2, 2010, both requests are **dismissed as premature**.

Inquiries regarding this decision may be directed to Eric Keasel, Supervisory Patent Examiner, at (571) 272-4929.

This decision is not a final agency decision and is without prejudice to request reconsideration or higher-level review.

Eric Keasel
SPE, Central Reexamination Unit, Art Unit 3992



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,336	04/19/2010	7328297	ACQI-010/14US 310578-2060	4690
58249	7590	02/28/2012	EXAMINER	
COOLEY LLP ATTN: Patent Group Suite 1100 777 - 6th Street, NW WASHINGTON, DC 20001			ART UNIT	PAPER NUMBER

DATE MAILED: 02/28/2012

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David L. McCombs
HAYNES AND BOONE LLP, IP SECTION
2323 Victory Ave., Suite 700
Dallas, TX 75219

Date: **MAILED**

FEB 28 2012

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001336
PATENT NO. : 7328297
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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(For Patent Owner)

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CENTRAL REEXAMINATION UNIT

HAYNES AND BOONE, LLP
IP SECTION
2323 VICTORY AVENUE
SUITE 700
DALLAS, TX 75219

(For Third Party Requester)

Inter Partes Reexamination Proceeding
Control No. 95/001,336
Filed: April 19, 2010
For: U.S. Patent No. 7,328,297 B2

:
: **DECISION**
: **DISMISSING**
: **PETITION**
:

This is a decision on the May 12, 2011 third party requester petition under 37 CFR 1.183 requesting waiver of the page limit requirement of 37 CFR 1.943(b) for its comments submission filed in reply to the patent owner's supplemental response. The third party requester timely filed its comments submission under 37 CFR 1.947 concurrently with the petition.

The petition under 37 CFR 1.183 is before the Office of Patent Legal Administration.

For the reasons set forth below, the third party requester's petition under 37 CFR 1.183 is **dismissed**.

DECISION

37 CFR 1.183 provides:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

In the present petition under 37 CFR 1.183, the third party requester requests waiver of the requirement under 37 CFR 1.943(b) with respect to the 50-page limit for the third party requester's comments submission filed concurrently with the present petition and directed solely to the April 12, 2011 supplemental patent owner response.

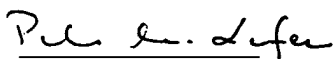
On April 26, 2011, the third party requester filed a paper entitled "Third-party Requester's Petition Requesting Denial of Entry of the Patent Owner's Supplemental Response, Filed April 12, 2011, to Office Action Mailed on August 4, 2010," which will be taken as a petition under 37 CFR 1.181 (the § 1.181 petition) challenging the entry of the patent owner's April 12, 2011 supplemental response.

Since the requester's April 26, 2011 § 1.181 petition has not yet been decided, the instant requester petition under 37 CFR 1.183 is premature- if the requester's § 1.181 petition should be granted, then the present requester petition requesting waiver of the requirement of 37 CFR 1.943(b) would be moot.¹ The third party requester retains the option of seasonably filing a renewed petition under 37 CFR 1.183 requesting waiver of the requirement of 37 CFR 1.943(b) for its comments submission directed only to the patent owner supplemental response should the decision on the § 1.181 petition be not to grant the petition. Until such time, the issue is not ripe for consideration by the Office under 37 CFR 1.183. When no further challenge under 37 CFR 1.181 is filed by the requester as to denial of the entry of the April 12, 2011 supplemental patent owner response, the requester may renew the present petition under 37 CFR 1.183.

In view of the above, the petition under 37 CFR 1.183 is dismissed as premature.

CONCLUSION

1. The third party requester petition under 37 CFR 1.183 filed on May 12, 2011 is dismissed as being premature.
2. Telephone inquiries related to this decision should be directed to Susy Tsang-Foster, Legal Advisor, at (571) 272-7711.



Pinchus M. Laufer
Senior Legal Advisor
Office of Patent Legal Administration

02-27-2012

¹ That is, if relief is granted under 37 CFR 1.181 to deny of entry of the patent owner supplemental response, then both the patent owner supplemental response and the comments submission in response thereto would be expunged from the record as improper papers.



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,336	04/19/2010	7328297	ACQI-010/14US 310578-2060	4690
58249	7590	04/04/2012	EXAMINER	
COOLEY LLP ATTN: Patent Group Suite 1100 777 - 6th Street, NW WASHINGTON, DC 20001			ART UNIT	PAPER NUMBER

DATE MAILED: 04/04/2012

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Date:

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HAYNES AND BOONE LLP, IP SECTION

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**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001336

PATENT NO. : 7328297

TECHNOLOGY CENTER : 3999

ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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COOLEY LLP
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SUITE 1100
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(For Patent Owner)

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CENTRAL REEXAMINATION UNIT

HAYNES AND BOONE, LLP
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DALLAS, TX 75219

(For Third Party Requester)

In re *Chu*
Control No. 95/001,336
Filed: April 19, 2010
For: U.S. Patent No. 7,328,297

:
: **DECISION**
: **DISMISSING**
: **PETITIONS**

This decision is in response to Third Party Requester's petition, filed on April 26, 2011, under 37 CFR 1.182, which is treated as a petition under 37 CFR 1.181 to invoke supervisory authority to not enter Patent Owner's supplemental response of April 12, 2011. This decision also addresses the Patent Owner's petition, dated July 12, 2011, under 37 CFR 1.181 to expunge Requester's July 12, 2011 comments to Patent Owner's supplemental response.

The petitions are before the Director of the Central Reexamination Unit for decision.

The Requester's petition, filed on April 26, 2011, and Patent Owner's petition, filed on July 12, 2011 are dismissed as premature for the reasons expressed below.

STATEMENT OF FACTS RELEVANT TO THE DECISION

- U.S. Patent No. 7,328,297 (the '297 patent) issued on February 5, 2008.
- A completed request for reexamination of the '297 patent was filed on April 19, 2010. The request was assigned control No. 95/001,336 (the '336 proceeding).
- On June 17, 2010, the Office ordered that the patent be reexamined.
- On August 4, 2010, the Office mailed a first Office action in the '336 proceeding.
- On October 4, 2010, the Patent Owner filed a response to the Office action.
- On November 2, 2010, the Third Party Requester filed comments.
- On November 17, 2010, the Patent Owner filed a petition under 37 CFR 1.181 requesting that the November 2, 2010 comments be expunged from the record of the '336 proceeding.
- On December 16, 2010, the Requester filed an opposition petition to the Patent Owner's November 17, 2010 petition.
- On April 12, 2011, the Patent Owner filed a supplemental response to the Office action, mailed on August 4, 2010.
- On April 18, 2011, the Office mailed a decision dismissing the November 17 and December 16, 2010 petitions as premature.
- On April 26, 2011, the Requester filed the instant petition requesting that the April 12, 2011 supplemental response not be entered into the record of the '336 proceeding.
- On May 12, 2011, the Requester filed comments on the April 12, 2011 supplemental response.
- On May 17, 2011, the Patent Owner renewed its petition to have the comments filed by the Requester on November 2, 2010 returned. This petition will be separately decided.
- On May 25, 2011, the Requester filed an opposition to Patent Owner's petition filed on May 17, 2011. This petition will be separately decided.
- On July 12, 2011, the Patent Owner filed the instant petition under 37 CFR 1.181 requesting that Requester's May 12, 2011 comments be expunged from the record.
- To date, the examiner has not acted on the responses and comments filed.

DECISION

As pointed out, the Requester filed an April 26, 2011 petition under 37 CFR 1.182 to not enter the Patent Owner's April 12, 2011 supplemental response. It is noted that a petition under 37 CFR 1.182 is not proper because the petition addresses issues that are properly raised under 37 CFR 1.181. Therefore, the petition is being addressed under 37 CFR 1.181. In other words, a petition under 37 CFR 1.182 is not the proper means to seek relief for the issues raised in the May 12, 2011 petition. In summary, although the petition contains statements that relief sought is under 37 CFR 1.182, the petition is being addressed as a petition under 37 CFR 1.181.

As pointed out, Requester's petition requests that Patent Owner's April 12, 2011 supplemental response not be entered into the record. Requester asserts that the April 12, 2011 supplemental response fails to meet the requirements of 37 CFR 1.111(a)(2) for entry. In addition, the Patent Owner filed a July 12, 2011 petition requesting expungement of Requester's May 12, 2011 comments filed on the April 12, 2010 supplemental response. Patent Owner alleges that the May 12, 2011 comments were not in compliance with the requirements of 37 CFR 1.947. For these reason, Requester asserts that Patent Owner's April 12, 2011 supplemental response should not be entered and Patent Owner asserts that Requester's May 12, 2011 comments should be expunged from the proceeding record.

However, there has been no decision by the examiner if the Patent Owner's April 12, 2011 supplemental response or the Third Party Requester's comments of May 12, 2011 are entered into the record and are in compliance with Office rules and procedures. Accordingly, it is premature to invoke supervisory authority regarding entry of the April 12, 2011 supplemental response or the May 12, 2011 comments because the examiner has not made his or her decision. Thus, the Requester's April 26, 2011 petition and the Patent Owner's July 12, 2011 petition are premature and are accordingly dismissed.

CONCLUSION

1. The April 26, 2011 Requester's petition is dismissed as premature.
2. The July 12, 2011 Patent Owner's petition is dismissed as premature.
3. Any response should be addressed as follows:


By Mail to: Mail Stop *Inter Partes* Reexam
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Commissioner for Patents
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Alexandria, VA 22313-1450

By Fax to: (571) 273-9900
Central Reexamination Unit

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By EFS: Registered users of EFS-Web may submit such correspondence via EFS-Web, at **<https://efs.uspto.gov/efile/myportal/efs-registered>**. EFS-Web offers the benefit of quick submission to the particular area of the Office that needs to act on the correspondence. Also, EFS-Web submissions are "soft scanned" (i.e., electronically uploaded) directly into the official file for the reexamination proceeding, which offers parties the opportunity to review the content of their submissions after the "soft scanning" process is complete.

4. Telephone inquiries related to this decision should be directed to Sudhanshu Pathak, Supervisory Patent Examiner, at (571) 272-5509.



Irem Yucel
Director, Central Reexamination Unit



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,336	04/19/2010	7328297	ACQI-010/14US 310578-2060	4690
58249	7590	04/09/2012	EXAMINER	
COOLEY LLP ATTN: Patent Group Suite 1100 777 - 6th Street, NW WASHINGTON, DC 20001			ART UNIT	PAPER NUMBER

DATE MAILED: 04/09/2012

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

David L. McCombs

HAYNES AND BOONE LLP, IP SECTION

2323 Victory Ave., Suite 700

Dallas, TX 75219

Date: **MAILED**

APR 09 2012

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001336

PATENT NO. : 7328297

TECHNOLOGY CENTER : 3999

ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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COOLEY LLP
ATTN: PATENT GROUP
SUITE 1100
777 6TH STREET, NW
WASHINGTON, D.C. 20001

(For Patent Owner)

MAILED

APR 09 2012

CENTRAL REEXAMINATION UNIT

HAYNES AND BOONE, LLP
IP SECTION
2323 VICTORY AVENUE
SUITE 700
DALLAS, TX 75219

(For Third Party Requester)

In re *Chu*
Control No. 95/001,336
Filed: April 19, 2010
For: U.S. Patent No. 7,328,297

:
: **DECISION**
: **DISMISSING**
: **PETITIONS**

This decision is in response to Patent Owner's renewed petition, filed on May 17, 2011, under 37 CFR 1.182, which is treated as a petition under 37 CFR 1.181, to invoke supervisory authority to expunge the Third Party Requester's [hereinafter, "the Requester"] Comments of November 2, 2010. This decision also addresses the Requester's opposition petition dated May 25, 2011.

The petitions are before the Director of the Central Reexamination Unit for decision.

The Patent Owner's petition, filed on May 17, 2011, and the Requester's opposition petition, filed on May 25, 2011, are dismissed as moot for the reasons expressed below.

STATEMENT OF FACTS RELEVANT TO THE DECISION

- U.S. Patent No. 7,328,297 (the '297 patent) issued on February 5, 2008.
- On April 19, 2010, the Requester filed a completed request for reexamination of the '297 patent. The request was assigned control number 95/001,336 (the '336 proceeding).
- On June 17, 2010, the Office ordered that the patent be reexamined.
- On August 4, 2010, the Office mailed a first Office action in the '336 proceeding.
- On October 4, 2010, the Patent Owner filed a response to the Office action.
- On November 2, 2010, the Third Party Requester filed comments.
- On November 17, 2010, the Patent Owner filed a petition under 37 CFR 1.181 requesting that the November 2, 2010 comments be expunged from the record of the '336 proceeding.
- On December 16, 2010, the Requester filed an opposition petition to the Patent Owner's November 17, 2010 petition.
- On April 12, 2011, the Patent Owner filed a supplemental response to the Office action, mailed on August 4, 2010.
- On April 18, 2011, the Office mailed a decision dismissing the November 17 and December 16, 2010 petitions as premature.
- On April 26, 2011, the Requester filed a petition requesting denial of entry of the supplemental response filed on April 12, 2011.
- On May 12, 2011, the Requester filed supplemental comments.
- On May 17, 2011, the Patent Owner filed the instant petition under 37 CFR 1.182 requesting that the Office expunge the comments filed by the Requester on November 2, 2010.
- On May 25, 2011, the Requester filed an opposition petition to Patent Owner's May 17, 2011 petition.
- On July 12, 2011, the Patent Owner filed a petition requesting expungement of the supplemental comments filed on May 12, 2011.

- On April 4, 2010, the Office mailed a decision dismissing the April 26 and July 12, 2011 petitions as premature.
- On April 5, 2012, the Office mailed a Notification of Defective Paper in a Reexamination regarding the Third Party Requester's comments filed on November 2, 2010.

DECISION

As pointed out, the Patent Owner filed a May 17, 2011 renewed petition under 37 CFR 1.182 to expunge the Third Party Requester's November 2, 2010 comments. It is noted that a petition under 37 CFR 1.182 is not proper because the petition addresses issues that are properly raised under 37 CFR 1.181. Therefore, the petition is being addressed under 37 CFR 1.181. In other words, a petition under 37 CFR 1.182 is not the proper means to seek relief for the issues raised in the May 17, 2011 petition. In summary, although the petition contains statements that relief sought is under 37 CFR 1.182, the petition is being addressed as a petition under 37 CFR 1.181.

The renewed petition, filed on May 17, 2011, requests expungement of the Requester's comments filed on November 2, 2010. Patent Owner alleges that the November 2, 2010 comments were not in compliance with the requirements of 37 CFR 1.947 because they introduced new references to propose new grounds of rejection for original claims. Renewed Petition, pp. 4-8. For this reason, Patent Owner asserts that Requester's comments filed on November 2, 2010 should be expunged from the proceeding record.

On April 5, 2012, as discussed above, the Office mailed a Notification of Defective Papers in a Reexamination that determined that the November 2, 2010 comments are improper papers and expunged the comments from the record. As the November 2, 2010 comments have been entered into the electronic Image File Wrapper (IFW) record, the comments are expunged from the record by closing the papers in the IFW record, and marking the papers nonpublic. See MPEP 2667.

As a result of the April 4, 2012 Notice, the remedy of expungement of the November 2, 2010 comments is already given. In other words, the ultimate relief requested by the May 17, 2011 petition, and opposed by the May 25, 2011 petition by Requester, was given by the April 5, 2012 Office decision.

For these reasons, the Patent Owner's May 17, 2011 petition, and the Requester's May 25, 2011 petition, are moot, and hereby, dismissed.

CONCLUSION

1. The May 12, 2011 Patent Owner's petition is dismissed as moot.
2. The May 19, 2011 Requester's opposition petition is dismissed as moot.
3. Any response should be addressed as follows:

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By Fax to: (571) 273-9900
Central Reexamination Unit

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By EFS: Registered users of EFS-Web may submit such correspondence via EFS-Web, at **<https://efs.uspto.gov/efile/myportal/efs-registered>**. EFS-Web offers the benefit of quick submission to the particular area of the Office that needs to act on the correspondence. Also, EFS-Web submissions are "soft scanned" (i.e., electronically uploaded) directly into the official file for the reexamination proceeding, which offers parties the opportunity to review the content of their submissions after the "soft scanning" process is complete.

4. Telephone inquiries related to this decision should be directed to Sudhanshu Pathak, Supervisory Patent Examiner, at (571) 272-5509.



Irem Yucel
Director, Central Reexamination Unit



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,339	06/08/2010	7619912	043326-000-0021	5035
20995	7590	07/29/2011	EXAMINER	
KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614			ART UNIT	PAPER NUMBER

DATE MAILED: 07/29/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
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P.O. BOX 10500
MCLEAN, VA 22102

Date:

MAILED

JUL 29 2011

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001339
PATENT NO. : 7619912
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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(For Patent Owner)

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(For '0578 *Inter Partes* Requester)

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(For '0579 *Inter Partes* Requester)

Pillsbury Winthrop Shaw Pittman LLP
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McLean, VA 22102

(For '1339 *Inter Partes* Requester)

Inter Partes Reexamination Proceeding
Control No. 95/000,578
Filed: October 20, 2010
For: U.S. Patent No. 7,619,912
Inter Partes Reexamination Proceeding
Control No. 95/000,579
Filed: October 21, 2010
For: U.S. Patent No. 7,619,912
Inter Partes Reexamination Proceeding
Control No. 95/001,339
Filed: June 8, 2010
For: U.S. Patent No. 7,619,912

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: **DECISION**
: **GRANTING**
: **PETITION**
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:

This is a decision on the patent owner paper entitled "PATENTEE'S PETITION PURSUANT TO 37 C.F.R. § 1.183 TO SUSPEND OR WAIVE THE PAGE COUNT LIMIT OF 37 C.F.R. § 1.943(b)" (the petition under 37 CFR 1.183), filed on July 5, 2011.

The patent owner petition is before the Office of Patent Legal Administration for consideration.

The patent owner petition under 37 CFR 1.183 is granted for the reasons set forth herein.

BACKGROUND

1. On November 17, 2009, United States Patent No. 7,619,912 (the '912 patent) issued to Bhakta et al.
2. On April 20, 2010, a first request for *inter partes* reexamination of the '912 patent was deposited by a third party requester (the '1339 requester), which request was assigned Reexamination Control No. 95/001,339 (the '1339 proceeding). The '1339 proceeding was assigned a filing date of June 8, 2010.
3. On September 1, 2010, the Office ordered reexamination of the '912 patent in the '1339 proceeding and concurrently issued an action closing prosecution (ACP), confirming all of the claims of the '912 patent under reexamination.
4. On October 20, 2010, a second request for *inter partes* reexamination of the '912 patent was filed by another third party requester (the '0578 requester), which request was assigned Reexamination Control No. 95/000,578 (the '0578 proceeding).
5. On October 21, 2010, a third request for *inter partes* reexamination of the '912 patent was filed by another third party requester (the '0579 requester), which request was assigned Reexamination Control No. 95/000,579 (the '0579 proceeding).
6. On January 14, 2011, the Office ordered reexamination of the '912 patent in the '0579 proceeding.
7. On January 18, 2011, the Office ordered reexamination of the '912 patent in the '0578 proceeding.
8. On February 28, 2011, the Office issued a decision merging, *sua sponte*, the '0578, '0579 and '1339 proceedings (the merged proceeding).
9. On April 4, 2011, the Office issued a non-final Office action in the merged proceeding.
10. On July 5, 2011, the patent owner timely filed a response submission in the merged proceeding, concurrently with the instant petition under 37 CFR 1.183.¹

DECISION

I. Relevant Authority

37 CFR 1.183 provides:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be

¹ See April 20, 2011 decision granting a one-month extension of time for patent owner to file a response to the April 4, 2011 Office action.

suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 CFR 1.943(b) provides:

Responses by the patent owner and written comments by the third party requester shall not exceed 50 pages in length, excluding amendments, appendices of claims, and reference materials such as prior art references.

II. Patent Owner Petition Under 37 CFR 1.183

On July 5, 2011, patent owner filed the instant petition under 37 CFR 1.183, requesting waiver of the 50-page limit of 37 CFR 1.943(b) for its July 5, 2011 response submission. Petitioner asserts that "Patentee attempted to comply with all relevant rules when preparing this Response" but "despite Patentee's best efforts, the Response exceeded the page count limit of 37 C.F.R. § 1.943(b)."² Petitioner states that "[t]he Response itself contains 48 pages of argument (excluding the 'Amendment to the Claims' and 'Claim Status and Support for New and Amended Claims' sections" and that "the Response also includes three declarations" (two of which include exhibits), such that "[t]aking the full lengths of the arguments of the Response and its three declarations, the 50-page count limit is exceeded by at most 130 pages, while excluding the exhibit pages, the 50-page count limit is exceeded by 48 pages."³ Thus, petitioner requests waiver of 37 CFR 1.943(b) to "permit Patentee to file its 180 page Response, including exhibits."⁴

37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party. The burden is on petitioner to set forth with specificity the facts that give rise to an extraordinary situation in which justice requires suspension of a rule. A showing which petitioner can make in support of a request for waiver of the 50-page limit of 37 CFR 1.943(b) can be an attempt to draft a patent owner's response in compliance with the 50-page limit, and submission of a resulting response that is in excess of 50 pages concurrently with a petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b), requesting entry of the submitted response. Such a response can be evaluated for economizing, extraneous material, and arrangement, without repetition of information already of record. In this way, petitioner can rely on the proposed response: (1) for justification that more pages are needed to complete the response, and (2) to set forth an accurate determination of exactly how many additional pages petitioner deems to be needed for the response.

In support of waiver of the rule, petitioner asserts that the "Office Action states 8 bases for rejecting the 51 claims previously pending in the reexamination," "[t]he Office Action, on its face, is 59 pages long, which already exceeds Patentee's 50-page limit for response," and "the

² See Petition at page 2.

³ *Id.*

⁴ *Id.* at pages 2-3.

three Requests from the three merged proceedings included 202 pages, 2,254 pages, and 151 pages, respectively, of arguments (excluding prior art references).⁵ Hence, petitioner asserts that “it was impossible for Patentee to fully respond to each of the grounds in the detailed manner required by 37 C.F.R. § 1.111, within the 50 page limit imposed by 37 C.F.R. § 1.943.”⁶ Additionally, petitioner has made a showing in support of its request for waiver of the 50-page limit of 37 CFR 1.943(b) by attempting to draft a patent owner’s response in compliance with the 50-page limit, and submitting the resulting response that is in excess of 50 pages.

III. Findings and Analysis

37 CFR 1.943(b) expressly excludes from the regulatory page count “amendments, appendices of claims, and reference materials such as prior art references.” However, 37 CFR 1.943(b) does not expressly exclude from the regulatory page count an “explanation of the support in the disclosure of the patent for changes to the claims made by [an] amendment paper” pursuant to 37 CFR 1.530(e).

Further, a document is deemed to be subject to the 50-page length requirement when the document includes legal argument, *i.e.*, arguments of counsel such as, *e.g.*, arguments that the claims are patentable or unpatentable, or that are directed to how an outstanding or proposed rejection is overcome, or, in the case of a document filed by the requester, how an outstanding or proposed rejection is supported. Each determination of whether a document, such as an affidavit or declaration, contains a legal argument that will cause the document to be subject to the page count is made on a case-by-case basis. In determining whether a document such as an affidavit or declaration under 37 CFR 1.132, or any other document of a submission, includes legal argument, the Office analyzes whether the document is providing factual evidence, *i.e.*, evidence of **technological** facts, or whether the document contains argument that is merely an extension of the arguments of counsel. Factual evidence includes, for example, declarations that swear behind the filing date of a reference, that establish the date of a printed publication, that provide a technical explanation or technical definition of terms of art used by a reference, or that provide comparative test results and a scientific, or technological, analysis of the results (see, *e.g.*, MPEP 716.02). If a document is limited to factual evidence, the document is not included in the page count. In addition, affidavits or declarations **limited to** establishing commercial success, long-felt need and failure of others, skepticism of experts, or copying, as per MPEP 716.03-716.06, respectively, will not be included in the page count.

Patent owner’s July 5, 2011 response submission includes: (1) an 81-page response comprising a 1-page cover sheet, 19 pages of claim amendments, 13 pages of explanation of support for the claim amendments, and 48 pages of remarks, (2) a 37-page declaration of Carl Sechen (the Sechen declaration), (3) an 8-page declaration of Hyun Lee (the Lee declaration) with accompanying exhibits of reference materials, and (4) an 8-page declaration of Christopher Lopes (the Lopes declaration) with accompanying exhibits of reference materials. In this instance, the explanation of support for claim amendments, remarks, and the Sechen declaration are included in the regulatory page count such that patent owner’s July 5, 2011 response

⁵ See *id.*

⁶ *Id.*

submission is deemed to exceed the 50-page limit by up to 48 pages.⁷ Unlike the Sechen declaration, portions of which are deemed to include legal argument, the Lee declaration and the Lopes declaration are limited to providing factual evidence, hence they are *not* subject to the 50-page length requirement.

Based on the individual facts and circumstances of this case such as, for example, the nature of the April 4, 2011 Office action in adopting ten grounds of rejection of fifty claims, based on a synthesis of the three requests for *inter partes* reexamination.⁸ Additionally, it is recognized that the *inter partes* reexamination statute provides for proposed patent owner amendments and new claims and that, to comply with the rules, patent owner must provide an explanation of the support for any such proposed amendments and new claims. See 35 U.S.C. 314(a) and 37 CFR 1.530(e). Therefore, it is deemed equitable to waive the 50-page limit of 37 CFR 1.943(b) in this instance to the extent that the portions of patent owner's response submission that are included in the regulatory page count not exceed 98 pages.

Accordingly, patent owner's petition under 37 CFR 1.183 is **granted** and the page limit of 37 CFR 1.943(b) is waived to the extent of permitting patent owner's July 5, 2011 response submission to exceed the regulatory page limit by 48 pages. **This waiver makes patent owner's July 5, 2011 response submission page-length compliant.**

IV. Time Period for Submission of Third Party Requesters' Comments

The '0578, '0579 and '1339 *inter partes* requesters have **30 days from the mailing date of this decision**, granting patent owner's petition under 37 CFR 1.183 and making patent owner's July 5, 2011 response submission page-length compliant, **to file a comments paper pursuant to 37 CFR 1.947**. It is noted that any petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b) deemed necessary should accompany the comments submission. Further, to obtain a waiver of the 50-page length requirement of 37 CFR 1.943(b), any grantable petition under 37 CFR 1.183 must be accompanied by a requester comments submission that:

- 1) is one-and-a-half or double-spaced;⁹
- 2) is in a non-script type font (e.g., Arial, Times New Roman, or Courier);
- 3) has a font size no smaller than 12-point;
- 4) conforms to the margin requirements of 37 CFR 1.52(a)(1)(ii); and
- 5) has sufficient clarity and contrast to permit direct reproduction, and electronic capture by digital imaging and optical character recognition.

⁷ It is noted that the pages of the July 5, 2011 response submission that are being counted toward the 50-page limit appear to comply with the formatting guidelines for a grantable petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b) (i.e., one-and-a-half or double-spaced; in a non-script type font (e.g., Arial, Times New Roman, or Courier); has a font size no smaller than 12-point; conforms to the margin requirements of 37 CFR 1.52(a)(1)(ii); and has sufficient clarity and contrast to permit direct reproduction, and electronic capture by digital imaging and optical character recognition).

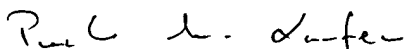
⁸ See April 4, 2011 Office action at pages 3-5.

⁹ Claim charts applying the art to the claims are permitted to be single-spaced so long as the charts have sufficient clarity and contrast to permit direct reproduction, and electronic capture by digital imaging and optical character recognition.

See, generally, 37 CFR 1.943(a) and 37 CFR 1.52. Adherence to such formatting guidelines enables the Office to more accurately and uniformly determine the number of pages of a requester comments submission that the Office must review, analyze, and address to the extent needed. Attached reference materials, such as prior art references, are not subject to these formatting guidelines, as such papers are expressly excluded from the regulatory page limit count under 37 CFR 1.943(b).

CONCLUSION

1. Patent owner's July 5, 2011 petition under 37 CFR 1.183 is granted and the page limit of 37 CFR 1.943(b) is waived to the extent of permitting patent owner's response submission to exceed the regulatory page limit by up to 48 pages. This waiver makes patent owner's July 5, 2011 response submission page-length compliant.
2. The '0578, '0579 and '1339 *inter partes* requesters have 30 days from the mailing date of this decision, granting patent owner's petition under 37 CFR 1.183 and making patent owner's July 5, 2011 response submission page-length compliant, to file a comments paper pursuant to 37 CFR 1.947.
3. Any questions concerning this communication should be directed to Nicole D. Haines, Legal Advisor, at (571) 272-7717.



Pinchus M. Laufer
Senior Legal Advisor
Office of Patent Legal Administration

07-29-2011



UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,339	06/08/2010	7619912	043326-000-0021	5035
20995	7590	11/18/2011	EXAMINER	
KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614			ART UNIT	PAPER NUMBER

DATE MAILED: 11/18/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
PILLSBURY WINTHROP SHAW PITTMAN LLP
P.O. BOX 10500
MCLEAN, VA 22102

Date:

MAILED

NOV 18 2011

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001339
PATENT NO. : 7619912
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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Knobbe Martens Olson & Bear LLP
2040 Main Street, Fourteenth Floor
Irvine, CA 92614

(For Patent Owner)

MAILED

NOV 18 2011

CENTRAL REEXAMINATION UNIT

Orrick, Herrington & Sutcliffe, LLP
IP Prosecution Department
2050 Main Street, Suite 1100
Irvine, CA 92614

(For '0578 *Inter Partes* Requester)

Fish & Richardson P.C.
PO Box 1022
Minneapolis, MN 55440-1022

(For '0579 *Inter Partes* Requester)

Pillsbury Winthrop Shaw Pittman LLP (SV)
P.O. Box 10500
McLean, VA 22102

(For '1339 *Inter Partes* Requester)

Inter Partes Reexamination Proceeding
Control No. 95/000,578
Filed: October 20, 2010
For: U.S. Patent No. 7,619,912

Inter Partes Reexamination Proceeding
Control No. 95/000,579
Filed: October 21, 2010
For: U.S. Patent No. 7,619,912

Inter Partes Reexamination Proceeding
Control No. 95/001,339
Filed: June 8, 2010
For: U.S. Patent No. 7,619,912

DECISION
GRANTING
PETITIONS

This is a decision on the following petitions under 37 CFR 1.183, filed on August 29, 2011 in the 95/000,578, 95/000,579, and 95/001,339 merged *inter partes* reexamination proceeding (the merged proceeding):

1. The petition paper entitled "THIRD PARTY REQUESTOR SMART MODULAR TECHNOLOGIES (WWH) INC.'S PETITION PURSUANT TO 37 C.F.R. § 1.183 TO SUSPEND OR WAIVE THE PAGE COUNT LIMIT OF 37 C.F.R. § 1.946(B)," filed by the third party requester of the 95/000,578 proceeding (the '578 requester);

2. The petition paper entitled "PETITION UNDER 37 C.F.R. § 1.183," filed by the third party requester of the 95/000,579 proceeding (the '579 requester); and
3. The petition paper entitled "PETITION FOR SUSPENSION OF RULES PURSUANT TO 37 C.F.R. §§ 1.182 and 1.183," filed by the third party requester of the 95/001,339 proceeding (the '1339 requester).

The petitions under 37 CFR 1.183 are before the Office of Patent Legal Administration for consideration.

On April 4, 2011, the Office mailed a non-final Office action in the merged proceeding, and on July 5, 2011, patent owner filed a response to the April 4, 2011 Office action, concurrently with a petition under 37 CFR 1.183 for waiver of the 37 CFR 1.943(b) page limit.¹ On July 29, 2011, the Office mailed a decision granting patent owner's July 5, 2011 petition under 37 CFR 1.183, and entering patent owner's July 5, 2011 response submission as page-length compliant. On August 29, 2011, the third party requesters in the merged proceeding filed their respective petitions under 37 CFR 1.183, requesting waiver of the 37 CFR 1.943(b) page limit, concurrently with their respective third party requester comments submissions after the April 4, 2011 non-final Office action and the July 5, 2011 patent owner response submission.

On October 4, 2011, the Office mailed a second non-final Office action in the merged proceeding. On October 14, 2011, the Office mailed another non-final Office action in the merged proceeding, superseding the October 4, 2011 Office action and addressing the patent owner's July 5, 2011 response submission and the three third party requester August 29, 2011 comments submissions.²

In view of the examiner's consideration, in the October 14, 2011 Office action, of the three third party requester August 29, 2011 comments submissions, the instant petitions under 37 CFR 1.183, requesting waiver of the 37 CFR 1.943(b) page limit with respect to the August 29, 2011 comments submissions, are granted *nunc pro tunc*. The granting of the petitions under 37 CFR 1.183 in this instance is not an indication that any future such petitions would be so granted without a sufficient showing under 37 CFR 1.183 for waiver of the regulatory page limit.

Any questions concerning this communication should be directed to Nicole D. Haines, Legal Advisor, at (571) 272-7717.



Pinchus M. Laufer
Senior Legal Advisor
Office of Patent Legal Administration

11-17-2011

¹ On April 20, 2011, the Office granted a one-month extension of time for filing patent owner's response to the April 4, 2011 Office action.

² See October 14, 2011 Office action at page 2 and FN 1.



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United States Patent and Trademark Office
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Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,339	06/08/2010	7619912	043326-000-0021	5035
25224	7590	01/24/2012	EXAMINER	
MORRISON & FOERSTER, LLP 555 WEST FIFTH STREET SUITE 3500 LOS ANGELES, CA 90013-1024			ART UNIT	PAPER NUMBER

DATE MAILED: 01/24/2012

Please find below and/or attached an Office communication concerning this application or proceeding.



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Alexandria, VA 22313-1450
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
PILLSBURY WINTHROP SHAW PITTMAN LLP
P.O. BOX 10500
MCLEAN, VA 22102

Date:

MAILED

JAN 24 2012

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001339
PATENT NO. : 7619912
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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MAILED

JAN 24 2012

MORRISON & FOERSTER, LLP
555 WEST FIFTH STREET
SUITE 3500
LOS ANGELES, CA 90013-1024

(For Patent Owner) CENTRAL REEXAMINATION UNIT

Orrick, Herrington & Sutcliffe, LLP
IP Prosecution Department
2050 Main Street, Suite 1100
Irvine, CA 92614

(For '0578 *Inter Partes* Requester)

Fish & Richardson P.C.
PO Box 1022
Minneapolis, MN 55440-1022

(For '0579 *Inter Partes* Requester)

Pillsbury Winthrop Shaw Pittman LLP (SV)
PO Box 10500
McLean, VA 22102

(For '1339 *Inter Partes* Requester)

Inter Partes Reexamination Proceeding
Control No. 95/000,578
Filed: October 20, 2010
For: U.S. Patent No. 7,619,912

DECISION ON PETITIONS

Inter Partes Reexamination Proceeding
Control No. 95/000,579
Filed: October 21, 2010
For: U.S. Patent No. 7,619,912

Inter Partes Reexamination Proceeding
Control No. 95/001,339
Filed: June 8, 2010
For: U.S. Patent No. 7,619,912

This is a decision on the Patent Owner petition filed on February 07, 2011, as well as the Third Party opposition petition filed March 02, 2011. Patent Owner requests under 37 C.F.R. 1.181 to

vacate *ultra vires* the assignment of a filing date and the grant of request for re-examination. Third Party Requester's opposition opposes the request for relief and requests entry of a new IDS for fixing a typographical error.

The petitions are considered pursuant to 37 CFR 1.181; No fee is required.

Patent Owner's petition is denied and Third Party Requester's petition is moot.

REVIEW OF RELEVANT FACTS

1. Reexamination Request 95/000,578 was granted a filing date of October 20, 2010.
2. Reexamination of U.S. Patent No. 7,619,912 was ordered in the Order mailed January 18, 2011.
3. The Order determined that a substantial new question (SNQ) of patentability existed for multiple references cited by the Requester, including U.S. Pat 6,414,868 to Wong (Wong '868). However, the IDS which was signed by the examiner did not include Wong '868.
4. On February 7, 2011, the current Patent Owner's petition was filed.
5. On March 02, 2011, the current Third Party Requester's opposition petition was filed, which included an updated IDS listing the Wong '868 Patent.
6. On January 12, 2012, the examiner considered and initialed the Information Disclosure Statement (IDS) submitted by Third Party Requester.

DECISION

37 CFR §1.919 states

Filing date of request for inter partes reexamination.

(a)

The filing date of a request for inter partes reexamination is the date on which the request satisfies the fee requirement of § 1.915(a).

37 C.F.R. §1.915 states

Content of request for inter partes reexamination.

(b)

A request for inter partes reexamination must include the following parts:

(2)

A citation of the patents and printed publications which are presented to provide a substantial new question of patentability.

In view of the relevant facts above, the Request was properly accorded a filing date as it satisfies the requirements of 37 C.F.R. 1.915. The Request filed October 20, 2010 correctly identifies Wong '868 on Page 29. The incorrect citations to Wong in the Table of Exhibits at page xvii and in form PTO/SB/08A were mere typographical errors. Further evidence is provided in the Order mailed January 18, 2011, in which the examiner correctly cited Wong '868 on Page 2.

With regard to the Third Party Requester's opposition petition, the corrected IDS has been considered and initialed by the examiner as of January 12, 2012.

Accordingly, Patent Owner's petition to vacate *ultra vires* the assignment of a filing date and the grant of request for re-examination is denied as the filing date assignment and grant of the Request were proper. Third Party Requester's opposition petition is therefore moot in view of Patent Owner's petition being denied and in view of examiner's consideration of the corrected IDS.

CONCLUSION

1. Patent Owner's petition is **DENIED**. Third Party Requester's petition is **MOOT**.
2. **All** correspondence relating to this *inter partes* reexamination proceeding should be directed:

By EFS: Registered users may submit via the electronic filing system EFS-Web, at <https://efs.uspto.gov/efile/myportal/efs-registered>

By Mail to: Mail Stop *Inter Partes* Reexam
Central Reexamination Unit
Commissioner for Patents
United States Patent & Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

By FAX to: (571) 273-9900
Central Reexamination Unit

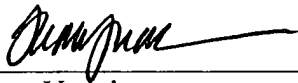
By hand: Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

For EFS-Web transmissions, 37 CFR 1.8(a)(1)(i) (C) and (ii) states that correspondence (except for a request for reexamination and a corrected or replacement request for

reexamination) will be considered timely filed if (a) it is transmitted via the Office's electronic filing system in accordance with 37 CFR 1.6(a)(4), and (b) includes a certificate of transmission for each piece of correspondence stating the date of transmission, which is prior to the expiration of the set period of time in the Office action.

3. Telephone inquiries related to this decision should be directed to Alexander Kosowski, at (571) 272-3744, Mark Reinhart, at (571) 272-1611 or Sudhanshu Pathak at (571) 272-5509.

This decision is final and nonappealable. See 37 CFR 1.927. No further communication on this matter will be acknowledged or considered.



Irem Yucel
Director, Central Reexamination Unit



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,344	04/20/2010	6486780	2917.002REX0	6327

7590 10/27/2010

PETER L. OLSON
OFFICE OF INTELLECTUAL PROPERTY COUNSEL
3M INNOVATIVE PROPERTIES COMPANY
P.O. BOX 33427
ST. PAUL, MN 55133-3427

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 10/27/2010

Please find below and/or attached an Office communication concerning this application or proceeding.



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.
1100 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

Date: **MAILED**

OCT 27 2010

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001344
PATENT NO. : 6486780
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

**Decision on Petition for Extension
of Time in Reexamination**

Control No.: 95/001,344

1. THIS IS A DECISION ON THE PETITION FILED 26 October 2010.
2. THIS DECISION IS ISSUED PURSUANT TO:
 - A. ☐ 37 CFR 1.550(c) – The time for taking any action by a patent owner in an *ex parte* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.
 - B. ☒ 37 CFR 1.956 – The time for taking any action by a patent owner in an *inter partes* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.-
The petition is before the Central Reexamination Unit for consideration.
3. FORMAL MATTERS
Patent owner requests that the period for responding to the Office action mailed on _____, which sets a _____ period for filing a response thereto, be extended by _____.
 - A. ☒ Petition fee per 37 CFR §1.17(g):
 - i. ☐ Petition includes authorization to debit a deposit account.
 - ii. ☐ Petition includes authorization to charge a credit card account.
 - iii. ☐ Other: _____.
 - B. ☒ Proper certificate of service was provided. (Not required in reexamination where patent owner is requester.)
 - C. ☒ Petition was timely filed.
 - D. ☒ Petition properly signed.
4. DECISION (See MPEP 2265 and 2665)
 - A. ☐ Granted or ☐ Granted-in-part for _____, because petitioner provided a factual accounting that established sufficient cause. (See 37 CFR 1.550(c) and 37 CFR 1.956).
☐ Other/comment: _____.
 - B. ☒ Dismissed because:
 - i. ☐ Formal matters (See unchecked box(es) (A, B, C and/or D) in section 4 above).
 - ii. ☐ Petitioner failed to provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period.
 - iii. ☒ Petitioner failed to explain why, in spite of the action taken thus far, the requested additional time is needed.
 - iv. ☒ The statements provided fail to establish sufficient cause to warrant extension of the time for taking action (See other).
 - v. ☐ The petition is moot.
 - vi. ☒ Other/comment: It is unclear specifically why the additional time is required. The mention of declarations/affidavits etc are so inspecific as to render the petition unclear as to why additional time is needed.
5. CONCLUSION

Telephone inquiries with regard to this decision should be directed to Mark Reinhart at 571-272-1611. In his/her absence, calls may be directed to Eric Keasel at 571-272-4929 in the Central Reexamination Unit.

/Mark Reinhart/
[Signature]

SPE Art Unit 3992
(Title)



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,346	04/20/2010	6857568	2917.003REX0	6397
32692	7590	02/03/2011	EXAMINER	
3M INNOVATIVE PROPERTIES COMPANY PO BOX 33427 ST. PAUL, MN 55133-3427			ART UNIT	PAPER NUMBER

DATE MAILED: 02/03/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Robert E. Sokohl

STERNE KESSLER GOLDSTEIN & FOX, P.L.L.C.

1100 New York Ave, N.W.

Washington, DC 20005

Date: 2-3-11

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001346

PATENT NO. : 6857568

TECHNOLOGY CENTER : 3999

ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

Decision on Petition for Extension of Time in Reexamination	Control No.: 95/001,346
--	-------------------------

1. THIS IS A DECISION ON THE PETITION FILED 26 January 2011.

2. THIS DECISION IS ISSUED PURSUANT TO:
 - A. ☐ 37 CFR 1.550(c) – The time for taking any action by a patent owner in an *ex parte* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.
 - B. ☒ 37 CFR 1.956 – The time for taking any action by a patent owner in an *inter partes* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.
The petition is before the Central Reexamination Unit for consideration.

3. FORMAL MATTERS

Patent owner requests that the period for responding to the Office action mailed on 15 January 2011 which sets a thirty (30) day period for filing a response thereto, be extended by one (1) month

 - A. ☒ Petition fee per 37 CFR §1.17(g):
 - i. ☐ Petition includes authorization to debit a deposit account.
 - ii. ☐ Petition includes authorization to charge a credit card account.
 - iii. ☐ Other: _____.
 - B. ☒ Proper certificate of service was provided. (Not required in reexamination where patent owner is requester.)
 - C. ☒ Petition was timely filed.
 - D. ☒ Petition properly signed.

4. DECISION (See MPEP 2265 and 2665)
 - A. ☒ Granted or ☐ Granted-in-part for one (1) month because petitioner provided a factual accounting that established sufficient cause. (See 37 CFR 1.550(c) and 37 CFR 1.956).
☐ Other/comment: _____.
 - B. ☐ Dismissed because:
 - i. ☐ Formal matters (See unchecked box(es) (A, B, C and/or D) in section 4 above).
 - ii. ☐ Petitioner failed to provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period.
 - iii. ☐ Petitioner failed to explain why, in spite of the action taken thus far, the requested additional time is needed.
 - iv. ☐ The statements provided fail to establish sufficient cause to warrant extension of the time for taking action (See attached).
 - v. ☐ The petition is moot.
 - vi. ☐ Other/comment: _____.

5. CONCLUSION

Telephone inquiries with regard to this decision should be directed to Mark Reinhart at 571-272-1611 .In his/her absence, calls may be directed to Eric Keasel at 571-272-4929 in the Central Reexamination Unit.

/Mark Reinhart/
 [Signature]

SPE, AU 3992 Central Reexamination Unit
 (Title)



UNITED STATES PATENT AND TRADEMARK OFFICE

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P.O. Box 1450
Alexandria, VA 22313-1450
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Sughrue Mion PLLC
Suite 800
2100 Pennsylvania Avenue, N. W.
Washington, DC 20037-3213

(For Patent Owner)

MAILED

DEC 17 2010

Reising Ethington P.C.
755 W. Big Beaver Road
Suite 1850
Troy, MI 48099-4390

CENTRAL REEXAMINATION UNIT
(For 95/001,214 Requester)

Novak Druce + Quigg, LLP
1000 Louisiana Avenue
53rd Floor
Houston, TX 77002

(For 95/001,350 Requester)

Pauley Petersen & Erickson
2800 West Higgins Road
Suite 365
Hoffman Estates, IL 60169

(For 95/001,353 Requester)

In re Ronald Kefferstein et al.
Inter Partes Reexamination Proceeding
Control No.: 95/001,214
Filed: August 20, 2009
For: U.S. Patent No. 6,564,604

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:
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:
: **DECISION, *SUA SPONTE*,**
: **TO MERGE**
: **REEXAMINATION**
: **PROCEEDINGS**

In re Ronald Kefferstein et al.
Inter Partes Reexamination Proceeding
Control No.: 95/001,350
Filed: April 30, 2010
For: U.S. Patent No. 6,564,604

In re Ronald Kefferstein et al.
Inter Partes Reexamination Proceeding
Control No.: 95/001,353
Filed: May 12, 2010
For: US. Patent No. 6,564,604

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The above-captioned reexamination proceedings are before the Office of Patent Legal Administration for *sua sponte* consideration of whether the proceedings should be merged under 37 CFR 1.989.

BACKGROUND

1. U.S. Patent No. 6,564,604 ("the '604 patent") issued to Ronald Kefferstein et al. on May 20, 2003, with 7 claims.
2. A request for *inter partes* reexamination of claims 1-7 of the '604 patent was filed on August 20, 2009, by a third party requester, and was assigned control number 95/001,214 ("the '1214 *inter partes* proceeding"). The real party in interest is Severstal North America, Inc.
3. On September 25, 2009, *inter partes* reexamination was ordered for claims 1-7 of the '604 patent based on the examiner's determination that the August 20, 2009 request raised a substantial new question of patentability affecting these claims. The order was accompanied by a non-final rejection action.
4. On November 25, 2009, patent owner submitted a response to the September 25, 2009 non-final rejection action. The November 25, 2009 patent owner response included the addition of new claims 8-16.
5. The '1214 requester filed comments on December 28, 2009, on patent owner's November 25, 2009 response.
6. A second request for *inter partes* reexamination of claims 1-7 of the '604 patent was filed on April 30, 2010, by a third party requester, and was assigned control number 95/001,350 ("the '1350 *inter partes* proceeding"). The real party in interest is Corus Staal BV.
7. On May 20, 2010, *inter partes* reexamination was ordered for claims 1-7 of the '604 patent, and for new claims 8-16 contained in the '1214 reexamination proceeding, based on the examiner's determination that the April 30, 2010 request raised a substantial new question of patentability affecting these claims. No Office action has been issued in the '1350 proceeding.
8. A third request for *inter partes* reexamination of claims 1-7 of the '604 patent was filed on May 12, 2010, by a third party requester, and was assigned control number 95/001,353 ("the '1353 *inter partes* proceeding"). The real party in interest is Voestalpine Stahl GmbH.
9. On June 2, 2010, *inter partes* reexamination was ordered for claims 1-7 of the '604 patent, and for new claims 8-16 contained in the '1214 reexamination proceeding, based on the examiner's determination that the May 12, 2010 request raised a substantial new question of patentability affecting these claims. No Office action has been issued in the '1353 proceeding.

DECISION

I. MERGER OF PROCEEDINGS

Reexamination has been ordered in three proceedings for the same claims of the same patent. All three proceedings are *inter partes* proceedings. All three proceedings are still pending, and have not been terminated. Therefore, consideration of merger pursuant to 37 CFR 1.989 is ripe at this point in time.

37 CFR 1.989 provides:

(a) If any reexamination is ordered while a prior *inter partes* reexamination proceeding is pending for the same patent and prosecution in the prior *inter partes* reexamination proceeding has not been terminated, a decision may be made to merge the two proceedings or to suspend one of the two proceedings. Where merger is ordered, the merged examination will normally result in the issuance and publication of a single reexamination certificate under § 1.997.

In accordance with 37 CFR 1.989(a), the 95/001,214, 95/001,350 and 95/001,353 proceedings are merged. The merged proceeding will be conducted in accordance with the guidelines and requirements that follow.

II. THE SAME CLAIMS MUST BE MAINTAINED IN ALL THREE PROCEEDINGS

Patent owner is required to maintain the same claims (and specification) in all three files throughout the merged proceeding. Presently, the '1214 proceeding includes additional claims 8-16. Thus, the claims are not currently the same in all three files. An Office action requiring an amendment placing the claims in identical form is being issued concurrently with this decision. Patent owner must respond to the Office action in accordance with the procedures in 37 CFR 1.111. The third party requesters will then have an opportunity to comment on patent owner's response in accordance with the procedures in 37 CFR 1.947.

III. CONDUCT OF MERGED PROCEEDING

A. Governing regulations for the merged proceeding:

The present decision merges three *inter partes* reexamination proceedings. The merged proceeding is governed by 37 CFR 1.902 through 1.997. Pursuant to 37 CFR 1.989(a), the merged examination will normally result in the issuance and publication of a single reexamination certificate under 37 CFR 1.997.

It is noted that reexamination was ordered for claims 1-7 of the '604 patent in the '1214 proceeding, for claims 1-7 of the '604 patent and newly added claims 8-16 in the '1350 proceeding, and for claims 1-7 of the '604 patent and newly added claims 8-16 in the '1353 proceeding. The examiner will conduct reexamination in the merged proceeding for claims 1-7 of the '604 patent and for the newly added claims 8-16.

B. Papers mailed/filed:

All papers mailed by the Office throughout the merged proceeding will take the form of a single action which applies to all three proceedings. All papers issued by the Office, or filed by the patent owner and the third party requester(s), will contain the identifying data for all three proceedings and will be entered in each reexamination file. All papers filed by the patent owner and the third party requester(s) must consist of a single paper, **filed in duplicate**, each bearing a signature and identifying data for all three proceedings, for entry into each file.

All papers filed by the patent owner and the third party requester(s) should be directed:

by Mail to: Attn: Mail Stop "*Inter Partes* Reexam"
Central Reexamination Unit
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

by FAX to: (571) 273-9900
Central Reexamination Unit

by Hand to: Customer Service Window
Attn: Central Reexamination Unit
Randolph Building, Lobby Level
401 Dulany Street
Alexandria, VA 22314

by EFS: Registered users may submit papers via the
electronic filing system EFS-Web, at:

<https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html>

Patent owner and requester(s) are reminded that every paper filed in the merged proceeding subsequent to this decision must be served on the other parties, and every paper filed must reflect that such paper was served on the other parties, pursuant to 37 CFR 1.903. All papers are to be addressed to the Central Reexamination Unit as provided above.

C. Amendments:

The filing of any amendments to the specification, claims, or drawings must comply with 37 CFR 1.943, which incorporates the provisions of 37 CFR 1.530 and the guidelines of MPEP § 2666.01, which in turn references the guidelines of MPEP § 2250.

37 CFR 1.121 does not apply to amendments in reexamination. Accordingly, clean copies of the amended claims are not required and are not to be submitted; rather amendments are to be presented via markings pursuant to 37 CFR 1.530(f), except that a claim should be canceled by a statement canceling the claim, without presentation of the text of the claim.

Pursuant to 37 CFR 1.530(i), all amendments must be made relative to the patent specification,

including the claims, and drawings, which are in effect as of the date of filing the request for reexamination. *Amendments are not to be made relative to previous amendments.* Thus, for all amendments, all words not appearing in the patent are always underlined, and only words being deleted from the patent appear in brackets.

D. Fees:

Where a paper is filed which requires payment of a fee (e.g., extension of time fee, excess claims fee, petition fee, appeal fee, brief fee, oral hearing fee), only a single fee need be paid. For example, only one fee need be paid for patent owner's appellant brief (or that of one of the *inter partes* reexamination requesters) which may be filed, even though the brief relates to merged multiple proceedings, and copies must be filed (as pointed out above) for each file in the merged proceeding.

E. Citation of Patents and Printed Publications:

Upon return of the present merged proceeding to the examiner, the examiner will review the files to ensure that each file contains identical citations of prior patents and printed publications, and will cite such documents as are necessary as part of the next action in order to place the files in that condition.

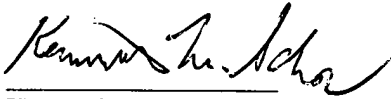
F. Appeal Procedure Reminders for *Inter Partes* Reexamination

The parties are reminded of the procedures for taking appeal in an *inter partes* reexamination as explained in MPEP 2674 and 2675. The appeal must only be taken from (1) the rejection(s) of the claims in the Right of Appeal Notice (RAN) that the *patent owner* proposes to contest, or (2) the finding(s) of patentability of claims in the RAN that the *third party requester* proposes to contest. Therefore, in the notice of appeal, the patent owner must identify each claim rejected by examiner that the patent owner intends to contest and the third party requester must identify each rejection *that was previously proposed by that third party requester* that the third party requester intends to contest. (37 CFR 41.61) The appellant's brief shall present a concise statement of each issue. Further, no new ground of rejection can be proposed by a third party requester appellant, unless such ground was withdrawn by the examiner during the prosecution of the proceeding, and the third party requester has not yet had an opportunity to propose it as a third party requester proposed ground of rejection. (37 CFR 41.67(c)(1)(vi))

CONCLUSION

1. *Inter partes* Reexamination Control No. 95/001,214, *inter partes* Reexamination No. 95/001,350 and *inter partes* Reexamination Control No. 95/001,353 are merged into a single proceeding, to be conducted in accordance with the procedure set forth above.
2. Jurisdiction over the merged reexamination is being forwarded via the Central Reexamination Unit Director to the examiner for the preparation of an Office action, to be issued in due course for the merged proceeding.
3. Any questions concerning this communication should be directed to Raul Tamayo in the

3. Any questions concerning this communication should be directed to Raul Tamayo in the Office of Patent Legal Administration, at (571) 272-7728.



Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

September 7, 2010



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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The Webb Law Firm
700 Koppers Building
436 Seventh Avenue
Pittsburgh, PA 15219

(For Patent Owner)

MAILED

FEB 25 2011

Harness, Dickey, & Pierce
P.O. Box 828
Bloomfield Hills, MI 48303

(For Requester)

CENTRAL REEXAMINATION UNIT

In re Ramun
Inter Partes Reexamination Proceeding
Control No. 95/001,352
Filed: May 5, 2010
For: U.S. Patent No. 7,121,489 B2

:
: **DECISION**
: **DISMISSING PETITION**
: **UNDER § 1.182**
:

This is a decision on the October 25, 2010 patent owner petition entitled "PETITION UNDER § 1.182."

The patent owner petition is before the Office of Patent Legal Administration.

The petition is **dismissed** as moot.

BACKGROUND

- On May 5, 2010, a request for *inter partes* reexamination was filed by a third party requester, and the resulting reexamination proceeding was assigned control number 95/001,352 ("the '1352 proceeding"). Reexamination was ordered on June 4, 2010.
- Prosecution progressed until, on September 24, 2010, an Action Closing Prosecution was issued.
- On October 25, 2010, patent owner filed a response to the Action Closing Prosecution, and the instant petition entitled "PETITION UNDER § 1.182," requesting entry of the amendment and remarks filed therewith.
- On November 17, 2010, third party requester filed comments after the October 25, 2010 patent owner response.

- On February 24, 2011, the Office issued an Action Closing Prosecution, entering the amendment of September 24, 2010.

APPLICABLE REGULATION

37 C.F.R. § 1.182 provides:

All **situations not specifically provided** for in the regulations of this part will be decided in accordance with the merits of each situation by or under the authority of the Director, subject to such other requirements as may be imposed, and such decision will be communicated to the interested parties in writing. Any petition seeking a decision under this section must be accompanied by the petition fee set forth in § 1.17(f). (emphasis added)

DECISION

Patent owner filed the instant petition to seek entry of the amendment filed on October 25, 2010. However, that amendment was entered by the examiner in an Action Closing Prosecution, issued by the Office on February 24, 2010. Thus, patent owner has received the relief requested in the instant petition, and therefore the instant petition is therefore moot.

In view of the above and the facts and circumstances presented by the present record, the petition is dismissed.

CONCLUSION

- The petition is dismissed as moot.
- A copy of this decision will be made of record in the reexamination file.
- Any inquiry concerning this decision should be directed to the undersigned at (571) 272-7700.

/Michael Cygan/

Michael Cygan
Legal Advisor
Office of Patent Legal Administration

February 24, 2010



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Sughrue Mion PLLC
Suite 800
2100 Pennsylvania Avenue, N. W.
Washington, DC 20037-3213

(For Patent Owner)

MAILED

DEC 17 2010

Reising Ethington P.C.
755 W. Big Beaver Road
Suite 1850
Troy, MI 48099-4390

CENTRAL REEXAMINATION UNIT
(For 95/001,214 Requester)

Novak Druce + Quigg, LLP
1000 Louisiana Avenue
53rd Floor
Houston, TX 77002

(For 95/001,350 Requester)

Pauley Petersen & Erickson
2800 West Higgins Road
Suite 365
Hoffman Estates, IL 60169

(For 95/001,353 Requester)

In re Ronald Kefferstein et al.
Inter Partes Reexamination Proceeding
Control No.: 95/001,214
Filed: August 20, 2009
For: U.S. Patent No. 6,564,604

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: **DECISION, *SUA SPONTE*,**
: **TO MERGE**
: **REEXAMINATION**
: **PROCEEDINGS**

In re Ronald Kefferstein et al.
Inter Partes Reexamination Proceeding
Control No.: 95/001,350
Filed: April 30, 2010
For: U.S. Patent No. 6,564,604

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In re Ronald Kefferstein et al.
Inter Partes Reexamination Proceeding
Control No.: 95/001,353
Filed: May 12, 2010
For: US. Patent No. 6,564,604

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:

The above-captioned reexamination proceedings are before the Office of Patent Legal Administration for *sua sponte* consideration of whether the proceedings should be merged under 37 CFR 1.989.

BACKGROUND

1. U.S. Patent No. 6,564,604 (“the ‘604 patent”) issued to Ronald Kefferstein et al. on May 20, 2003, with 7 claims.
2. A request for *inter partes* reexamination of claims 1-7 of the ‘604 patent was filed on August 20, 2009, by a third party requester, and was assigned control number 95/001,214 (“the ‘1214 *inter partes* proceeding”). The real party in interest is Severstal North America, Inc.
3. On September 25, 2009, *inter partes* reexamination was ordered for claims 1-7 of the ‘604 patent based on the examiner’s determination that the August 20, 2009 request raised a substantial new question of patentability affecting these claims. The order was accompanied by a non-final rejection action.
4. On November 25, 2009, patent owner submitted a response to the September 25, 2009 non-final rejection action. The November 25, 2009 patent owner response included the addition of new claims 8-16.
5. The ‘1214 requester filed comments on December 28, 2009, on patent owner’s November 25, 2009 response.
6. A second request for *inter partes* reexamination of claims 1-7 of the ‘604 patent was filed on April 30, 2010, by a third party requester, and was assigned control number 95/001,350 (“the ‘1350 *inter partes* proceeding”). The real party in interest is Corus Staal BV.
7. On May 20, 2010, *inter partes* reexamination was ordered for claims 1-7 of the ‘604 patent, and for new claims 8-16 contained in the ‘1214 reexamination proceeding, based on the examiner’s determination that the April 30, 2010 request raised a substantial new question of patentability affecting these claims. No Office action has been issued in the ‘1350 proceeding.
8. A third request for *inter partes* reexamination of claims 1-7 of the ‘604 patent was filed on May 12, 2010, by a third party requester, and was assigned control number 95/001,353 (“the ‘1353 *inter partes* proceeding”). The real party in interest is Voestalpine Stahl GmbH.
9. On June 2, 2010, *inter partes* reexamination was ordered for claims 1-7 of the ‘604 patent, and for new claims 8-16 contained in the ‘1214 reexamination proceeding, based on the examiner’s determination that the May 12, 2010 request raised a substantial new question of patentability affecting these claims. No Office action has been issued in the ‘1353 proceeding.

DECISION

I. MERGER OF PROCEEDINGS

Reexamination has been ordered in three proceedings for the same claims of the same patent. All three proceedings are *inter partes* proceedings. All three proceedings are still pending, and have not been terminated. Therefore, consideration of merger pursuant to 37 CFR 1.989 is ripe at this point in time.

37 CFR 1.989 provides:

(a) If any reexamination is ordered while a prior *inter partes* reexamination proceeding is pending for the same patent and prosecution in the prior *inter partes* reexamination proceeding has not been terminated, a decision may be made to merge the two proceedings or to suspend one of the two proceedings. Where merger is ordered, the merged examination will normally result in the issuance and publication of a single reexamination certificate under § 1.997.

In accordance with 37 CFR 1.989(a), the 95/001,214, 95/001,350 and 95/001,353 proceedings are merged. The merged proceeding will be conducted in accordance with the guidelines and requirements that follow.

II. THE SAME CLAIMS MUST BE MAINTAINED IN ALL THREE PROCEEDINGS

Patent owner is required to maintain the same claims (and specification) in all three files throughout the merged proceeding. Presently, the '1214 proceeding includes additional claims 8-16. Thus, the claims are not currently the same in all three files. An Office action requiring an amendment placing the claims in identical form is being issued concurrently with this decision. Patent owner must respond to the Office action in accordance with the procedures in 37 CFR 1.111. The third party requesters will then have an opportunity to comment on patent owner's response in accordance with the procedures in 37 CFR 1.947.

III. CONDUCT OF MERGED PROCEEDING

A. Governing regulations for the merged proceeding:

The present decision merges three *inter partes* reexamination proceedings. The merged proceeding is governed by 37 CFR 1.902 through 1.997. Pursuant to 37 CFR 1.989(a), the merged examination will normally result in the issuance and publication of a single reexamination certificate under 37 CFR 1.997.

It is noted that reexamination was ordered for claims 1-7 of the '604 patent in the '1214 proceeding, for claims 1-7 of the '604 patent and newly added claims 8-16 in the '1350 proceeding, and for claims 1-7 of the '604 patent and newly added claims 8-16 in the '1353 proceeding. The examiner will conduct reexamination in the merged proceeding for claims 1-7 of the '604 patent and for the newly added claims 8-16.

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All papers filed by the patent owner and the third party requester(s) should be directed:

by Mail to: Attn: Mail Stop "*Inter Partes* Reexam"
Central Reexamination Unit
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

by FAX to: (571) 273-9900
Central Reexamination Unit

by Hand to: Customer Service Window
Attn: Central Reexamination Unit
Randolph Building, Lobby Level
401 Dulany Street
Alexandria, VA 22314

by EFS: Registered users may submit papers via the
electronic filing system EFS-Web, at:

<https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html>

Patent owner and requester(s) are reminded that every paper filed in the merged proceeding subsequent to this decision must be served on the other parties, and every paper filed must reflect that such paper was served on the other parties, pursuant to 37 CFR 1.903. All papers are to be addressed to the Central Reexamination Unit as provided above.

C. Amendments:

The filing of any amendments to the specification, claims, or drawings must comply with 37 CFR 1.943, which incorporates the provisions of 37 CFR 1.530 and the guidelines of MPEP § 2666.01, which in turn references the guidelines of MPEP § 2250.

37 CFR 1.121 does not apply to amendments in reexamination. Accordingly, clean copies of the amended claims are not required and are not to be submitted; rather amendments are to be presented via markings pursuant to 37 CFR 1.530(f), except that a claim should be canceled by a statement canceling the claim, without presentation of the text of the claim.

Pursuant to 37 CFR 1.530(i), all amendments must be made relative to the patent specification,

including the claims, and drawings, which are in effect as of the date of filing the request for reexamination. *Amendments are not to be made relative to previous amendments.* Thus, for all amendments, all words not appearing in the patent are always underlined, and only words being deleted from the patent appear in brackets.

D. Fees:

Where a paper is filed which requires payment of a fee (e.g., extension of time fee, excess claims fee, petition fee, appeal fee, brief fee, oral hearing fee), only a single fee need be paid. For example, only one fee need be paid for patent owner's appellant brief (or that of one of the *inter partes* reexamination requesters) which may be filed, even though the brief relates to merged multiple proceedings, and copies must be filed (as pointed out above) for each file in the merged proceeding.

E. Citation of Patents and Printed Publications:

Upon return of the present merged proceeding to the examiner, the examiner will review the files to ensure that each file contains identical citations of prior patents and printed publications, and will cite such documents as are necessary as part of the next action in order to place the files in that condition.

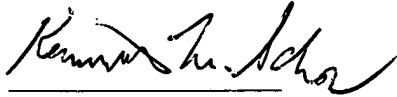
F. Appeal Procedure Reminders for *Inter Partes* Reexamination

The parties are reminded of the procedures for taking appeal in an *inter partes* reexamination as explained in MPEP 2674 and 2675. The appeal must only be taken from (1) the rejection(s) of the claims in the Right of Appeal Notice (RAN) that the *patent owner* proposes to contest, or (2) the finding(s) of patentability of claims in the RAN that the *third party requester* proposes to contest. Therefore, in the notice of appeal, the patent owner must identify each claim rejected by examiner that the patent owner intends to contest and the third party requester must identify each rejection *that was previously proposed by that third party requester* that the third party requester intends to contest. (37 CFR 41.61) The appellant's brief shall present a concise statement of each issue. Further, no new ground of rejection can be proposed by a third party requester appellant, unless such ground was withdrawn by the examiner during the prosecution of the proceeding, and the third party requester has not yet had an opportunity to propose it as a third party requester proposed ground of rejection. (37 CFR 41.67(c)(1)(vi))

CONCLUSION

1. *Inter partes* Reexamination Control No. 95/001,214, *inter partes* Reexamination No. 95/001,350 and *inter partes* Reexamination Control No. 95/001,353 are merged into a single proceeding, to be conducted in accordance with the procedure set forth above.
2. Jurisdiction over the merged reexamination is being forwarded via the Central Reexamination Unit Director to the examiner for the preparation of an Office action, to be issued in due course for the merged proceeding.
3. Any questions concerning this communication should be directed to Raul Tamayo in the

3. Any questions concerning this communication should be directed to Raul Tamayo in the Office of Patent Legal Administration, at (571) 272-7728.



Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

September 7, 2010



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,363	06/30/2010	6,781,231	092771-0035	7421
38939 7590 12/14/2010 DYKEMA GOSSETT PLLC 10 S. WACKER DR., STE. 2300 CHICAGO, IL 60606				
			EXAMINER THERIAULT, STEVEN B	
			ART UNIT 3992	PAPER NUMBER
			MAIL DATE 12/14/2010	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patents and Trademark Office
P.O. Box 14
Alexandria, VA 22313-1404
www.uspto.gov

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Date:

BUCHANAN, INGERSOLL & ROONEY PC

POST OFFICE BOX 1404

ALEXANDRIA, VA 22313-1404

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001363

PATENT NO. : 6781231

TECHNOLOGY CENTER : 3999

ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



UNITED STATES PATENT AND TRADEMARK OFFICE

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Alexandria, VA 22313-1450
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**DYKEMA GOSSETT PLLC
10 S. WACKER DRIVE
SUITE 2300
CHICAGO, IL 60606**

<i>In re</i> Application of	:	
MINERVINI, Anthony	:	
Control No. 90/001,363	:	
Filed: May 27, 2010	:	DECISION ON PETITION
Attorney Docket No. 0076943-000002	:	TO WITHDRAW
	:	FROM RECORD
	:	

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed November 22, 2010.

The request is **moot** because a revocation of power of attorney has been filed.

A review of the file record indicates that the power of attorney to Buchanan Ingersoll & Rooney PC has been revoked by the third party requestor of the reexamination application on December 3, 2010. Accordingly, the request to withdraw under 37 C.F.R. § 1.36(b) is moot.

All future communications from the Office will be directed to the below-listed address until otherwise notified by applicant.

Telephone inquiries concerning this decision should be directed to Denise L. Boyd at 571-272-0992.

cc: Jason Y. & Associates, LLC
12178 Bridgend Run
Fairfax, VA 22030

cc: Buchanan Ingersoll & Rooney PC
P. O. Box 1404
Alexandria, VA 22313-1404



UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
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P.O. Box 1450
Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,509	10/07/2009	6781231	092771-0021C	5895
38939	7590	12/28/2010	EXAMINER	
DYKEMA GOSSETT PLLC 10 S. WACKER DR., STE. 2300 CHICAGO, IL 60606			ART UNIT	PAPER NUMBER

DATE MAILED: 12/28/2010

Please find below and/or attached an Office communication concerning this application or proceeding.



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,251	11/24/2009	6,781,231	092771-0021D	6960
38939	7590	12/28/2010	EXAMINER	
DYKEMA GOSSETT PLLC 10 S. WACKER DR., STE. 2300 CHICAGO, IL 60606			ART UNIT	PAPER NUMBER

DATE MAILED: 12/28/2010

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UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
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Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,363	06/30/2010	6,781,231	092771-0035	7421
38939	7590	12/28/2010	EXAMINER	
DYKEMA GOSSETT PLLC 10 S. WACKER DR., STE. 2300 CHICAGO, IL 60606			ART UNIT	PAPER NUMBER

DATE MAILED: 12/28/2010

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UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Dykema Gossett PLLC
10 S. Wacker Dr.
Suite 2300
Chicago, IL 60606

(For Patent Owner)

Sunstein Kann Murphy & Timbers LLP
125 Summer Street
Boston, MA 02110-1618

(For 95/000,509 Requester)

Wolf Greenfield & Sacks, P.C.
600 Atlantic Avenue
Boston, MA 02210-2206

(For 95/001,251 Requester)

Buchanan, Ingersoll & Rooney PC
Post Office Box 1404
Alexandria, VA 22313-1404

(For 95/001,363 Requester)

MAILED

DEC 28 2010

In re Anthony D. Minervini
Inter Partes Reexamination Proceeding
Control No.: 95/000,509
Filed: October 7, 2009
For: U.S. Patent No. 6,781,231

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: **CENTRAL REEXAMINATION UNIT**
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:
:
: **DECISION, *SUA SPONTE*,**
: **TO MERGE**
: **REEXAMINATION**
: **PROCEEDINGS**

In re Anthony D. Minervini
Inter Partes Reexamination Proceeding
Control No.: 95/001,251
Filed: November 24, 2009
For: U.S. Patent No. 6,781,231

In re Anthony D. Minervini
Inter Partes Reexamination Proceeding
Control No.: 95/001,363
Filed: June 30, 2010
For: US. Patent No. 6,781,231

The above-captioned reexamination proceedings are before the Office of Patent Legal Administration for *sua sponte* consideration of whether the proceedings should be merged under 37 CFR 1.989.

BACKGROUND

1. U.S. Patent No. 6,781,231 (“the ‘231 patent”) issued to Anthony D. Minervini on August 24, 2004, with 22 claims.
2. A request for *inter partes* reexamination of claims 1-22 of the ‘231 patent was filed on October 7, 2009, by a third party requester, and was assigned control number 95/000,509 (“the ‘509 *inter partes* proceeding”). The real party in interest is Analog Devices, Inc.
3. On November 25, 2009, *inter partes* reexamination was ordered for claims 1-22 of the ‘231 patent based on the examiner’s determination that the October 7, 2009 request raised a substantial new question of patentability affecting these claims. The order was accompanied by an Office action rejecting Claims 1-4 and confirming the patentability of claims 5-22.
4. On January 28, 2010, patent owner submitted a response to the November 25, 2009 non-final rejection action. The January 28, 2010 patent owner response included the addition of new claims 23-26.
5. The ‘509 requester filed comments on February 24, 2010, on patent owner’s January 28, 2010 response.
6. A request for *inter partes* reexamination of claims 1-4 of the ‘231 patent was filed on November 24, 2009, by a third party requester, and was assigned control number 95/001,251 (“the ‘1251 *inter partes* proceeding”). The real party in interest is Wolfson Microelectronics, PLC.
7. On February 23, 2010, *inter partes* reexamination was ordered for claims 1-4 of the ‘231 patent based on the examiner’s determination that the November 24, 2009 request raised a substantial new question of patentability affecting these claims. The order was accompanied by a non-final an Office action rejecting Claims 1-4.
8. On April 26, 2010, patent owner submitted a response to the February 23, 2010 non-final rejection action. The April 26, 2010 patent owner response included the addition of new claims 23-26, which are identical to claims 23-26 added by patent owner in the January 28, 2010 response filed in the ‘509 *inter partes* proceeding.
9. The ‘1251 requester filed comments on May 21, 2010, on patent owner’s April 26, 2010 response.
10. A request for *inter partes* reexamination of claims 1-4 of the ‘231 patent was also filed on June 30, 2010, by a third party requester, and was assigned control number 95/001,363 (“the 1363 *inter partes* proceeding”). The real party in interest is BSE Co., Ltd.
11. On September 8, 2010, *inter partes* reexamination was ordered for claims 1-4 of the ‘231 patent based on the examiner’s determination that the June 30, 2010 request raised a substantial new question of patentability affecting these claims. No Office action has been issued in the ‘1363 proceeding.

DECISION

I. MERGER OF PROCEEDINGS

Reexamination has been ordered in three proceedings for overlapping claims of the same patent. All three proceedings are *inter partes* proceedings. All three proceedings are still pending, and have not been terminated. Therefore, consideration of merger pursuant to 37 CFR 1.989 is ripe at this point in time.

37 CFR 1.989 provides:

- (a) If any reexamination is ordered while a prior *inter partes* reexamination proceeding is pending for the same patent and prosecution in the prior *inter partes* reexamination proceeding has not been terminated, a decision may be made to merge the two proceedings or to suspend one of the two proceedings. Where merger is ordered, the merged examination will normally result in the issuance and publication of a single reexamination certificate under § 1.997.

In accordance with 37 CFR 1.989(a), the 95/000,509, 95/001,251 and 95/001,363 proceedings are merged. The merged proceeding will be conducted in accordance with the guidelines and requirements that follow.

II. THE SAME CLAIMS MUST BE MAINTAINED IN ALL THREE PROCEEDINGS

Patent owner is required to maintain the same claims (and specification) in all three files throughout the merged proceeding. Presently, the '509 and '1251 proceedings, but not the '1363 proceeding, include additional claims 23-26. Thus, the claims are not currently the same in all three files. An Office action requiring an amendment placing the claims in identical form is being issued concurrently with this decision. Patent owner must respond to the Office action in accordance with the procedures in 37 CFR 1.111. The third party requesters will then have an opportunity to comment on patent owner's response in accordance with the procedures in 37 CFR 1.947.

III. CONDUCT OF MERGED PROCEEDING

A. Governing regulations for the merged proceeding:

The present decision merges three *inter partes* reexamination proceedings. The merged proceeding is governed by 37 CFR 1.902 through 1.997. Pursuant to 37 CFR 1.989(a), the merged examination will normally result in the issuance and publication of a single reexamination certificate under 37 CFR 1.997.

It is noted that reexamination was ordered for claims 1-22 of the '231 patent in the '509 proceeding, for claims 1-4 of the '231 patent in the '1251 proceeding, and for claims 1-4 of the '231 patent in the '1363 proceeding. The examiner will conduct reexamination in the merged proceeding for claims 1-22 of the '231 patent and for the newly added claims 23-26.

B. Papers mailed/filed:

All papers mailed by the Office throughout the merged proceeding will take the form of a single action which applies to all three proceedings. All papers issued by the Office, or filed by the patent owner and the third party requester(s), will contain the identifying data for all three proceedings and will be entered in each reexamination file. All papers filed by the patent owner and the third party requester(s) must consist of a single paper, **filed in triplicate**, each bearing a signature and identifying data for all three proceedings, for entry into each file.

All papers filed by the patent owner and the third party requester(s) should be directed:

by Mail to: Attn: Mail Stop "Inter Partes Reexam"
Central Reexamination Unit
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

by FAX to: (571) 273-9900
Central Reexamination Unit

by Hand to: Customer Service Window
Attn: Central Reexamination Unit
Randolph Building, Lobby Level
401 Dulany Street
Alexandria, VA 22314

by EFS: Registered users may submit papers via the
electronic filing system EFS-Web, at:

<https://portal.uspto.gov/authenticate/authenticateuserlocalepf.html>

Patent owner and requester(s) are reminded that every paper filed in the merged proceeding subsequent to this decision must be served on the other parties, and every paper filed must reflect that such paper was served on the other parties, pursuant to 37 CFR 1.903. All papers are to be addressed to the Central Reexamination Unit as provided above.

C. Amendments:

The filing of any amendments to the specification, claims, or drawings must comply with 37 CFR 1.943, which incorporates the provisions of 37 CFR 1.530 and the guidelines of MPEP § 2666.01, which in turn references the guidelines of MPEP § 2250.

37 CFR 1.121 does not apply to amendments in reexamination. Accordingly, clean copies of the amended claims are not required and are not to be submitted; rather amendments are to be presented via markings pursuant to 37 CFR 1.530(f), except that a claim should be canceled by a statement canceling the claim, without presentation of the text of the claim.

Pursuant to 37 CFR 1.530(i), all amendments must be made relative to the patent specification, including the claims, and drawings, which are in effect as of the date of filing the request for reexamination. *Amendments are not to be made relative to previous amendments.* Thus, for all amendments, all words not appearing in the patent are always underlined, and only words being deleted from the patent appear in brackets.

D. Fees:

Where a paper is filed which requires payment of a fee (e.g., extension of time fee, excess claims fee, petition fee, appeal fee, brief fee, oral hearing fee), only a single fee need be paid. For example, only one fee need be paid for patent owner's appellant brief (or that of one of the *inter partes* reexamination requesters) which may be filed, even though the brief relates to merged multiple proceedings, and copies must be filed (as pointed out above) for each file in the merged proceeding.

E. Citation of Patents and Printed Publications:

Upon return of the present merged proceeding to the examiner, the examiner will review the files to ensure that each file contains identical citations of prior patents and printed publications, and will cite such documents as are necessary as part of the next action in order to place the files in that condition.

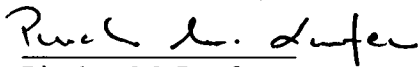
F. Appeal Procedure Reminders for *Inter Partes* Reexamination

The parties are reminded of the procedures for taking appeal in an *inter partes* reexamination as explained in MPEP 2674 and 2675. The appeal must only be taken from (1) the rejection(s) of the claims in the Right of Appeal Notice (RAN) that the *patent owner* proposes to contest, or (2) the finding(s) of patentability of claims in the RAN that the *third party requester* proposes to contest. Therefore, in the notice of appeal, the patent owner must identify each claim rejected by examiner that the patent owner intends to contest and the third party requester must identify each rejection *that was previously proposed by that third party requester* that the third party requester intends to contest. (37 CFR 41.61) The appellant's brief shall present a concise statement of each issue. Further, no new ground of rejection can be proposed by a third party requester appellant, unless such ground was withdrawn by the examiner during the prosecution of the proceeding, and the third party requester has not yet had an opportunity to propose it as a third party requester proposed ground of rejection. (37 CFR 41.67(c)(1)(vi))

CONCLUSION

1. *Inter partes* Reexamination Control No. 95/000,509, *inter partes* Reexamination No. 95/001,251 and *inter partes* Reexamination Control No. 95/001,363 are merged into a single proceeding, to be conducted in accordance with the procedure set forth above.

2. Any questions concerning this communication should be directed to Raul Tamayo in the Office of Patent Legal Administration, at (571) 272-7728.



Pinchus M. Laufer
Legal Advisor
Office of Patent Legal Administration

October 7, 2010



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,363	06/30/2010	6,781,231	092771-0035	7421
38939 7590 12/14/2010 DYKEMA GOSSETT PLLC 10 S. WACKER DR., STE. 2300 CHICAGO, IL 60606				
EXAMINER THERIAULT, STEVEN B				
ART UNIT 3992		PAPER NUMBER		
MAIL DATE 12/14/2010		DELIVERY MODE PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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Alexandria, VA 22313-1450
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DYKEMA GOSSETT PLLC
10 S. WACKER DRIVE
SUITE 2300
CHICAGO, IL 60606

In re Application of

MINERVINI, Anthony

Control No. 997001,363

Filed: May 27, 2010

Attorney Docket No. 0076943-000002

DECISION ON PETITION
TO WITHDRAW
FROM RECORD

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed November 22, 2010.

The request is **moot** because a revocation of power of attorney has been filed.

A review of the file record indicates that the power of attorney to Buchanan Ingersoll & Rooney PC has been revoked by the third party requestor of the reexamination application on December 3, 2010. Accordingly, the request to withdraw under 37 C.F.R. § 1.36(b) is moot.

All future communications from the Office will be directed to the below-listed address until otherwise notified by applicant.

Telephone inquiries concerning this decision should be directed to Denise L. Boyd at 571-272-0992.

cc: Jason Y. & Associates, LLC
12178 Bridgend Run
Fairfax, VA 22030

cc: Buchanan Ingersoll & Rooney PC
P. O. Box 1404
Alexandria, VA 22313-1404



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United States Patents and Trademark Office
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Date:

BUCHANAN, INGERSOLL & ROONEY PC

POST OFFICE BOX 1404

ALEXANDRIA, VA 22313-1404

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001363

PATENT NO. : 6781231

TECHNOLOGY CENTER : 3999

ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,363	06/30/2010	6,781,231	092771-0035	7421
38939	7590	05/03/2011	EXAMINER	
DYKEMA GOSSETT PLLC 10 S. WACKER DR., STE. 2300 CHICAGO, IL 60606			ART UNIT	PAPER NUMBER

DATE MAILED: 05/03/2011

Please find below and/or attached an Office communication concerning this application or proceeding.



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,251	11/24/2009	6,781,231	092771-0021D	6960
38939	7590	05/03/2011	EXAMINER	
DYKEMA GOSSETT PLLC 10 S. WACKER DR., STE. 2300 CHICAGO, IL 60606			ART UNIT	PAPER NUMBER

DATE MAILED: 05/03/2011

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,509	10/07/2009	6781231	092771-0021C	5895
38939	7590	05/03/2011	EXAMINER	
DYKEMA GOSSETT PLLC 10 S. WACKER DR., STE. 2300 CHICAGO, IL 60606			ART UNIT	PAPER NUMBER

DATE MAILED: 05/03/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

LADAS & PARRY LLP

224 SOUTH MICHIGAN AVENUE

SUITE 1600

CHICAGO, IL 60604

Date:

MAILED

MAY 03 2011

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001363

PATENT NO. : 6781231

TECHNOLOGY CENTER : 3999

ART UNIT : 3992

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
SUNSTEIN KANN MURPHY & TIMBERS LLP
125 SUMMER STREET
BOSTON, MA 02110-1618

Date:

MAILED

JUN 03 2011

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000509
PATENT NO. : 6784231
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
WOLF GREENFIELD & SACKS, P.C.
600 ATLANTIC AVENUE
BOSTON, MA 02210-2206

MAILED

Date: **MAY 03 2011**

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001251
PATENT NO. : 6781231
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

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DYKEMA GOSSETT PLLC
10 S. WACKER DR. STE. 2300
CHICAGO, IL 60606

(For Patent Owner)

MAILED

MAY 03 2011

CENTRAL REEXAMINATION UNIT

SUNSTEIN KANN MURPHY &
TIMBERS LLP
125 SUMMER STREET
BOSTON, MA 02110

(For 95/000,509 Requester)

WOLF GREENFIELD & SACKS, P.C.
600 ATLANTIC AVE.
BOSTON, MA 02110

(For 95/001,251 Requester)

BUCHANAN, INGERSOLL &
ROONEY PC
POST OFFICE BOX 1404
ALEXANDRIA, VA 22313-1404

(For 95/001,363 Requester)

In re: Minervini
Inter Partes Reexamination Proceeding
Control No.: 95/000,509
Deposited: October 7, 2009
For: U.S. Patent No.: 6,781,231

DECISION ON PETITION

In re: Minervini
Inter Partes Reexamination Proceeding
Control No.: 95/001,251
Deposited: November 24, 2009
For: U.S. Patent No.: 6,781,231

In re: Minervini
Inter Partes Reexamination Proceeding
Control No.: 95/001,363
Deposited: June 30, 2010
For: U.S. Patent No.: 6,781,231

This is a decision on a petition filed by the patent owner on January 28, 2011, entitled "PETITION UNDER 37 C.F.R. § 1.182 TO STRIKE THIRD PARTY REQUESTER'S COMMENTS" [hereinafter "the petition"]. The petition is being treated as a petition under 37

C.F.R. § 1.181 as a request to the Director to exercise his discretion to review the allegedly improper entry of a paper into the record.

The petition is before the Director of the Central Reexamination Unit. The petition is dismissed.

REVIEW OF RELEVANT FACTS

- U.S. Patent No. 6,781,231 issued on August 24, 2004.
- A request for *inter partes* reexamination was filed October 7, 2009 and assigned control no. 95/000,509.
- A second request for *inter partes* reexamination met the requirements for receiving a filing date on November 24, 2009 and was assigned control no. 95/001,251.
- A third request for *inter partes* reexamination met the requirements for receiving a filing date on June 30, 2010 and was assigned control no. 95/001,363.
- *Inter partes* reexamination was ordered and prosecution progressed in each proceeding. The third party in the '1251 proceeding filed comments responsive to an Office action and patent owner response on May 21, 2010.
- The proceedings were merged in a decision mailed December 28, 2010.
- A Non-final Rejection was mailed on December 28, 2010 in the merged proceeding.
- On January 28, 2011, the instant petition was filed along with a response to the Office action

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

37 C.F.R. § 1.181 Petition to the Director

- (f) The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings. Any petition under this part not filed within two months of the mailing date of the action or notice from which relief is

requested may be dismissed as untimely, except as otherwise provided. This two-month period is not extendable.

37 C.F.R. § 1.182 Questions Not Specifically Provided For

All situations not specifically provided for in the regulations of this part will be decided in accordance with the merits of each situation by or under the authority of the Director, subject to such other requirements as may be imposed, and such decision will be communicated to the interested parties in writing. Any petition seeking a decision under this section must be accompanied by the petition fee set forth in § 1.17(f).

DECISION

Patent owner [“petitioner”] argues that the comments filed by the third party requester on May 21, 2010 are improper and should be stricken from the record as being longer than the permissible page limit, and also as being drawn beyond the permissible scope.

As a procedural matter, the petition was filed under 37 CFR § 1.182, which is reserved for questions that are not provided for in the regulations. The Office considers petitions to strike a paper as being properly filed under 37 CFR § 1.181, as this is considered the invocation of supervisory authority of the Director to review the allegedly improper entry of a paper into the record. Such a petition is therefore provided for elsewhere in the regulations and is not proper under 37 CFR § 1.182. The petition is treated as a petition under 37 CFR § 1.181.¹

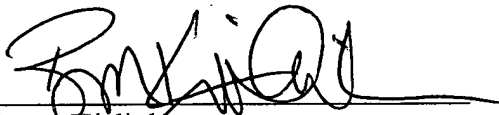
A paper such as a third party comments submission is entered into the record when it is filed. After the scanning period, the paper is available for viewing on public PAIR as a part of the reexamination record. Thus, the allegedly improper action, the entry of the paper into the record, took place on May 21, 2010, the filing date of the third party comments submission.

The petition was filed on January 28, 2011, nearly six months after the entry of the paper into the record. It was therefore not filed within two months of the act of entering the paper, from which relief is requested. The petition is therefore untimely under 37 CFR § 1.181(f), and is dismissed.

¹ Note that this does not change the result herein, as 1.182 petitions are also subject to the time limit discussed in this decision. “The 2-month period for filing timely petitions set forth in 37 CFR 1.181(f) applies to any petition under 37 CFR part 1, except as otherwise provided The 2-month time period in 37 CFR 1.181(f) applies to a petition under any section (e.g., 37 CFR 1.182 and 37 CFR 1.183) that does not specify the time period within which a petition must be filed.” MPEP 1002.01.

CONCLUSION

1. The petition filed January 28, 2011 is dismissed as untimely.
2. Jurisdiction remains with the Central Reexamination Unit for consideration of the January 28, 2011 patent owner response and subsequent third party requester comments.
3. Telephone inquiries related to this decision should be directed to Mark Reinhart, Supervisory Patent Examiner, at (571) 272-1611 or in his absence to the undersigned at (571) 272-0700.



Bruce Kisliuk
Director, Central Reexamination Unit



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,363	06/30/2010	6,781,231	092771-0035	7421
38939	7590	05/11/2011	EXAMINER	
DYKEMA GOSSETT PLLC 10 S. WACKER DR., STE. 2300 CHICAGO, IL 60606			ART UNIT	PAPER NUMBER

DATE MAILED: 05/11/2011

Please find below and/or attached an Office communication concerning this application or proceeding.



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,509	10/07/2009	6781231	092771-0021C	5895
38939	7590	05/11/2011	EXAMINER	
DYKEMA GOSSETT PLLC 10 S. WACKER DR., STE. 2300 CHICAGO, IL 60606			ART UNIT	PAPER NUMBER

DATE MAILED: 05/11/2011

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,251	11/24/2009	6,781,231	092771-0021D	6960
38939	7590	05/11/2011	EXAMINER	
DYKEMA GOSSETT PLLC 10 S. WACKER DR., STE. 2300 CHICAGO, IL 60606			ART UNIT	PAPER NUMBER

DATE MAILED: 05/11/2011

Please find below and/or attached an Office communication concerning this application or proceeding.



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SUNSTEIN KANN MURPHY & TIMBERS LLP
125 SUMMER STREET
BOSTON, MA 02110-1618

Date:

MAILED
MAY 11 2011

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000509
PATENT NO. : 6784231
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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WOLF GREENFIELD & SACKS, P.C.
600 ATLANTIC AVENUE
BOSTON, MA 02210-2206

Date: **MAILED**
NOV 11 2011
CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001251
PATENT NO. : 6781231
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Date:

LADAS & PARRY LLP
224 SOUTH MICHIGAN AVENUE
SUITE 1600
CHICAGO, IL 60604

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001363
PATENT NO. : 6781231
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

MAILED
MAY 11 2001
CENTRAL REEXAMINATION UNIT

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SUMMARY

The February 18, 2011 petition, filed by the requester of *inter partes* reexamination proceeding control no. 95/001,251, is **dismissed**.

The May 21, 2010 and February 28, 2011 comments submissions, filed by the requester of *inter partes* reexamination proceeding control no. 95/001,251, ***facially*** fail to comply with Office regulations and procedures, are **improper**, and are being **sua sponte expunged** from the record due to their failure to comply, at a minimum, with MPEP 2617 and MPEP 2666.05. Because these papers have been scanned into the Office's electronic Image File Wrapper (IFW) system, they are being **expunged** from the record by marking the papers "closed" and "non-public," and will not constitute part of the record of the present reexamination proceeding.

DECISION

The February 18, 2011 Petition Under 37 CFR 1.183 to Waive the Page Length Requirements of 37 CFR 1.943(b)

In the instant petition, the requester requests that the Office waive the page length requirements of 37 CFR 1.943(b) for the comments submission filed on May 21, 2010 in *inter partes* reexamination control no. 95/001,251. The May 21, 2010 written comments submission is in excess of 50 pages.

37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party. The burden is on petitioner to set forth with specificity the facts that give rise to an extraordinary situation in which justice requires suspension of a rule. In the present case, however, the requester did not file its petition until nearly two months after a decision merging the '1251 proceeding with two other *inter partes* reexamination proceedings, control nos. 95/000,509 and 95/001,363, as well as a non-final Office action in the merged proceeding, had been mailed. Furthermore, the requester did not file its petition until ***nearly nine months after*** the filing of its comments submission, for which waiver of the rule is requested.

The requester argues that the present petition "is belated . . . because the Requester was unaware of the page limit at the time the Comments were filed". That the requester was unaware of the page limit requirements is not considered to reflect an extraordinary situation, such that justice requires waiver of the rule, particularly in view of requester's substantial delay in filing its petition.

Accordingly, the February 18, 2011 petition, filed by the requester of *inter partes* reexamination proceeding control no. 95/001,251, is **dismissed**.

Requester's May 21, 2010 and February 28, 2011 Comments Submissions Facially Fail to Comply with Office Regulations and Published Procedures

This decision addresses requester's comments submissions solely for the purpose of determining their compliance with the page length requirements of 37 CFR 1.943(b), and is not intended to provide a full analysis of requester's comments submissions for compliance with any other Office regulations or procedures. The Office, however, notes that requester's May 21, 2010 and February 28, 2011 comments submissions *facially* fail to comply with Office regulations and published procedures.

For example, requester's May 21, 2010 and February 28, 2011 comments submissions fail to comply with MPEP 2666.05 and MPEP 2617. See MPEP 2666.05 which provides, in pertinent part (emphasis added):

... where a newly proposed rejection is based on the newly presented prior patents and printed publications (art), **the third party requester must present the newly proposed rejection in compliance with the guidelines set forth in MPEP § 2617**, since any such new proposed rejection stands on the same footing as a proposed rejection presented with the request for reexamination, and is treated the same way as to future Office actions and any appeal. See MPEP § 2617 as to the required discussion of the pertinency of each reference to the patentability of at least one claim presented for the newly submitted prior art. An explanation pursuant to the requirements of 35 U.S.C. 311 of how the art is applied is no less important at this stage of the prosecution, than it is when filing the request.

Requester's comments submissions propose new grounds of rejection. The submissions, however, fail to provide a clear and complete explanation for every claim for which a rejection is proposed, due to the lumping together of the identification and explanation of multiple proposed rejections. See, for example, the rejections newly proposed on pages 47 and 14 of the May 21, 2010 and February 28, 2011 comments submissions, respectively, where the requester proposes a rejection over "the combination of **either** Torkkeli **or** Bamhauer with Sjursen".

Also, the requester's comments submissions do not clearly specify what new non-cumulative technological teaching, which forms the basis for a substantial new question (SNQ), is taught by at least one of the documents cited for *each* newly proposed ground of rejection. For at least one of the documents cited for each newly proposed ground of rejection, the requester must specify where, in the document, the new, non-cumulative technological teaching is provided within the document, preferably by column and line number (or by page number). If a ground of rejection citing only one document is newly proposed, the requester must specify where, in the document, the new, non-cumulative technological teaching is provided within the document, preferably by column and line number (or by page number).

Finally, the requester is reminded that a proper comments submission must specifically explain, for each newly proposed rejection, *how patent owner's amendment necessitated each newly proposed new ground of rejection*, and why each reference of any proposed combination is needed to address the amendment. **For each newly submitted document**, the requester must *specifically* explain **a)** how the presence of a teaching in the newly submitted document, if cited alone in a proposed rejection, **corresponds to at least one claim limitation newly added by**

patent owner's amendment, or b) if the newly submitted document is cited as one of the documents of a document combination, how the presence of a teaching in at least one of the documents of the document combination corresponds to at least one claim limitation newly added by patent owner's amendment. See MPEP 2666.05.

For the reasons given above, the May 21, 2010 and February 28, 2011 requester comments submissions *facially* fail to comply with Office regulations and procedures, are **improper**, and are being ***sua sponte expunged*** from the record due to their failure to comply, at a minimum, with MPEP 2617 and MPEP 2666.05. Because these papers have been scanned into the Office's electronic Image File Wrapper (IFW) system, they are being **expunged** from the record by marking the papers "closed" and "non-public," and will not constitute part of the record of the present reexamination proceeding.

This decision addresses requester's comments submissions solely for the purpose of determining their compliance with the page length requirements of 37 CFR 1.943(b), and is not intended to provide a full analysis of requester's comments submissions for compliance with any other Office regulations or procedures. The examiner should review all pending, and later-filed papers of record for compliance with Office regulations and published procedures.

Requester's Recourse

The requester is given **15 days to file a replacement comments submission**, which may include the content of both the May 21, 2010 and the February 28, 2010 comments submissions, including any appendices, **and any petition under 37 CFR 1.183 requesting waiver of the page length requirements of 37 CFR 1.943(b) for the replacement comments submission**. Any petition under 37 CFR 1.183 requesting waiver of the page length requirements is to be filed concurrently with the replacement comments submission for which waiver is requested.

This decision does **not** *sua sponte* waive the page length requirements of 37 CFR 1.943(b) with respect to any replacement comments submission that is filed in response to this decision, nor is this decision intended to imply a *sua sponte* waiver of any specific number of pages in excess of 50. The requester, in fact, should attempt to file a replacement comments submission within the regulatory 50-page limit.

In order to request waiver of the page length requirements pursuant to 37 CFR 1.183, if a waiver is needed, the requester is reminded that 37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party. **The burden is on the petitioner** to set forth with specificity the facts that give rise to an extraordinary situation in which justice requires suspension of a rule. A showing which petitioner can make in support of a request for waiver of the 50-page limit of 37 CFR 1.943(b) can be an attempt to draft a comments submission in compliance with the 50-page limit, and the filing of a resulting comments submission that is in excess of 50 pages concurrently with a petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b), requesting entry of the comments submission. Such a

submission can be evaluated for economizing, extraneous material,¹ and arrangement, without repetition of information already of record. In this way, petitioner can rely on the proposed submission: (1) for justification that more pages are needed to complete the submission, and (2) to set forth an accurate determination of exactly how many additional pages are needed to complete the submission.

The requester is also reminded that a document is deemed to be subject to the 50-page length requirement when the document includes legal argument, i.e., arguments of counsel such as, e.g., arguments that the claims are patentable or unpatentable, or that are directed to how an outstanding or proposed rejection is overcome, or, in the case of a document filed by the requester, how an outstanding or proposed rejection is supported. There are no *per se* rules for determining whether a document, such as an affidavit or declaration, contains a legal argument that will cause the document to be subject to the page count. Each determination of whether a document, such as an affidavit or declaration, contains information that will cause the document to be subject to the page count is made on a case-by-case basis. In determining whether a document such as an affidavit or declaration under 37 CFR 1.132, or any other document of a submission, includes legal argument, the Office analyzes whether the document is providing factual evidence, i.e., evidence of **technological** facts, or whether the document contains argument that is merely an extension of the arguments of counsel.² Factual evidence includes, for example, declarations that swear behind the filing date of a reference, that establish the date of a printed publication, that provide a technical explanation or technical definition of terms of art used by a reference, or that provide comparative test results and a scientific, or technological, analysis of the results (see, e.g., MPEP 716.02). If a document is limited to factual evidence, the document is not included in the page count. In addition, affidavits or declarations **limited to** establishing commercial success, long-felt need and failure of others, skepticism of experts, or copying, as per MPEP 716.03 -716.06, respectively, will not be included in the page count.

The requester is further reminded that, **in order to obtain a waiver of the 50-page length requirement of 37 CFR 1.943(b), any grantable petition under 37 CFR 1.183 must be accompanied by a requester comments submission that:**

- 1) is one-and-a-half or double-spaced;
- 2) is in a non-script type font (e.g., Arial, Times New Roman, or Courier);
- 3) has a font size no smaller than 12-point;
- 4) conforms to the margin requirements of 37 CFR 1.52(a)(1)(ii); and
- 5) has sufficient clarity and contrast to permit direct reproduction of readily legible copies in any number by use of photographic, electrostatic, photo-offset, and microfilming processes

¹ For example, a brief review of the May 21, 2010 comments submission reveals the presence of an entire section devoted to a legal analysis of the broadest reasonable interpretation standard, which may be considered to be extraneous material.

² For example, a brief review of the May 21, 2010 comments submission reveals the presence of a brief, submitted in the United States Court of Appeals for the Federal Circuit. The brief includes arguments regarding the invalidity of the patent under reexamination in this proceeding, and would, if later filed, be considered as replete with legal arguments that are an extension of the arguments of counsel, which would be counted toward the regulatory page limit.

and electronic capture by digital imaging and optical character recognition pursuant to 37 CFR § 1.52(a)(1)(v).

See, generally, 37 CFR 1.943(a) and 37 CFR 1.52.

CONCLUSION

- The February 18, 2011 petition under 37 CFR 1.183, filed by the requester of *inter partes* reexamination proceeding control no. 95/001,251, is **dismissed**.
- The May 21, 2010 and February 28, 2011 requester comments submissions *facially* fail to comply with Office regulations and procedures, are **improper**, and are being **sua sponte expunged** from the record due to their failure to comply, at a minimum, with MPEP 2617 and MPEP 2666.05. Because these papers have been scanned into the Office's electronic Image File Wrapper (IFW) system, they are being **expunged** from the record by marking the papers "closed" and "non-public," and will not constitute part of the record of the present reexamination proceeding.
- The requester of the '1251 *inter partes* reexamination proceeding is given **15 days to file a replacement comments submission** in this merged proceeding, pursuant to the guidance set forth in this decision, and to concurrently file **any petition under 37 CFR 1.183 requesting waiver of the page length requirements of 37 CFR 1.943(b) for the replacement comments submission**.
- If no response to this decision is timely filed by the requester of the '1251 *inter partes* reexamination proceeding, prosecution of this merged proceeding, including the mailing of an Office action, will proceed in due course, without consideration of the May 21, 2010 and February 28, 2010 comments submissions filed by the third party requester of the '1251 *inter partes* reexamination proceeding.
- Any inquiry concerning this communication should be directed to the undersigned at (571) 272-7724.



Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

5/10/11
Kenpet8



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,363	06/30/2010	6,781,231	092771-0035	7421
38939	7590	06/27/2011	EXAMINER	
DYKEMA GOSSETT PLLC 10 S. WACKER DR., STE. 2300 CHICAGO, IL 60606			ART UNIT	PAPER NUMBER

DATE MAILED: 06/27/2011

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95/000,509	10/07/2009	6781231	092771-0021C	5895
38939	7590	06/27/2011	EXAMINER	
DYKEMA GOSSETT PLLC 10 S. WACKER DR., STE. 2300 CHICAGO, IL 60606			ART UNIT	PAPER NUMBER

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CENTRAL REEXAMINATION UNIT

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PATENT NO. : 6784231
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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CENTRAL REEXAMINATION UNIT

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In the instant petition under 37 CFR 1.183, the requester requests that the Office waive the page length requirements of 37 CFR 1.943(b). Specifically, the requester argues that the requester must present proposed rejections of newly added claims 23-27 (including independent claim 24), a detailed discussion of the newly added claims, and must also satisfy the applicable requirements of 37 CFR 1.948 and MPEP 2666.05.

A document is deemed to be subject to the 50-page length requirement when the document includes legal argument, i.e., arguments of counsel such as, e.g., arguments that the claims are patentable or unpatentable, or that are directed to how an outstanding or proposed rejection is overcome, or, in the case of a document filed by the requester, how an outstanding or proposed rejection is supported. There are no *per se* rules for determining whether a document, such as an affidavit or declaration, contains a legal argument that will cause the document to be subject to the page count. Each determination is made on a case-by-case basis. In determining whether a document such as an affidavit or declaration under 37 CFR 1.132, or any other document of a submission, includes legal argument, the Office analyzes whether the document is providing factual evidence, i.e., evidence of **technological** facts, or whether the document contains argument that is merely an extension of the arguments of counsel. Factual evidence includes, for example, declarations that swear behind the filing date of a reference, that establish the date of a printed publication, that provide a technical explanation or technical definition of terms of art used by a reference, or that provide comparative test results and a scientific, or technological, analysis of the results (see, e.g., MPEP 716.02). If a document is limited to factual evidence, the document is not included in the page count. In addition, affidavits or declarations **limited to** establishing commercial success, long-felt need and failure of others, skepticism of experts, or copying, as per MPEP 716.03 -716.06, respectively, will not be included in the page count.

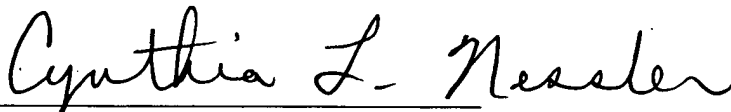
In support of its request for waiver of 37 CFR 1.943(b), the requester has submitted, on May 25, 2011, a comments submission that is in excess of 50 pages. Upon brief review, the May 26, 2011 comments submission includes 50 pages of comments and an eight-page declaration under 37 CFR 1.132 of Dr. Khalil Najafi. The 50 pages of comments are included in the page count. Two pages, i.e., pages 7 and 8, of the declaration under 37 CFR 1.132 of Dr. Khalil Najafi are deemed to be an extension of the arguments of counsel (see, for example, the heading "Obvious Design Choices and Modifications", and, for example, the following statements: "It would have

been obvious to provide solder pads on the bottom of the package of Sjursen . . . to achieve a package that can be mounted to [the] next level of interconnection from the underside” (paragraph 20); “and therefore the use of a printed circuit board as a package substrate is a matter of design choice” (paragraph 21). Thus, the 50 pages of comments and the two pages of the Najafi declaration, resulting in a total of 52 pages, are included in the page count.

Based on the individual facts and circumstances of this case including, for example, the five claims, including one independent claim, newly added by the patent owner, it is deemed equitable to waive the 50-page limit of 37 CFR 1.943(b) in this instance. Thus, even though requester’s May 26, 2011 comments submission exceeds the 50-page limit, it is still deemed equitable in this instance to waive the 50-page limit of 37 CFR 1.943(b) to the extent that the pages of requester’s comments submission that are deemed to be subject to the page limit not exceed 52 pages. Accordingly, requester’s petition under 37 CFR 1.183 is granted and the page limit of 37 CFR 1.943(b) is waived to the extent that requester’s May 26, 2011 comments submission may exceed the page limit by up to 52 pages. This waiver makes requester’s May 26, 2011 comments submission page-length compliant.

CONCLUSION

- The May 26, 2011 requester petition is granted and the page limit of 37 CFR 1.943(b) is waived to the extent that requester’s May 26, 2011 comments submission may exceed the page limit by up to 52 pages. This waiver makes requester’s May 26, 2011 comments submission page-length compliant.
- Any inquiry concerning this communication should be directed to the undersigned at (571) 272-7724.



Cynthia L. Nessler
Senior Legal Advisor
Office of Patent Legal Administration

6/26/11



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,364	06/30/2010	7,439,616	092771-0034	7700
38939	7590	02/07/2011	EXAMINER	
DYKEMA GOSSETT PLLC 10 S. WACKER DR., STE. 2300 CHICAGO, IL 60606			ART UNIT	PAPER NUMBER

DATE MAILED: 02/07/2011

Please find below and/or attached an Office communication concerning this application or proceeding.



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

LADAS & PARRY LLP
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SUITE 1600
CHICAGO, IL 60604

Date:

MAILED

FEB 07 2011

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001364
PATENT NO. : 7439616
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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Dykema Gossett PLLC
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Chicago, IL 60606

(For Patent Owner)

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FEB 07 2011

CENTRAL REEXAMINATION UNIT

Mr. Steven G. Saunders
Sustain Kann Murphy & Timbers LLP
125 Summer Street
Boston, MA 02110-1618

(For 90/010,985 Requester)

Ladas & Parry LLP
224 South Michigan Avenue
Suite 1600
Chicago, IL 60604

(For 95/001,364 Requester)

In re Anthony D. Minervini
Ex Parte Reexamination Proceeding
Control No.: 90/010,985
Filed: May 6, 2010
For: U.S. Patent No. 7,439,616

:
:
: **DECISION, *SUA SPONTE*,**
: **TO MERGE**
: **REEXAMINATION**
: **PROCEEDINGS**

In re Anthony D. Minervini
Inter Partes Reexamination Proceeding
Control No.: 95/001,364
Filed: June 30, 2010
For: U.S. Patent No.: 7,439,616

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The above-captioned reexamination proceedings are before the Office of Patent Legal Administration for *sua sponte* consideration of whether the proceedings should be merged at this time.

Ex parte reexamination proceeding No. 90/010,985 and *inter partes* reexamination proceeding No. 95/001,364 **are merged** into a single proceeding.

BACKGROUND

1. United States Patent Number 7,439,616 ("the '616 patent") issued to Anthony D. Minervini on October 21, 2008, with 21 claims.
2. A request for *ex parte* reexamination of claims 1-21 of the '616 patent was filed on May 6, 2010, by third party requester Steven G. Saunders, and the request was assigned control number 90/010,985 ("the '10985 proceeding").

3. A request for *inter partes* reexamination of claims 1, 8-18, and 21 of the '616 patent was filed June 30, 2010, by third party requester Charles F. Wieland III, in which BSE Co., Ltd. was identified as the real party in interest, and the request was assigned Reexamination Control No. 95/001,364 ("the '1364 proceeding").
4. An order granting *ex parte* reexamination of claims 1-21 of the '616 patent was mailed for the '10985 reexamination proceeding on July 27, 2010. No Office action has been issued in the '10985 reexamination proceeding. No Patent Owner statement has been filed in the '10985 reexamination proceeding; and the time for filing same has expired.
5. An order granting *inter partes* reexamination of claims 1, 8-18, and 21 of the '616 patent was mailed for the '1364 proceeding on September 24, 2010; the order was accompanied by a non-final rejection action.
6. On November 16, 2010, the patent owner filed a response to the September 24, 2010 Office action, requesting reconsideration of the rejections of the original claims and adding new claims 22-35.
7. The third party requester in the '1364 proceeding filed a paper titled "Third Party Comments After Patent Owner Response Pursuant to 37 C.F.R. 1.947" on December 16, 2010.

DECISION

I. MERGER OF PROCEEDINGS

Reexamination is ordered in the above-captioned two proceedings for overlapping claims of the same patent. One of the proceedings (the '10985 proceeding) is an *ex parte* proceeding. The other proceeding (the '1364 proceeding) is an *inter partes* proceeding. Both proceedings are still pending, and have not been terminated. In addition, the period for filing the patent owner's statement in the *ex parte* proceeding has expired. Therefore, consideration of merger is ripe at this point in time.

MPEP 2686.01 points out:

Where a second request for reexamination is filed and reexamination is ordered, and a first reexamination proceeding is pending, the proceedings will be merged where the Office (in its discretion) deems it appropriate to do so, to facilitate the orderly handling of the proceedings. However, a decision not to merge is within the sole discretion of the Office to facilitate/carry out the statutory mandate of 35 U.S.C. 314(c) to conduct reexamination proceedings with "special dispatch."

In this instance, based upon the record as a whole, it is found, based on the facts as they exist at present, that merger of the proceedings should facilitate the orderly handling of the proceedings with special dispatch. Accordingly, the 90/010,985 and 95/001,364 proceedings are hereby merged. The merged proceeding will be conducted in accordance with the guidelines and requirements that follow.

II. THE SAME CLAIMS MUST BE MAINTAINED IN BOTH PROCEEDINGS

New claims 22-35 have been proposed in the '1364 proceeding, while there is no amendment in the '10985 proceeding. Thus, the claims are not currently the same in both proceeding files. Accordingly, a copy of claims 22-35 from the amendment in the *inter partes* reexamination proceeding is being placed in the *ex parte* reexamination IFW file, and is entered in the *ex parte* reexamination. Claims 1-35 will be addressed in the next Office action on the merits for the now merged proceeding. Such action is appropriate in this situation, because the *inter partes* reexamination requester has already had an opportunity to comment on the amendment in the *inter partes* reexamination and has done so.

The patent owner is required to continue to maintain the same claims (and specification) in both files throughout the merged proceeding.

III. CONDUCT OF MERGED PROCEEDING

A. Governing regulations for the merged proceeding:

The present decision merges an *ex parte* reexamination proceeding with an *inter partes* reexamination proceeding. Pursuant to 37 CFR 1.989(b), the merged proceeding is governed by 37 CFR 1.902 through 1.997, except that the rights of the third party requester of the *ex parte* reexamination are governed by 37 CFR 1.510 through 1.560.

B. *Inter partes* Third Party Requester Participation:

1. Comment rights:

The *inter partes* requester can comment pursuant to 35 U.S.C. 314(b)(2).¹ First, an *inter partes* requester's right to comment is contingent upon the patent owner responding to, or commenting on, an Office action. Second, the *inter partes* requester's right to comment is limited to issues raised in either the Office action or the patent owner's response to the action.

2. Appeal Rights:

¹ Each time that the patent owner files a response to an action on the merits from the Patent and Trademark Office, the *inter partes* third-party requester shall have one opportunity to file written comments addressing issues raised by the action of the Office or the patent owner's response thereto, if those written comments are received by the Office within 30 days after the date of service of the patent owner's response.

A notice of appeal by a third party requester must identify each rejection *that was previously proposed by that third party requester* which the third party requester intends to contest. It is not sufficient to merely appeal from the allowance of a claim (i.e., the examiner's finding of a claim patentable); the third party requester must identify each previously proposed rejection to be contested.

No new ground of rejection can be proposed by a third party requester appellant, unless such ground was withdrawn by the examiner during the prosecution of the proceeding, and the third party requester has not yet had an opportunity to propose it as a third party requester proposed ground of rejection.

It is to be noted that, since the *inter partes* third party requester did not propose any rejections of claims 2-7 and 19-20 in the request for reexamination, requester does not have any appeal rights as to those claims as they appear in the '616 patent.

All papers mailed by the Office throughout the merged proceeding will take the form of a single action which applies to both proceedings. All papers issued by the Office, or filed by the patent owner and the third party requesters, will contain the identifying data for both files and will be physically entered in each reexamination file. All papers filed by the patent owner and the third party requesters must consist of a single paper, filed in duplicate, each bearing a signature and identifying data for both files, for entry into each file.

by Mail to: Attn: Mail Stop "*Inter Partes* Reexam"
 Central Reexamination Unit
 Commissioner for Patents

P.O. Box 1450
Alexandria, VA 22313-1450

by FAX to: (571) 273-9900
Central Reexamination Unit

by Hand to: Customer Service Window
Attn: Central Reexamination Unit
Randolph Building, Lobby Level
401 Dulany Street
Alexandria, VA 22314

by EFS: Registered users may submit papers via the
electronic filing system EFS-Web, at:

<https://portal.uspto.gov/authenticate/authenticateuserlocalepf.html>

Patent owner and requesters are reminded that every paper filed (including papers filed *via* facsimile transmission) in the merged proceeding subsequent to this decision must be served on the other parties, and every paper filed must reflect that such paper was served on the other parties, pursuant to 37 CFR 1.903. All papers are to be addressed to the Central Reexamination Unit as provided above.

D. Amendments:

The filing of any amendments to the drawings, specification or claims must comply with 37 CFR 1.943, which incorporates the provisions of 37 CFR 1.530, and the guidelines of MPEP § 2666.01, which in turn references the guidelines of MPEP § 2250.

37 CFR 1.121 does not apply to amendments in reexamination. Accordingly, clean copies of the amended claims are not required and are not to be submitted; rather amendments are to be presented via markings pursuant to paragraph 37 CFR 1.530(f), except that a claim should be canceled by a statement canceling the claim, without presentation of the text of the claim.

Pursuant to 37 CFR 1.530(i), all amendments must be made relative to the patent specification, including the claims, and drawings, which are in effect as of the date of filing the request for reexamination. *Amendments are not to be made relative to previous amendments*. Thus, for all amendments, all words not appearing in the patent are always underlined, and only words being deleted from the patent appear in brackets.

E. Fees:

Where a paper is filed that requires payment of a fee (*e.g.*, petition fee, excess claims fee, extension of time fee, appeal fee, brief fee, oral hearing fee), only a single fee need be paid. For example, only one fee need be paid for any patent owner's appellant brief (or that of the *inter*

partes reexamination requester) which may be filed, even though the brief relates to merged multiple proceedings, and copies must be filed (as pointed out above) for each file in the merged proceeding.

F. Citation of Patents and Printed Publications:

Upon return of the present merged proceeding to the examiner, the examiner will review the files to ensure that each file contains identical citations of prior patents and printed publications, and will cite such documents as are necessary as part of the next action in order to place the files in that condition.

CONCLUSION

1. *Ex parte* Reexamination Control No. 90/010,985 and *inter partes* Reexamination Control No. 95/001,364 are merged into a single proceeding, to be conducted in accordance with the procedure set forth above.
2. A copy of the new claims added via the 95/001,364 *inter partes* reexamination proceeding has been placed in the *ex parte* 90/010,985 reexamination proceeding, thus, making the claims the same in both proceedings.
3. The examiner will prepare an Office action on the merits for the merged proceeding in due course.
4. Any questions concerning this communication should be directed to Raul Tamayo, Legal Advisor, at 571-272-7728.

/Kenneth M. Schor/

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

02-03-2011



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,369	06/03/2010	7395090	21716-0013RX2	5862
22913	7590	03/16/2012	EXAMINER	
Workman Nydegger 1000 Eagle Gate Tower 60 East South Temple Salt Lake City, UT 84111			ART UNIT	PAPER NUMBER

DATE MAILED: 03/16/2012

Please find below and/or attached an Office communication concerning this application or proceeding.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

Inter partes
CSR plc.
v.
Skullcandy, Inc.

Inter Partes Reexamination Control No. 95/001,369
Patent 7,395,090
Technology Center 3900

DECISION ON PETITIONS

This is a decision on requester's "Petition under 37 C.F.R. § 1.183 to Waive the 30-Page Limit set forth in 37 C.F.R. § 1.943," filed February 6, 2012 (petition #1). In petition #1, requester seeks waiver of 37 C.F.R. § 1.943(c), to permit requester to file an appellant brief having no more than 37 pages. The petition fee of \$400 in accordance with 37 C.F.R. § 1.17(f) was charged to requester's deposit account on February 7, 2012.

This is also a decision on patent owner's "Petition under 37 C.F.R. § 1.183 to Waive the 15-Page Limit set forth in 37 C.F.R. § 1.943(c)," filed March 6, 2012 (petition #2). In petition #2, patent owner seeks waiver of

Inter Partes Reexamination Control No. 95/001,369
Patent No. 7,395,090

37 C.F.R. § 1.943(c), to permit patent owner to file a respondent brief having no more than 18 pages. The petition fee of \$400 in accordance with 37 C.F.R. § 1.17(f) was charged to patent owner's credit card on March 7, 2012.

See 75 Fed. Reg. 50,750-51 (Aug. 17, 2010) for authority of the Chief Administrative Patent Judge.

FINDINGS

1. Third party requester filed a request for *inter partes* reexamination of U.S. Patent No. 7,395,090, on June 3, 2010, which was assigned control no. 95/001,369.
2. On August 6, 2010, reexamination was ordered in the '1369 proceeding, and a non-final Office action was mailed, rejecting claims 1-58.
3. Patent owner filed a response to the non-final Office action on October 6, 2010, including an amendment adding claims 59-74; and requester filed comments on November 5, 2010, both within the 50 page limit pursuant to 37 C.F.R. § 1.943(b).
4. On June 6, 2011, an Action Closing Prosecution (ACP) was mailed, confirming the patentability of claims 1- 74.
5. On November 4, 2011, a Right of Appeal Notice (RAN) was mailed, confirming the patentability of claims 1- 74.
6. Requester filed a Notice of Appeal on December 5, 2011, appealing the examiner's refusal to adopt numerous proposed grounds of rejection of claims 1- 74.
7. Requester filed petition #1 on February 6, 2012, accompanied by an appellant's brief.

Inter Partes Reexamination Control No. 95/001,369
Patent No. 7,395,090

8. Patent owner filed petition #2 on March 6, 2012, accompanied by a respondent's brief.

DISCUSSION

In petition #1, requester seeks waiver of the limits of 37 C.F.R. § 1.943(c), which limits an appellant brief to thirty pages or 14,000 words in length. The requester is seeking permission to file an appellant brief no longer than 37 pages.

Extension of the limits is requested for the following reasons stated by requester:

1. The examiner completely reversed his position in the ACP based on a new interpretation of the primary reference not advanced by either party and not of record previously.
2. The patent owner added new claims 59-74, therefore the requester must address 74 claims in light of the new position taken by the examiner.
3. The patent owner did not respond to the ACP, and this has cost requester 20 pages of arguments to address the position reversal of the examiner because the appellant brief is limited to 30 pages.
4. In the appellant brief, requester must submit contentions to the examiner's reasons for not adopting proposed rejections for 74 claims.

In petition #2, patent owner seeks waiver of the limits of 37 C.F.R. § 1.943(c), which limits patent owner's respondent brief to fifteen pages or 7,000 words in length. The patent owner is seeking permission to file a respondent brief having 3 additional pages to respond to the material in

Inter Partes Reexamination Control No. 95/001,369
Patent No. 7,395,090

requester's appellant brief having 7 additional pages. Patent owner asserts that to be fair, if appellant is allowed additional pages for its brief, then respondent should also be allowed at least half the number of additional pages that appellant is allowed.

RELEVANT AUTHORITY

37 CFR § 1.183 provides:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, sua sponte, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 CFR § 1.943(c) provides:

Appellant's briefs filed by the patent owner and the third party requester shall not exceed thirty pages or 14,000 words in length, excluding appendices of claims and reference materials such as prior art references. All other briefs filed by any party shall not exceed fifteen pages in length or 7,000 words. If the page limit for any brief is exceeded, a certificate is required stating the number of words contained in the brief.

MPEP § 2667 I.A.2 (Response filed by Patent Owner that is too long) provides:

With respect to the length of the papers, the following additional information is to be noted. Similar to the Federal Rules of Appellate Procedure, the provisions of 37 CFR 1.943(c) are waived to the extent that the table of contents pages, the table of case law pages, and the pages of the claims (but not claim charts applying the art to the claims) are excluded from the thirty (30) page limit required by 37 CFR 1.943(c). Any affidavit or declaration (or a clearly defined portion thereof) that contains opinion(s) of the affiant/declarant, or argument(s) that the art either does or does not anticipate or render obvious the claims, or specific claim elements, of the patent under reexamination, is considered to be part of the comments

Inter Partes Reexamination Control No. 95/001,369
Patent No. 7,395,090

submitted by the patent owner, or by the third party requester, and is subject to the page limit requirements of 37 CFR 1.943. Affidavits or declarations that are excluded from the page limit requirements include, for example, declarations attempting to swear behind (antedate) the filing date of a reference, or to establish the date of a printed publication, or declarations that provide comparative test data and an analysis of same. However, if the patent owner's affidavit or declaration includes any argument as to how an outstanding/proposed rejection is overcome, then the page(s) of the affidavit or declaration upon which the argument appears would be included against the page limit count. Likewise, if a third party requester affidavit or declaration includes any argument as to how a rejection is supported, then the page(s) of the affidavit or declaration upon which the argument appears would be included against the page limit count. Similarly, attached exhibits presenting data or drawings are not included against the page limit count, unless an exhibit or drawing includes argument as to how the outstanding rejection is overcome. Any page(s) of the exhibit or sheet(s) of drawings that include such argument would be included against the page limit count.

MPEP § 2667 I.B.2 (Response filed by Third Party Requester that is too long) provides:

For additional information with respect to the length of papers, see Subsection I.A.2 above.

ANALYSIS

Requester's petition has been considered fully. The USPTO has the discretion to waive the applicable rules under 37 C.F.R. § 1.183 in an extraordinary situation when justice requires waiver. Upon review of the prosecution history of this proceeding, it is noted that the patent owner and third party requester responses and comments prior to appeal have been within the page limit requirements. Requester is requesting permission to file an appellant brief that is stated to be not more than 37 pages.

Inter Partes Reexamination Control No. 95/001,369
Patent No. 7,395,090

Petitioner's reasons provided in support of waiving the page/word limits focus on the examiner's reversal of his position in the ACP; the addition of new claims 59-74; and the fact that because patent owner did not respond to the ACP, this has cost requester 20 pages of arguments to address the position reversal of the examiner. Petitioner asserts that requester must submit contentions to the examiner's reasons for not adopting proposed rejections for 74 claims. A persuasive showing has been made that this situation is extraordinary and that justice requires that more pages/words be allotted to appellant's brief. It is deemed equitable to permit an additional 7 pages for the appellant brief.

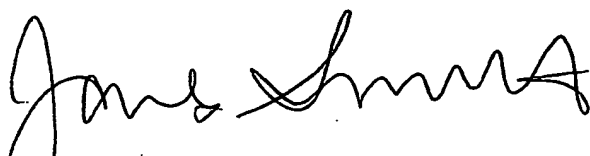
Petition #1 is **granted**.

In petition #2, patent owner is seeking permission to file a respondent brief having 3 additional pages to respond to the material in requester's appellant brief having 7 additional pages. Patent owner asserts that to be fair, if appellant is allowed additional pages for its brief, then respondent should also be allowed at least half the number of additional pages that appellant is allowed. It is deemed equitable to permit an additional 3 pages for the respondent brief.

Petition #2 is **granted**.

DECISION

In view of the foregoing, petition #1 and petition #2 are GRANTED.



James Donald Smith
Chief Administrative Patent Judge

Inter Partes Reexamination Control No. 95/001,369
Patent No. 7,395,090

Counsel for Patent Owner:

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Counsel for Third Party Requester

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,373	06/08/2010	6,651,000	12879-001-999	1646
26111	7590	08/09/2011	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			ART UNIT	PAPER NUMBER

DATE MAILED: 08/09/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
JONES DAY
222 EAST 41ST STREET
NEW YORK, NY 10017

Date: **MAILED**

AUG 09 2011

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001373
PATENT NO. : 6651000
TECHNOLOGY CENTER : 3999
ART UNIT : 3993

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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AUG 09 2011

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(For Patent Owner) CENTRAL REEXAMINATION UNIT

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New York, NY 10017

(For Third Party Requester)

Sterne, Kessler, Goldstein, & Fox
1100 New York Ave, N.W.
Washington, DC 20005

(Courtesy Copy)

In re Van Diggelen et al.
Inter Partes Reexamination Proceeding
Control No. 95/001,373
Filed: June 8, 2010
For: U.S. Patent No. 6,651,000 B2

:
: **DECISION**
: **DISMISSING PETITIONS**
: **UNDER §§ 1.182 AND 1.183**
:

This is a decision on the June 2, 2011 patent owner petitions entitled "PETITION UNDER 37 CFR § 1.182 REQUEST FOR CONTINUED REEXAMINATION" and PATENT OWNER'S PETITION FOR EXTENSION OF TIME TO FILE APPEAL BRIEF PURSUANT TO 37 C.F.R. § 1.183."

The patent owner petitions are before the Office of Patent Legal Administration.

The petitions under 37 C.F.R. §§ 1.182 and 1.183 are **dismissed**.

PERTINENT BACKGROUND

- On November 18, 2003, U.S. Patent No. 6,651,000 B2 ("the '000 patent) was issued to Van Diggelen *et al.*, having 33 claims.
- On June 8, 2010, a request for *inter partes* reexamination of claims 1, 2, and 5 was filed by the third party requester, the real party in interest being SiRF Technology, and the resulting reexamination proceeding was assigned control number 95/001,373 ("the '1373 proceeding").

- On July 27, 2010, reexamination was ordered for claims 1, 2, and 5 of the '1373 patent. On the same date, an Office action was mailed, rejecting claims 1, 2, and 5.
- On November 29, 2010, following a grant of a two month extension of time, patent owner filed a response to the July 27, 2010 Office action, including resubmission of claims 1, 2, and 5 in their unamended form.
- On December 22, 2010, third party requester filed comments pursuant to 37 C.F.R. § 1.947.
- On February 4, 2011, an Office Action Closing Prosecution (ACP) was mailed, repeating rejections made in the May 3, 2010 Office actions on claims 1, 2, and 5.
- On March 7, 2011, patent owner filed a response to the February 4, 2011 ACP, presenting proposed claim amendments to claims 1, 3, 4, 6-13, and 15.
- On May 2, 2011, a Right of Appeal Notice (RAN) was mailed, refusing entry of the proposed amendments filed with patent owner's March 7, 2011 response.
- On June 2, 2011, patent owner filed a Notice of Appeal, and a petition under § 1.182 for the purpose of requesting entry of proposed claim amendments as submitted on March 7, 2011, and refused entry in the Right of Appeal Notice of May 2, 2011, for reopening of prosecution for consideration of the same.
- On July 22, 2011, patent owner filed the instant petition under § 1.183 to permit an extension of time to file an appellant's brief until a decision on the § 1.182 petition has been rendered.

PERTINENT STATUTES AND REGULATIONS

35 U.S.C. § 314 provides, in pertinent part:

(a) **IN GENERAL.** — Except as otherwise provided in this section, reexamination shall be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133. In any inter partes reexamination proceeding under this chapter, the patent owner shall be permitted to propose any amendment to the patent and a new claim or claims, except that no proposed amended or new claim enlarging the scope of the claims of the patent shall be permitted.

(c) **SPECIAL DISPATCH.** — Unless otherwise provided by the Director for good cause, all inter partes reexamination proceedings under this section, including any appeal to the

Board of Patent Appeals and Interferences, shall be conducted with special dispatch within the Office.

37 C.F.R. § 1.182 provides:

All **situations not specifically provided** for in the regulations of this part will be decided in accordance with the merits of each situation by or under the authority of the Director, subject to such other requirements as may be imposed, and such decision will be communicated to the interested parties in writing. Any petition seeking a decision under this section must be accompanied by the petition fee set forth in § 1.17(f). (emphasis added)

37 C.F.R. § 1.183 provides:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, sua sponte, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

DECISION

The § 1.182 Petition

In March of 2005, the Office issued a Notice titled "Notice of Changes in Requirement for a Substantial New Question of Patentability for a Second or Subsequent Request for Reexamination While an Earlier Filed Reexamination is Pending."¹ Notice was provided therein that a patent owner could file a petition under 37 CFR § 1.182 requesting continued prosecution on the merits in the reexamination proceeding to seek entry of an amendment and/or evidence that was denied entry after a final rejection in an *ex parte* reexamination proceeding, or after an action closing prosecution in an *inter partes* reexamination proceeding.

By filing such a petition, the patent owner could obtain continued prosecution on the merits in the reexamination proceeding, including entry of the amendment and/or evidence that was denied entry after a final rejection in an *ex parte* reexamination proceeding, or after an action closing prosecution in an *inter partes* reexamination proceeding. Accordingly, relief in the form of a continuation of the reexamination prosecution (after a final Office action) was made available by the Office via a 37 CFR § 1.182 petition, in appropriate circumstances. This petition will be referred to herein as "the § 1.182 petition."

The § 1.182 petition must further the prosecution of the reexamination proceeding, rather than

¹ 1292 Off. Gaz. Pat. Office 20, March 1, 2005.

delay it, and must provide a submission toward that end. This is critical in the reexamination setting, where 35 U.S.C. § 305 (for *ex parte* reexamination) and 35 U.S.C. § 314 (for *inter partes* reexamination) mandate that reexamination proceedings must be conducted “with special dispatch within the Office.” Accordingly, the patent owner must make a *bona fide* effort, in the submission accompanying the § 1.182 petition, to define the issues for appeal, or the issuance of a reexamination certificate, since this is a key factor in reducing pendency of a reexamination proceeding. It thus follows that the petition should therefore clearly discuss the manner in which the entry of the submission would act to overcome a rejection or satisfy a requirement of form such that the issues in the proceeding are better defined for appeal or issuance of a reexamination certificate.

Furthermore, where relief is requested under § 1.182, any continuation of prosecution in a reexamination proceeding must be in accord with the statutory mandate of 35 U.S.C. § 314(c), stating that “all inter partes reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, shall be conducted with special dispatch within the Office.” Therefore, any Office decision granting continuation of prosecution in a reexamination proceeding must further its handling of the proceeding with special dispatch.

In this instance, patent owner petitions for reopening of prosecution to present claim amendments that purport to respond to new issues raised by the February 4, 2011 ACP, such that the amendments could not have been earlier anticipated, and that entry of such would advance prosecution.

To be consistent with the requirement of special dispatch, the showing of a *bona fide* effort made during the proceeding must explain why the need for the patent owner’s proposed response could not have been anticipated earlier, and only became apparent as a result of a new issue arising at, or subsequent to, the close of prosecution in the proceeding. In this case, the record is to the contrary. It is apparent from the prosecution history that the issue for which the proposed claim amendments are stated to address arose in the initial Office action of July 27, 2010.

Although patent owner chose only to argue against the legal sufficiency of the rejections in patent owner’s response to the initial Office action, patent owner could have *also* presented new claims having the scope of the presently proposed amendments, in addition to the arguments against the rejected claims.² Patent owner could have presented these claim amendments, or new claims having the scope of these amendments, in patent owner’s response to the non-final Office action, and all issues could have been resolved together. It is not to be expected, in all instances, that the Office will change its position in response to arguments. The need for the instant amendment, including the presentation of new claims, to define over the examiner’s rejection could have been anticipated following the first Office action, and entry at this stage would run counter to the requirement of special dispatch.

Additionally, patent owner’s response includes a submission directed towards the entry of claim

² Although petitioner states that copending proceedings outside the USPTO disfavored earlier claim amendments in the reexamination, such a decision not amend is driven by strategic concerns rather than by any issue arising in the reexamination proceeding. The existence of other such proceedings would also not prevent the submission of new claims of a more narrow scope; *i.e.*, the currently desired scope, in the reexamination proceeding.

amendments as described in patent owner's instant petition. Entry of these claims would increase rather than decrease the amount of issues in the present proceeding, since the proposed amendments contain previously unconsidered claim limitations which were found by the examiner to "add new issues under 35 USC 112, second paragraph".³

Therefore, as such reopening would not be consistent with the Office's requirement to handle reexamination proceedings with special dispatch, the instant patent owner petition under § 1.182 is **dismissed**.

The § 1.183 Petition

The instant petition is filed under § 1.183, which permits relief "[i]n an extraordinary situation, where justice requires" waiver of any requirement of the rules.

Patent owner petitioner filed the instant petition to request that the time for filing an appellant's Brief be extended until patent owner's petition under § 1.182 has been acted upon. Patent owner's petition under § 1.182 is being dismissed in the present decision. Patent owner petitioner's § 1.182 petition has thus been answered before the due date for filing an appellant's brief which is not due until August 16, 2011, causing the question of any waiver of the rules to become moot. Therefore, the instant patent owner petition under § 1.183 is **dismissed** to the extent that the requested 30 day extension is not granted. However, in view of the circumstances of the present proceeding, the time to file an Appellant's Brief under § 41.66(a) is extended to run through a date that is two weeks from the mailing date of this decision.

PATENT OWNER'S ADDRESS

The current correspondence address of record for the patent file is the proper patent owner address for reexamination mailings pursuant to 37 CFR 1.33(c). The current correspondence address of record for the 6,651,000 patent file is that of McAndrews, Held, & Malloy, 500 West Madison Street, Suite 3400, Chicago, IL 60661. However, the correspondence address of record in the reexamination file is that of Sterne, Kessler, Goldstein, & Fox, 1100 New York Ave, N.W., Washington, DC 20005. As a courtesy, this decision is being mailed to both addresses.

The address of McAndrews, Held, & Malloy, 500 West Madison Street, Suite 3400, Chicago, IL 60661, **will be the sole address used in future correspondence, until a change in correspondence address in the 6,651,000 patent file is made in accordance with 37 CFR 1.33(c).**

³ RAN at 4.

CONCLUSION

1. The patent owner petitions under §§ 1.182 and 1.183 are **dismissed**.
2. Patent owner's time to file an Appellant's Brief is due to expire on August 6, 2011. In view of the circumstances of the present proceeding, the time to file an Appellant's Brief under § 41.66(a) is extended to run through a date that is two weeks from the mailing date of this decision.
3. A copy of this decision will be made of record in the reexamination file.
4. Telephone inquiries related to this decision should be directed to the undersigned, at (571) 272-7700.

/Michael Cygan/

Michael Cygan
Legal Advisor
Office of Patent Legal Administration

August 9, 2011